

ADMINISTRATIVE PANEL DECISION

Caetano Retail España S.A.U. v. Car to Go Sweden AB / Hedin IT AB
Case No. D2022-1630

1. The Parties

The Complainant is Caetano Retail España S.A.U., Spain, represented by ArteLey, Spain.

The Respondent is Car to Go Sweden AB / Hedin IT AB, Sweden, represented by Advokatfirman Delphi, Sweden.

2. The Domain Name and Registrar

The disputed domain name <carplus.com> is registered with Name SRS AB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 5, 2022. On May 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 9, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on May 9, 2022, 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 May 11, 2022.

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 May 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 7, 2022. The due date for submission of the Response was extended until June 11, 2022, in accordance with paragraph 5(b) of the Rules. The Response was filed with the Center on June 10, 2022.

The Center appointed Jane Seager as the sole panelist in this matter on June 27, 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 is a Spanish company, active in the automotive sector, including the sale and purchase of used cars. The Complainant's parent company, Grupo Salvador Caetano -AUTO- SGPS, S.A., employs some 6,750 people, with retail shopfronts in Colombia, Portugal, and Spain. For use in connection with its used car business, the Complainant together with its affiliated company, Rigor-Consultoria e Gestao, S.A, is the owner of, *inter alia*, the following intellectual property rights:

- European Union Trade Mark No. 018124801, CARPLUS (figurative), registered on May 22, 2020;
- Portuguese Establishment Insignia (Old Law) No. 13169, CARPLUS (figurative), registered on September 14, 2004;
- Portuguese Logotype No. 51469, CARPLUS, registered on September 14, 2004;
- Portuguese Trademark No. 348642, CARPLUS AUTO MEGASTORE (figurative), registered on September 14, 2004;
- Portuguese Trademark No. 660072, CARPLUS MUITO MAIS QUE UM USADO (figurative), registered on June 7, 2021; and
- Spanish Trademark No. M2967519, CARPLUS IBERICAR OCCASION (figurative), registered on October 6, 2011.

The Respondent is a subsidiary of Hedin Mobility Group AB, a Swedish company operating some 200 car dealerships in 7 countries. The Respondent provides car leasing services and under the name and trademark CARPLUS.

On October 3, 2012, the Respondent registered the domain name <carplus.se>. Since 2013, the Respondent has used the domain name <carplus.se> to resolve to a website promoting its car leasing services.

The Respondent is the owner of the following trademark registration;

- Norwegian Trademark Registration No. 310637, CARPLUS (figurative), registered on July 8, 2020.

The Respondent has also filed trademark applications for CARPLUS before the European Intellectual Property Office ("EUIPO"), the Swiss Institute for Intellectual Property, and the United Kingdom Intellectual Property Office ("UKIPO"). The Complainant's parent company has filed oppositions against the Respondent's trademark applications before the EUIPO and UKIPO.

The disputed domain name was first registered on September 8, 1997. The Respondent acquired the disputed domain name from a third party on June 30, 2020. The disputed domain name redirects to the Respondent's website at the domain name <carplus.se>.

On July 3, 2020, the Complainant's authorized representatives sent a notice of trademark infringement to the Respondent, requesting transfer of the disputed domain name. The Respondent replied to the Complainant, asserting rights and legitimate interests in the disputed domain name, and refusing to transfer the disputed domain name to the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant asserts rights in the trademark CARPLUS. The Complainant submits that the disputed domain name is identical to the CARPLUS trademark in which the Complainant has rights.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant asserts that the Respondent is using the disputed domain name for commercial gain by misleadingly diverting consumers to the Respondent's website, which offers products and services which compete with those offered by the Complainant. The Complainant argues that the "mere fact of selling goods of a certain type is not sufficient to prove the existence of rights or legitimate interests to use an earlier registered distinctive sign with similar or identical goods or services", and that the Respondent is "carrying on a commercial activity identical to that carried on by the Complainant."

Under the third element, the Complainant asserts rights in the CARPLUS trademark dating back to 1999. The Complainant argues that by redirecting Internet users to the Respondent's website at "www.carplus.se", consumers are attracted to a range of products and services that match those of the Complainant. The Complainant asserts that the Respondent offers its products and services on the Swedish market without having industrial property rights over them. The Complainant further argues that the circumstances of the present case indicate that the Respondent acquired the disputed domain name for the purpose of selling the disputed domain name to the Complainant. The Complainant submits that the Respondent was aware of the Complainant's CARPLUS trademarks, and sought to register an identical trademark before the EUIPO in order to gain a commercial advantage over the Complainant.

The Complainant requests transfer of the disputed domain name.

B. Respondent

The Respondent argues that the disputed domain name is not confusingly similar to the Complainant's trademarks, as the Complainant's trademarks are not word marks, but rather stylized figurative trademarks, which does not automatically confer rights in the term "carplus" on the Complainant. The Respondent also notes that a number of the Complainant's trademarks include additional textual elements, *e.g.*, CARPLUS IBERICAR OCCASION and CARPLUS MUITO MAIS QUE UM USADO. The Respondent argues that the Complainant does not have better or prioritized rights to the term "carplus" or to the disputed domain name simply based on the fact that the Complainant has registered figurative trademarks including the term "carplus". The Respondent further claims that the term "carplus" may be found to be descriptive for some car-related services, and therefore the disputed domain name should be free for the Respondent to use for the marketing and provision of car-related services in general, irrespective of the Complainant's alleged trademark rights.

The Respondent submits that it has rights or legitimate interests in respect of the disputed domain name. The Respondent asserts that it has used the CARPLUS trademark since 2012 for the sale and marketing of services in relation to private leasing of cars. The Respondent has applied for a number of trademarks for "CARPLUS", and since July 8, 2020, the Respondent has owned a duly registered Norwegian trademark for CARPLUS. The Respondent notes that its business model consists of the sale and marketing of services in relation to private leasing of cars, and argues that its business is commonly known under the name "Carplus", which is reflected in the disputed domain name. The Respondent submits that the disputed domain name was acquired in 2020 as part of the Respondent's strategy of international expansion in Europe. The Respondent observes that it has made use of the domain name <carplus.se> for ten years.

The Respondent denies having registered or used the disputed domain name in bad faith. The Respondent submits that its use of the disputed domain name reflects a fair use, with no intent to misleadingly divert consumers or to tarnish the Complainant's trademarks. The Respondent argues that the Parties' services target different groups in different geographic regions, therefore the Respondent would not benefit from the

misdirection of customers confusing the Respondent's business with that of the Complainant. The Respondent claims that it is evident from the Respondent's press release regarding its acquisition of the disputed domain name that it had no intention of selling the disputed domain name to the Complainant with an aim of profiting from its sale. The Respondent submits that there is no evidence that the Respondent's use of the disputed domain name to redirect to its website at "www.carplus.se" has resulted in any actual confusion on the part of consumers seeking the Complainant's website.

The Respondent submits that the Complainant has failed to satisfy the requirements of paragraph 4(a) of the Policy, and requests that the remedies requested by the Complainant be denied.

6. Discussion and Findings

In order to prevail, the Complainant must demonstrate on the balance of probabilities that it has satisfied the requirements of paragraph 4(a) of the Policy:

- (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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

Where the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case; see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1. Panel assessment of identity or confusing similarity involves comparing the (alpha-numeric) domain name and the textual components of the relevant mark. To the extent that design (or figurative/stylized) elements would be incapable of representation in domain names, these elements are largely disregarded for purposes of assessing identity or confusing similarity under the first element; see [WIPO Overview 3.0](#), section 1.10.

The Complainant has produced evidence of a number of trademarks whose dominant textual element consists of CARPLUS, the registration details of which are provided in the factual background section above. The Panel finds that the Complainant has established rights in the CARPLUS trademark for purposes of paragraph 4(a)(i) of the Policy.

The disputed domain name reproduces the textual elements of the Complainant's CARPLUS trademark, under the generic Top-Level Domain ("gTLD") ".com", which may be disregarded for purposes of assessment under the first element; see [WIPO Overview 3.0](#), section 1.11.1. The Panel finds the disputed domain name to be identical to the textual elements of the Complainant's CARPLUS trademark; see *Majid Al Futtaim Properties Llc v. Domain-It Hostmaster, Domain-it!, Inc.*, WIPO Case No. [D2021-0591](#) (<citycenter.com>).

The Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant's case is founded on the notion that the Respondent is using the disputed domain name to misleadingly divert consumers to the Respondent's website. The Respondent argues in reply that it acquired and is using the disputed domain name as part of a *bona fide* business offering.

As noted above, the disputed domain name redirects to the Respondent's website at "www.carplus.se" – a Swedish-language website advertising private car leasing services. The Panel notes that the Respondent

appears to have made substantial investments in development of its website at “www.carplus.se”, having made use of the same domain name since at least 2013. The Respondent’s website provides comprehensive information about the Respondent’s identity, business and service offering, as well as information about its two physical Carplus-branded locations near Helsingborg and Stockholm, Sweden.

The Respondent has provided a credible explanation for its acquisition of the disputed domain name from a third party in June 2020, *i.e.*, to provide an international landing page for Internet users to access localized websites. The Respondent’s current redirection of the disputed domain name to its Swedish-language website is not inconsistent with the Respondent’s stated business plan. For use in connection with its car leasing operations, the Respondent has been granted a Norwegian trademark registration for CARPLUS.

The Panel further notes that the nature of the services offered by the Complainant differs slightly from those offered by the Respondent in that the Complainant is engaged in the sale and purchase of used vehicles, rather than vehicle leasing services as offered by the Respondent. The respective representation of “carplus” differs between the Parties in that the Complainant’s trade dress employs a red, white, and blue colour scheme, whereas the Respondent makes use of a black, white, and orange colour scheme. In addition, the Parties appear to operate in distinct geographic regions from one another. The Complainant’s primary operating languages appear to be Portuguese and Spanish, whereas the Respondent’s website is entirely in Swedish. Critically, there is no evidence of actual user confusion on the part of consumers seeking the Complainant.

Having considered the evidence provided by the Parties, the Panel is of the view that the Complainant has failed to substantiate its claim that the Respondent is using the disputed domain name by misleadingly diverting consumers seeking the Complainant’s trademark to the Respondent’s website. Rather, the evidence indicates that the Respondent has made use of the disputed domain name in connection with a *bona fide* offering of goods or services, as contemplated by paragraph 4(c)(i) of the Policy. In light of the Respondent’s longstanding use of the domain name <carplus.se>, its registration of a Norwegian trademark for CARPLUS, and evidence of the Respondent’s development of the CARPLUS brand, the Panel further finds that the Respondent appears to have become commonly known by a name corresponding to the disputed domain name, pursuant to paragraph 4(c)(ii) of the Policy.

For reasons set out above, the Panel finds that the Complainant has failed to establish the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

As set out under the Parties’ contentions above, the Complainant argues that by redirecting Internet users to the Respondent’s website at “www.carplus.se”, consumers are attracted to a range of products and services that match those of the Complainant, and that the circumstances of the present case indicate that the Respondent acquired the disputed domain name for the purpose of selling the disputed domain name to the Complainant.

For reasons set out under the preceding element, the Panel finds that there are no circumstances present indicating that the Respondent acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the disputed domain name, as set out in paragraph 4(b)(i) of the Policy.

Nor has the Complainant demonstrated that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s CARPLUS trademark as to the source, sponsorship, affiliation, or endorsement the Respondent’s website and the goods and services offered therein, in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

The Panel finds that the Complainant has failed to establish the requirements of paragraph 4(a)(iii) of the Policy.

Notwithstanding the Panel's findings above, the Panel observes that the present matter appears to fall under a broader ongoing trademark dispute between the Parties, who are engaged in opposition proceedings before the EUIPO and the UKIPO regarding the Respondent's trademark applications. This decision is made without prejudice to the outcome of any claims of trademark infringement that either party may bring against the other before a court of competent jurisdiction or a trademark-administrative body.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Jane Seager/

Jane Seager

Sole Panelist

Date: July 13, 2022