

## **ADMINISTRATIVE PANEL DECISION**

Mercedes-Benz Group AG v. M.W.

Case No. D2023-2679

### **1. The Parties**

The Complainant is Mercedes-Benz Group AG, Germany, represented by Heumann Intellectual Property Law, Germany.

The Respondent is M.W., Netherlands (Kingdom of the).

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

The disputed domain name <mercedes.luxe> is registered with Sav.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 22, 2023. On June 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 22, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 23, 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 amended Complaint on June 28, 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”).

On June 23 and 29, 2023, the Respondent sent informal emails.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 30, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 20, 2023. On June 30, 2023 and July 4, 2023, the Respondent submitted further emails. The Response was filed with the Center on July 5, 2023.

On July 5, 2023, the Complainant filed an amended complaint following the Respondent's offer of June 30, 2023 to buy out the disputed domain name.

The Center appointed Taras Kyslyy as the sole panelist in this matter on August 8, 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.

On August 13, 2023, the Respondent once again sent his position on the merits to the Center and the Panel.

#### **4. Factual Background**

The Complainant is one of the leading automobile manufacturers including luxury cars. Its trademark MERCEDES has enjoyed protection around the world for more than 100 years, including for instance the United States of America registration No. 41127, registration date September 15, 1903.

The disputed domain name was registered on January 15, 2023 and did not resolve to any active website. At the time of the decision, the disputed domain name resolved to a webpage with pay-per-click links related to the Complainant's business activities. The Respondent offered the Complainant to buy out the disputed domain name for EUR 2,900.

#### **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 it is known worldwide as an automobile brand. As the Complainant is one of the largest luxury car manufacturers in the world, amongst other branded merchandise, the disputed domain name suggests that it is originating from the Complainant or there is at least cooperation between the Complainant and the Respondent. No legitimate offer of goods or services has been made under the disputed domain name. Due to the lack of content on the disputed domain name, it has not been used for any purpose whatsoever. The Respondent is not known under the disputed domain name. The Respondent made an offer to sell the disputed domain name to the Complainant for EUR 2,900, which was an attempt to sell it expensively to the Complainant. There is no evidence that the Respondent registered the disputed domain name in connection with a *bona fide* offering of goods or services, or for any reason other than to receive profit from its transfer. The Respondent has no registered trademarks corresponding with the disputed domain name. The disputed domain name uses the world-famous trademark (also known by the Respondent) of the Complainant.

##### **B. Respondent**

The Respondent contends that he acquired the disputed domain name fairly and lawfully without any knowledge of possible infringement of trademark rights or any other form of impropriety. The Respondent's intention was to establish an online presence and offer services relevant to the concept of "luxury." The domain name extension ".luxe" does not belong to the traditional top-level domains ("TLD"s) such as ".com", ".org", or ".net", but rather is a specific extension related to the concept of luxury. As this extension is specific and not widely used, the Respondent was unaware of any potential conflicts with existing trademark rights.

The Respondent also contends that the "word Mercedes has other meanings and applications beyond the specific automotive brand referred to by the Complainant. It can, for example, be a name of a person, an animal, or a blog. In fact, "Mercedes" is derived from the Latin word "mercies" meaning mercy. In Spanish, Mercedes is also a female given name derived from "María de las Mercedes", one of the titles of the Virgin

Mary in the Roman Catholic tradition”. The Respondent claims that the use of the word “Mercedes” in his domain name does not necessarily refer to the specific automotive brand claimed by the Complainant.

The Respondent had engaged in communication with the Complainant’s representative regarding the possibility of selling the disputed domain name and to negotiate a fair and reasonable sale however, the Complainant rejected the offer. Based on these circumstances, the Respondent believes that the registration and use of the disputed domain name are legitimate and conducted in good faith.

## **6. Discussion and Findings**

### **A. Supplemental Filings**

Neither the Rules nor the Supplemental Rules make provision for supplemental filings, except at the request of the panel (see Rules, paragraph 12). Paragraph 10 of the Rules enjoins the panel to conduct the proceeding “with due expedition”. Therefore, UDRP panels are typically reluctant to countenance delay through additional rounds of pleading and normally accept supplemental filings only to consider material new evidence or provide a fair opportunity to respond to arguments that could not reasonably have been anticipated. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.6, and cases cited therein.

The Complainant’s supplemental filing provides for its position in response to the offer to buy the disputed domain name made by the Respondent after the Complaint was filed. The Panel finds this relevant and important for the case review and the Complainant obviously was not aware of the offer at the time of the Complaint filing. Thus, the Panel accepts the Complainant’s supplemental filing.

The Respondent’s supplemental filing in fact is a copy of his previously filed Response without adding any relevant previously unknown evidence or arguments. Thus, the Panel does not accept this supplemental filing.

### **B. 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 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 Complainant’s mark without any additions is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the Complainant’s mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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

### **C. 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.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. While the Respondent referred to various possible meanings of “mercedes” word, it did not explain what meaning exactly it had in mind when incorporating “mercedes” in the disputed domain name and how it was going to use the disputed domain name avoiding association with the famous Complainant’s trademark. On the contrary, the Respondent stated that its intention was to establish an online presence and offer services relevant to the concept of “luxury”, which does not plausibly match with any other meaning mentioned by the Respondent (name of a person, an animal, or a blog, title of the Virgin Mary), other than luxury automotive brand of the Complainant. Thus, the Panel finds that the Respondent has not convincingly 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 name.

The available evidence does not confirm that the Respondent is commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent, thus no actual or contemplated *bona fide* or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

The Respondent has no right or legitimate interests in the disputed domain name resolving to an inactive website (see, e.g., *Philip Morris USA Inc. v. Daniele Tornatore*, WIPO Case No. [D2016-1302](#)). Also, according to section 2.9 of the [WIPO Overview 3.0](#) 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 mark or otherwise mislead Internet users. The Panel finds these apply to the present case concerning the initial non-use and further PPC use of the disputed domain name.

Noting the high risk of implied affiliation between the disputed domain name and the identical well-known trademark of the Complainant, the Panel finds that there is no plausible fair use to which the disputed domain name could be put that would not have the effect of being somehow connected to the Complainant (see, e.g., *Instagram, LLC v. Super Privacy Service LTD c/o Dynadot / Zayed*, WIPO Case No. [D2019-2897](#)).

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

#### **D. 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 name identical to the well-known trademark of the Complainant, uses it to host a parked page comprising PPC links and offered the disputed domain name for sale to the Complainant.

According to section 3.1.4 of the [WIPO Overview 3.0](#) the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is convinced that the Complainant’s trademark is well established through long and widespread use and the Complainant has acquired a significant reputation and level of goodwill in its trademark internationally. Thus, the Panel finds that the disputed domain name identical to the Complainant’s trademark was registered in bad faith.

According to paragraph 4(b)(iv) of the Policy the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location. Using the disputed domain name to host a PPC parking page the Respondent creates a likelihood of confusion with the Complainant's trademark and potentially obtains revenue from this practice. Under such circumstances, the Panel finds that the disputed domain name is being used in bad faith.

Paragraph 4(b) of the Policy provides the following scenario constitutes evidence of a respondent's bad faith: circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name. The Panel finds that the Respondent's offer to sell the disputed domain name for EUR 2,900 confirms his intent to register the disputed domain name to sell it for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the disputed domain name.

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

## **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 <mercedes.luxe> be transferred to the Complainant.

*/Taras Kyslyy/*

**Taras Kyslyy**

Sole Panelist

Date: August 24, 2023