

## **ADMINISTRATIVE PANEL DECISION**

RockAuto LLC v. Victor Zuo  
Case No. D2024-1191

### **1. The Parties**

The Complainant is RockAuto LLC, United States of America (“United States”), represented internally.

The Respondent is Victor Zuo, Canada, self-represented.

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

The disputed domain name <rockautoaccs.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 19, 2024. On March 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 21, 2024, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on 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 March 21, 2024.

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 April 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 30, 2024. The Response was filed with the Center on April 27, 2024. The Complainant filed a Supplemental Filing on April 29, 2024.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on May 6, 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.

On May 17, 2024, the Panel issued Procedural Order No. 1 to the Parties in which the Panel noted that it had decided to admit the Complainant's supplemental filing, and accordingly, provided the Respondent with the opportunity to respond thereto until May 24, 2024. Additionally, Procedural Order No. 1 requested the following pursuant to paragraphs 10 and 12 of the Rules:

1. The Complainant should provide details of the extent of its business in Canada predating the registration of the disputed domain name, and in particular should substantiate with independent evidence its assertion that it "spends millions of dollars advertising its name" particularly as regards advertising spend in Canada or as regards its spending on an online presence that is accessible in Canada. The Complainant should provide independent evidence to support the fact that it has been supplying the Canadian market since February 6, 2001, conform to the claim in its registered Canadian trademark. Conclusory allegations will not suffice.

2. The Respondent should explain why, when the Panel observed the current website associated with the disputed domain name, it was noted to redirect to a website at "www.rokiotoex.com", which is branded "ROKIOTOEX". The Respondent should also explain why the "About ROKIOTOEX", "Privacy Policy & Security" and "Terms & Conditions" links all appear to redirect to the homepage of the website and do not contain any information about the operator of said website. The Respondent should explain the relationship between this brand and the name of its company/the disputed domain name.

3. The Respondent should explain why, when the Panel observed the archived version of the website associated with the disputed domain name on the Internet Archive "Wayback Machine", the entry dated March 27, 2024 was largely of the same appearance but was branded "ROCKAUTOACCS" and did not redirect to "www.rokiotoex.com". See:  
<https://web.archive.org/web/20240327120737/https://www.rockautoaccs.com/>

4. The Respondent should explain why, when the Panel observed an earlier archived incarnation of said website dated November 7, 2020, this was however noted to redirect to a website at "www.rokiotoex.com" with an HTTP 301 redirect. See:  
<https://web.archive.org/web/20201107231443/www.rockautoaccs.com>

The Parties were directed to respond to Procedural Order No. 1 within seven days, i.e., May 24, 2024, and were invited to comment upon each other's submission within a further five days, i.e., May 29, 2024. The due date for the Decision was extended to June 7, 2024.

On May 21, 2024, the Complainant filed a signed Affidavit in response to point 1 above of Procedural Order No. 1. On May 24, 2024, the Respondent filed its response to points 2 to 4 above of Procedural Order No. 1. On May 29, 2024, the Complainant filed its comments upon the Respondent's submission. On May 31, 2024, the Respondent filed its comments upon the Complainant's submission.

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

The Complainant is a limited liability company based in Madison, Wisconsin, United States. The Complainant sells automotive parts via a website associated with the domain name <rockauto.com>, which was registered on May 27, 1999.<sup>1</sup>

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<sup>1</sup>The Complainant did not supply a Whois record for said domain name and the Panel performed its own Whois lookup in this respect. The Panel also visited the website associated with the disputed domain name and versions of it on the Internet Archive "Wayback Machine". On the topic of a panel conducting such independent research of publicly available sources, see section 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant is the owner of various registered trademarks, namely, United States Registered Trademark Number 5339980 in respect of the word mark ROCKAUTO, registered on November 21, 2017, in Class 35 (online and offline wholesale and retail store services featuring automotive parts, supplies, tools and accessories), and United States Registered Trademark Number 2866795 in respect of a device mark including a stylized representation of the words ROCKAUTO.COM, registered on July 27, 2004, in Class 35 (broadly similar goods and services). The Complainant is also the owner of Canadian Registered Trademark Number TMA853888 for the same stylized representation of the words ROCKAUTO.COM, registered on June 25, 2013, in respect of “On-line retailing and wholesale distributorship services, retail store services, catalog mail order services and telephone order services, all in the field of automotive parts and tools; providing consumer product information, via a website on a global computer network, on automotive parts and tools for sale.” Said mark contains a claim of use in Canada since February 6, 2001.

The Complainant’s “www.youtube.com” channel has 62,400 subscribers and features 202 videos, the earliest of which shows that it was uploaded 15 years ago. The Complainant joined YouTube on April 30, 2009, and its videos have been viewed over 51,500,000 times. Many of these videos consist of clips of a television program named “TechGarage Presented by RockAuto.com”, which appears from the video listings to have had at least nine seasons. The Complainant asserts (and the Respondent does not deny) that this program airs or is otherwise receivable in Canada.

The disputed domain name was registered on October 25, 2018. The Respondent appears to be an individual with an address in Alberta, Canada. In an email to the Center dated April 27, 2024, the Respondent lists itself as “General Manager, Rock Auto Accs Inc.”. The Respondent provides evidence that the latter entity is a corporation registered in Alberta, Canada, on January 8, 2019. The website associated with the disputed domain name redirects to a website at “www.rokiotoex.com”, which is branded “ROKIOTOEX” and appears to offer a variety of exterior parts for automobiles, including roof rails, kayak and boat carriers, side steps, and mud guards. The “About ROKIOTOEX”, “Privacy Policy & Security”, and “Terms & Conditions” links all appear to redirect to the homepage of the website and do not contain any information about the operator of said website. This represents a change from the archived version of the website associated with the disputed domain name on the Internet Archive “Wayback Machine” dated March 27, 2024, which was largely of the same appearance but was branded “ROCKAUTOACCS” and did not redirect to “www.rokiotoex.com”. An earlier archived incarnation of said website dated November 7, 2020, did however redirect to “www.rokiotoex.com” with an HTTP 301 redirect.

The website associated with the disputed domain name contains telephone contact numbers at the top right hand edge. The archived incarnation of said site dated March 27, 2024, shows that the statement “We Are Not Rock Auto” has been inserted beside one of the contact numbers.

## **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 the disputed domain name consists of the Complainant’s trademark along with the term “accs”, and that adding such term does not sufficiently distinguish it from said mark. The Complainant asserts that its ROCK AUTO mark was first used in commerce in 2000 and consists of two otherwise unrelated words, adding that it spends millions of dollars advertising its name. The Complainant suggests that it is inconceivable that the Respondent would compound these two unrelated words to compete in the same industry without knowledge of the Complainant’s brand, adding that the Respondent was not authorized to use such mark or to apply for any domain name incorporating it. The Complainant notes that there is no evidence that the Respondent has been or is commonly known by the disputed domain name or has acquired corresponding trademark rights. Finally, the Complainant submits that the disputed domain name leverages the notoriety of its mark to attract users to the Respondent’s website, which features

services directly competing with the Complainant's offering, consistent with a finding of registration or use in bad faith. The Complainant concludes that the Respondent has intentionally attempted to attract Internet traffic to its website at the disputed domain name by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, endorsement of or affiliation with the said website.

## **B. Respondent**

The Respondent contends that the Complainant has not satisfied the elements required under the Policy for a transfer of the disputed domain name. Notably, the Respondent submits that it is based in Canada and asserts that its company name was inspired by the Royal Oak Community, Calgary showing the alleged proximity between this district and the Respondent's claimed location on a map extract. The Respondent states that when it registered its domain name "years ago" it was not alerted about any similar domain name. The Respondent asserts that it has been in the car outer body accessory industry for years and produces the certificate of incorporation of Rock Auto Accs Inc., dated January 8, 2019, together with a registration statement of the same entity, which indicates that an Alberta NUANS search was carried out regarding the availability of such corporate name on December 15, 2018.

The Respondent submits that it has never acted in bad faith, and notes that while it operates in the "outer body accessories" industry, the Complainant operates in the "parts industry". The Respondent asserts that the Parties do not have any overlap in terms of products, and that for this reason it has never taken a sale from the Complainant. The Respondent asserts that it has received many inquiries from people asking for the Complainant, adding, "This has been a major pain point for us, as we are a small family-owned business", which has "very limited resources to be handling customer service for both companies". The Respondent claims to have redirected "each lost customer". The Respondent asserts that it has begun to tell customers that it is based in Canada via its automated voice message, and that it does not sell parts "under the hood (what many customers are looking for)". The Respondent submits that all of its business operations are tied to the disputed domain name, and that it never imagined there to be any issues from a similar domain name.

## **C. Complainant's supplemental filing**

The Complainant notes that the Respondent asserts that it is based in Canada, and points out that its trademark is also registered in Canada, adding that such mark was registered years before the creation of the Respondent's company or website. The Complainant submits that the alleged inspiration behind the Respondent's company name makes no material connection between such name and the community concerned. The Complainant contends that the Respondent's assertion that there is no overlap between the Parties in terms of products offered is false, adding that a simple search of the Complainant's website (evidence provided) can validate that the Complainant provides outer auto body accessories. The Complainant asserts that the Respondent's submission that it has been receiving calls intended for the Complainant is evidence that the Respondent has leveraged the notoriety of the Complainant to attract users to its website by creating a likelihood of confusion with the Complainant's mark. The Complainant adds that there is a statement on the Respondent's website in small letters in the upper right corner, noting "We are not Rock Auto", and that this shows the Respondent's awareness of its infringement of the Complainant's rights. The Complainant asserts that the Respondent's submission that it may ask the Panel to make a finding of reverse domain name hijacking is without merit as the Complainant's rights in Canada predate the Respondent's website and company, which is actively trading in the same industry.

## **D. Complainant's response to Procedural Order No. 1**

The Complainant's response consists of an Affidavit, prepared by the Complainant's Customer Service Director, which in summary states as follows:

The fact that the Complainant ships thousands of parts from hundreds of manufacturers to millions of customers all over the world may be attested to on the Complainant's website (linking to a page on said site that repeats such claims). The Complainant ships orders to Canadian customers daily, as may be confirmed

by visiting the Complainant's website and adding products to the shopping cart, whereby it can be confirmed that the Complainant serves Canadian customers and will ship an order to any Canadian address where major couriers including the Canadian Post Office, FedEx, UPS or DHL can deliver packages. The Complainant's website provides a live quote for shipping and delivery times to Canadian addresses, and allows visitors to view prices in Canadian Dollars (CAD). The Complainant has also translated its website including over a million product lines into French so that Francophones in Canada (over 20% of the

population) can access this in their own language. The Complainant's business in Canada may be independently observed according to numerous reviews received from Canadian customers, many of whom note that they have been ordering from the Complainant for years. Five examples are offered, with two of these stating that the Canadian customers concerned had used the Complainant for eight years and over a decade respectively. The Complainant's online presence, accessible in Canada, is demonstrated via Google Keyword Ads and its YouTube presence. Its commercials are found on YouTube, together with clips from the television program "TechGarage" featuring the Complainant, whose airing reaches Canadian audiences.

#### **D. Respondent's response to Procedural Order No. 1**

In summary, the Respondent contends as follows:

Point 2. The Respondent's company operates via the disputed domain name as its retail business site. The Respondent's primary product brand has always been Rokioetox. Before the Respondent was incorporated in 2019, it used the domain name <rokioetox.com>. Due to the lock arising from the administrative proceeding, the Respondent has redirected its retail site to its older brand site in order to ensure timely product updates and site maintenance.

Point 3. The disputed domain name has consistently been the Respondent's domain name.

Point 4. In 2020, the Respondent's website underwent reconstruction and optimization, necessitating the temporary redirection to the old brand site to ensure seamless operation.

At the time that the disputed domain name was registered, the Respondent was unaware of the Complainant. The disputed domain name represents the Respondent's company name and aligns with its business activities. It has been an integral part of the Respondent's business for six years. Recent customer inquiries led to the Respondent's recognition of potential confusion between the Parties. The Respondent subsequently made explicit declarations on its website clarifying that it was a separate entity from the Complainant, aiming to redirect customers appropriately. Such a proactive approach cannot be considered an acknowledgment of infringement, and it demonstrates that the Respondent is not acting in bad faith but endeavoring to find a solution. The Respondent can only redirect the Complainant's customers by referencing the Complainant's company name. The Respondent's awareness of the Complainant dates from notification of the Complaint, and the Complainant had never reached out to the Respondent before then. It could not be expected to know about all foreign companies and their marks when it registered the disputed domain name.

#### **E. Complainant's comments on Respondent's response to Procedural Order No. 1**

The Complainant comments as follows:

The Respondent's claim of lack of awareness of the Complainant at the point of registration of the disputed domain name does not remove the Respondent's responsibility to ensure it is not copying registered trademarks. The Respondent should not be allowed to apply for the disputed domain name using its company name when both names violate a registered mark.

The Respondent's assertion that it should not be expected to know about all foreign companies does not excuse its actions as the Complainant's trademark is registered in the same country and industry, and for 20 years before the Respondent registered its business and domain names. The Respondent's assertion that

its use of the disputed domain name predates its knowledge of the Complainant is false as the Complainant had operated in the Canadian marketplace for decades prior to the Respondent registering its domain name and the Complainant's Canadian trademark was registered in 2013, predating the disputed domain name.

The Complainant had reached out to the administrators of the disputed domain name regarding the Respondent's website and to the Respondent directly via its phone numbers, although these only allow SMS text and the Complainant received no response to its inquiry.

#### **F. Respondent's comments on Complainant's response to Procedural Order No. 1**

The disputed domain name registration and the Respondent's company name registration were executed legally and do not violate any regulations. The Parties are distinct entities without connection, eliminating potential conflicts of interest. Taken as a whole, their names are different. Their product ranges are different. The Respondent has not used the Complainant's name for advertising or marketing. The Respondent started receiving contacts from the Complainant's customers in 2023, because the Complainant's customer service is lacking, and the Respondent has guided these customers to the correct contact. The Complainant's allegations are defamatory, baseless, and unfounded.

The Respondent produces a search engine screenshot for the search "rockauto". The first result refers to a Better Business Bureau entry relating to the Complainant. The second result is placed by what appears to be a third party competitor of the Complainant under the heading "RockAuto Alternative in Canada". The entry notes "Consider the Canadian alternative to RockAuto.com! Competitive prices and Free shipping are the perks! Your one-stop online shop with a comprehensive...". The remaining three entries in the search engine result also appear to relate to the Complainant's business, including a discussion on "Reddit", a customer review, and a forum discussion.

### **6. Discussion and Findings**

#### **A. Preliminary Issue – Complainant's Supplemental Filing**

Paragraph 10 of the UDRP Rules vests the Panel with the authority to determine the admissibility, relevance, materiality, and weight of the evidence, and also to conduct the proceedings with due expedition. Paragraph 12 of the UDRP Rules expressly provides that it is for the Panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case.

Unsolicited supplemental filings are generally discouraged, unless specifically requested by the Panel. Panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response (e.g., owing to some "exceptional" circumstance). Depending on the content of any admitted supplemental filing, the panel may issue further instructions to the parties, including a rebuttal/reply opportunity to the non-initiating party. [WIPO Overview 3.0](#), section 4.6.

In the present case, the Panel decided to admit the Complainant's supplemental filing because it could not reasonably have anticipated certain aspects of the Respondent's case, notably that the Respondent was engaged in a different type of parts business, and that it had allegedly come by its name independently of the Complainant and its rights due to the contraction of a district name in its local area. The Panel decided in accordance with the consensus view described in the [WIPO Overview 3.0](#), section 4.6, that the Respondent should be accorded a rebuttal/reply opportunity. At the same time, the Panel took the opportunity to ask both Parties to supplement their cases in respects which the Panel considered would be helpful to it in making its decision in the administrative proceeding. Accordingly, the Panel issued Procedural Order No. 1 as described above and has factored the Parties' responses (as summarized in the Parties' contentions section above) and any associated evidence into its decision.

The Panel notes that the Respondent's comments were received after the deadline provided in Procedural Order No. 1. The Panel has decided to admit these notwithstanding their lateness as the delay was not significant. It has not affected the due date for the Decision and the Panel has not identified any prejudice that would be suffered by the Complainant.

## **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 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 name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here, "accs", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name 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.

## **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.

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.

Here, the Panel finds that the Complainant has made out a prima facie case on the basis of the confusing similarity of the disputed domain name to the Complainant's registered trademark, which predates the registration of the disputed domain name and is registered in the Respondent's location, together with the Complainant's submissions that it is inconceivable that the Respondent would compound the same two unrelated words to compete in the same industry without prior knowledge of the Complainant's brand, and that the Respondent was not authorized to use the Complainant's mark or to apply for any domain name incorporating it. The Panel therefore turns to the Respondent's case to determine whether it has rebutted the Complainant's prima facie showing.

The Respondent's case is effectively that before notice to it of the dispute, it has been using the disputed domain name in connection with a bona fide offering of goods and services, conform to paragraph 4(c)(i) of the Policy, and alternatively that it has been commonly known by the disputed domain name (by way of its matching corporate name) conform to paragraph 4(c)(ii) of the Policy. To this end, the Respondent shows that it is incorporated in Canada under a name corresponding to the disputed domain name. It should be

noted however that the mere incorporation of a company with a name corresponding to a domain name does not typically, on its own, lead to a finding of rights and legitimate interests under the Policy (See: *Royal Bank of Canada v. RBC Bank*, WIPO Case No. [D2002-0672](#) in which the panel observed:

“If the intention of the Policy were otherwise, every cybersquatter would be able to avoid the operation of the Policy by the simple expedient of: (i) quietly registering someone else’s trademark as a corporation name (possibly in some jurisdiction having no connection with either the trademark owner or the cybersquatter); (ii) waiting some decent interval of time before registering the corporation name as a domain name; and (iii) resisting the trademark owner’s challenge under the Policy by claiming that the fact of the registration of the corporation proves that the corporation has been ‘commonly known by’ the corporation name/trademark/domain name, and therefore has a legitimate interest in the domain name.”)

The Respondent asserts that it is actively trading under such name via its website, and that it selected such name independently of the Complainant and its rights. However, on this last assertion in particular, there are substantive aspects of the Respondent’s case that do not stand up to the Panel’s scrutiny. The website associated with the disputed domain name seems at times to be named according to the disputed domain name, while at other times it is used as a mere redirection to a largely identical website branded “ROKIOTOEX”. The website itself is not fully complete in that it is missing information relating to the controlling entity and related contact details, while typical aspects of a trading business such as the “About Rokiotoex”, “Privacy Policy & Security”, and “Terms & Conditions” links do not appear to work. This suggests that the Respondent’s website may be pretextual. While the Respondent asserts in its reply that some of its website changes result from redevelopment (and ultimately from the disputed domain name being locked in accordance with the administrative proceeding), the Panel is nevertheless led by these apparent inconsistencies to consider whether the Respondent’s explanation for the selection of its corporate name is reasonably credible.

The suggestion that the Respondent came by its name solely due to its choice of a contraction of the Royal Oak Community’s name does not seem plausible to the Panel. To the Panel’s mind it has a flavor of being reverse-engineered to cover for the fact that it was actually selected because it closely matches the Complainant’s name and trademark. Notably, the Panel considers that “Royal Oak Community” would not be contracted to “Rock” by most people, and the Respondent has produced no evidence that this is a common or widely accepted or understood contraction/acronym, whether in that locality or otherwise. Further, the Respondent’s provided reason for its re-branding appears to have no association to the Respondent’s “primary product brand”, identified as “Rokiotoex”, and thus the Respondent’s sudden change in marketing via the registration of both the disputed domain name and its new company name that both reflect the Complainant’s trademark previously registered in Canada are too coincidental to be credible. As the Complainant notes, the Respondent has not made any material link between its business, which is an online offering, and the said community, other than its claim to be located nearby based on the map which it supplied.

For its part, the Complainant has pointed out that its ROCKAUTO.COM trademark has been registered in Canada since June 25, 2013, which is over five years before the disputed domain name was registered and five and a half years before the Respondent’s company was incorporated. The Complainant’s evidence demonstrates that the Parties are in the same line of business, notwithstanding the Respondent’s attempt to distinguish “under the hood” and outer body accessories, which the Panel finds to be somewhat disingenuous, given that the Complainant and Respondent evidently both sell parts for vehicles to consumers, and that in any event the Complainant has demonstrated that it also carries outer body accessories.

The Complainant’s evidence demonstrates that it supplies to the Canadian marketplace, and that it contributes to a television program and online videos with a substantial view number that are receivable in the Canadian marketplace, and commenced this activity long before the disputed domain name was registered. The Complainant has shown positive reviews from a selection of its Canadian customers which indicate that they have been using the Complainant’s business for eight and ten years respectively, supporting the longstanding nature of the Complainant’s connection to Canada.



The general impression conveyed by the Complainant's evidence is supported by the Respondent's own evidence in the form of its screenshot of an online search for "rockauto" in an unidentified search engine. All of the entries returned appear to reference the Complainant's business. For example, the entry "RockAuto Alternative in Canada" specifically references the Complainant's business and domain name. It appears to emanate from a third party business in Canada, given its use of the ".ca" country code Top-Level Domain in the URL "www.partsgo.ca". It is evident from this particular entry that not only is such a Canadian business clearly aware of the Complainant's business but is in fact presenting itself as an alternative to it by way of comparative advertising. This supports the Complainant's case that those in the auto parts business in Canada (such as the Respondent) would be, and are, fully aware of the Complainant's existence.

Given this evidence, the coincidence of the Respondent's name and coincidence of line of business, taken together, seem to the Panel to be coincidences too far, particularly in the face of the Complainant's equally longstanding registered trademark in the Respondent's location, which predates the Respondent's activities to a substantial degree, and covers the same goods and services allegedly supplied at the disputed domain name. In short, while the Respondent appears to be making an offer of goods and services under the related name, such an offering cannot be considered to be bona fide within the meaning of the Policy if it has at its root the intentional targeting of the Complainant's trademark rights and its goodwill.

In these circumstances, the Panel does not find a case to be made out by the Respondent in terms of either paragraph 4(c)(i) or paragraph 4(c)(ii) of the Policy, and accordingly finds that the Respondent has failed to rebut the Complainant's prima facie case that it has no rights and legitimate interests in the disputed domain name.

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.

A finding that a domain name has been registered and is being used in bad faith typically requires an inference to be drawn that the respondent has registered and is using such domain name to take advantage of its significance as a trademark owned by (usually) the complainant (see, for example: *British Airways Plc v. Softline Studios*, WIPO Case No. [D2023-2188](#)). It follows that the Complainant, on whom the burden of proof lies, must show on the balance of probabilities that the Respondent registered the disputed domain name in the knowledge of and with intent to target the Complainant and/or its rights in the trademark concerned.

In the present case, the Panel notes the longstanding nature of the Complainant's trademark, which is also registered in the Respondent's location. The Panel has rejected the Respondent's assertion that the Parties are in different lines of business as factually incorrect and indeed disingenuous. Both of the Parties are in the online auto accessories business. The Complainant's domain name was registered in 1999. Its earlier United States trademark was registered in July 2004. Its Canadian trademark was registered in 2013 and contains a claim of use in Canada since February 6, 2001. The Complainant's evidence shows substantial marketing activity by way of online videos and television programs. The Complainant asserts that these are receivable in Canada, and the Respondent has not denied this. The Respondent's own evidence shows that a third party Canadian business is conducting comparative advertising relating to the Complainant's business, presenting itself as an alternative.

In all the above circumstances, the notion that the Respondent would not have heard of the Complainant when it registered the disputed domain name in 2018 and incorporated a company in 2019 is not credible in the Panel's eyes, bearing in mind that the Parties are in the same line of business. Furthermore, the Respondent's suggestion that the similarity of the disputed domain name to the Complainant's mark and its own domain name is a coincidence, and that it was independently arrived at as a contraction of the name of

a nearby community is not credible based on the Panel's analysis above. As the Complainant points out, the combination of "Rock" with "Auto" is a relatively unusual portmanteau, and this too suggests the Respondent's prior knowledge of the Complainant, and its intent to target the Complainant's goodwill via the disputed domain name.

The Respondent has used the disputed domain name for an auto parts website, and occasionally merely to forward traffic to the website at "www.rokiotoex.com". The similarity of the disputed domain name to the Complainant's domain name and to its trademark, together with the use to which it has been put, suggests to the Panel 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 mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website, being evidence of registration and use in bad faith in terms of the Policy, paragraph 4(b)(iv). The evidence before the Panel shows that there has been actual confusion, a matter of admission by the Respondent, and the reason why it inserted the statement "We are not Rock Auto" on its website. The Respondent therefore effectively acknowledges that customers of the Complainant have been confused by the Respondent's business name and by the disputed domain name. The fact that the Respondent has been able to register a company name corresponding to the disputed domain name in its jurisdiction does not mean that, by virtue of that fact alone, it can escape the consequences of deliberately causing such confusion. Furthermore, based on the evidence before the Panel concerning the Respondent's likely knowledge of the Complainant's rights, the Respondent's registration and use of a domain name matching such corporate name cannot have been carried out in good faith.

The notice on the website associated with the disputed domain name in small letters in the upper right corner, stating "We are not Rock Auto" is effectively a disclaimer of association between the Parties (albeit that the nature of the disclaimer is itself highly confusing to Internet users, in that the Respondent's case is that it actually is "Rock Auto", at least in the sense of this being the first two words of its corporate name).

In cases where a respondent appears to otherwise have rights or legitimate interests in a disputed domain name, a clear and sufficiently prominent disclaimer would lend support to circumstances suggesting its good faith. On the other hand, where the overall circumstances of a case point to the respondent's bad faith, the mere existence of a disclaimer cannot cure such bad faith. In such cases, panels may consider the respondent's use of a disclaimer as an admission by the respondent that users may be confused. [WIPO Overview 3.0](#), section 3.7.

Here, the Panel notes that the disclaimer is not prominent and could easily be missed by a visitor to the website concerned, unless they are looking to contact the Respondent by SMS text. The Panel has not found that the Respondent otherwise has rights or legitimate interests in the disputed domain name. In these circumstances, the Panel agrees with the Complainant's submission that the presence of the disclaimer amounts to an admission that Internet users are confused by the disputed domain name, and indeed compounds the confusion further. It therefore supports the Panel's finding of registration and use in bad faith in the circumstances of this case.

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 name <rockautoaccs.com> be transferred to the Complainant.

*/Andrew D. S. Lothian/*

**Andrew D. S. Lothian**

Sole Panelist

Date: June 7, 2024