

ADMINISTRATIVE PANEL DECISION

Scania CV AB v. Moon Juncheol (문준철)

Case No. D2024-2129

1. The Parties

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

The Respondent is Moon Juncheol (문준철), Republic of Korea, self-represented.

2. The Domain Name and Registrar

The disputed domain name <scaniakorea.com> is registered with Gabia, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on May 24, 2024. On May 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 27, 2024, 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.

On May 27, 2024, the Center informed the parties in Korean and English, that the language of the registration agreement for the disputed domain name is Korean. On May 28, 2024, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 in English and Korean of the Complaint, and the proceedings commenced on June 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 25, 2024. The Respondent sent an email in Korean on June 7, 2024 to the Center indicating a willingness to resolve this case through a settlement with the Complainant. The Center sent an email regarding the possible settlement to the Parties on June 7,

2024. On June 11, 2024, the Complainant requested a suspension of the proceeding. On June 11, 2024, the Center confirmed that the proceeding was suspended until July 11, 2024. On June 20, 2024, the Complainant requested a reinstitution of the proceeding. On June 20, 2024, the Center issued a notice on the reinstitution of the proceeding. The due date for Response was set to July 4, 2024. The Respondent did not file any formal response. Accordingly, the Center notified the commencement of panel appointment process on July 5, 2024.

The Center appointed Kathryn Lee as the sole panelist in this matter on July 9, 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, founded in 1891 and registered as a Swedish company in 1962, manufactures trucks, buses, and engines for heavy transport applications, and sells service-related products and financing services. The Complainant has marketed and sold goods and services using the SCANIA trademark since 1911. Currently, the Complainant has 58,000 employees in over 100 countries, operates sites for production, assembly, or regional product centers in 11 countries, and has more than 1,500 service points internationally. In 2023, the Complainant had net sales of SEK 204 billion. The Complainant won the German Telematics Awards 2024 and secured the top spot for the best driver management and won the European Transport Award in the Electrified Trucks category in 2023. The Complainant is the owner of a number of trademark registrations for SCANIA around the world, including Korean Trademark Registration Number 4000653470000 registered on January 25, 2000, United States of America ("United States") Trademark Registration Number 0879387 registered on October 28, 1969, and International Registration Number 1415644 registered on January 24, 2018. Also, the Complainant is the owner of the domain name <scania.com> registered on March 8, 1996, which received 1.2 million individual visits in February 2024, making it the 41,072nd most popular website globally.

The Respondent appears to be an individual with an address in the Republic of Korea.

The disputed domain name was registered on July 8, 2023 and resolves to a website advertising a car tuning business called Enfold Construction with an address in Los Angeles, California.

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 is confusingly similar to the SCANIA mark in which the Complainant has rights, as it contains the SCANIA mark along with "korea" which is a generic, geographically descriptive term.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name and confirms that it has not authorized or licensed rights to the Respondent in any respect. In addition, the Complainant contends that on the website to which the disputed domain name resolves, the Respondent offers car tuning services for Audi and BMW cars which are competitors of the Complainant, and that this does not represent a bona fide offering of goods or services nor a legitimate noncommercial fair use of the disputed domain name. The Complainant also contends that the design and contents of the website is based on a WordPress website theme template created by a developer company named Kriesi.at, and that the contact information on the disputed domain name's website is likely fake and not associated with the Respondent.

Finally, the Complainant contends that the disputed domain name was registered and used in bad faith. The Complainant contends that the Complainant and its SCANIA trademark are known internationally with trademark registrations in numerous countries, including in the Republic of Korea where the Respondent is based, that the Complainant has a global presence and reputation, and that a search on Internet search engines for “scania korea” returns multiple links referencing the Complainant and its business. Based on this, the Complainant argues that the Respondent knew, or at least should have known, of the Complainant’s trademarks, when registering the disputed domain name. The Complainant also contends that the Respondent’s use of the disputed domain name for car tuning services for Audi and BMW brands which are competitors of the Complainant constitutes bad faith use. Given the composition of the disputed domain name, the confusing similarity of the disputed domain name to the Complainant’s trademark and domain name <scania.com>, and the use of the disputed domain name, the Complainant contends that it would be illogical to believe that the Respondent registered the disputed domain name without targeting the Complainant.

B. Respondent

The Respondent did not submit a formal reply to the Complainant’s contentions. However, after receipt of the Complaint, the Respondent indicated a desire to enter into a settlement with the Complainant and sent a reply to the Complainant in response to the Complainant’s proposal for a settlement without any compensation. In the response, the Respondent did not specifically address the elements required under the Policy but stated that as Scania Korea was established in Korea in 1995, it had sufficient time to register and use the disputed domain name, and that the Complainant’s failure to do so indicates its lack of interest in the disputed domain name. The Respondent also stated that it is expecting compensation for transfer of the disputed domain name to the Complainant.

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Korean. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the Complainant is unable to communicate in Korean, that preparing a translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceedings, and that the website linked to the disputed domain name display phrases in English such as “About us”, “Tuning File Services”, and “Our Tuning Options”.

The Respondent did not comment on the Complainant’s request for the language of the proceeding to be English but requested that the Complainant’s email communications on the possible settlement to the Respondent be in Korean.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.5.1). Here, the Panel notes that the disputed domain name is linked to a website advertising the services of a business with an address in Los Angeles, California, and that the website contains phrases in English.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

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 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 entirety of the mark is reproduced 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, korea – may bear on assessment of the second and third elements, the Panel finds the addition of such a 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.

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.

The website at the disputed domain name is essentially identical to the WordPress website design template that the Complainant found in terms of the layout, images, descriptions, and contact details, except for car tuning business rather than a construction business as on the template. In addition, online searches do not show any business by the name of “Enfold Construction” at the provided address. Based on this, it seems likely to the Panel that the Respondent simply used a template that it found on the Internet to which it made some changes to adopt a car related theme to give the appearance of bona fide use of the disputed domain name. However, the Panel finds that this was not convincing to show that the Respondent has rights or legitimate interests in the disputed domain name. Further, there is nothing in the record to suggest that the Respondent has made a legitimate noncommercial or fair use of the disputed domain name or has been commonly known by the disputed domain name, nor is there any evidence of the Respondent's demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services.

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 name which consists of the Complainant's trademark SCANIA and the country name "korea". Given the reputation associated with the Complainant's trademark, the Panel finds that it is unlikely for the Respondent to have registered it simply by chance. Even if the Respondent were unfamiliar with the Complainant, a simple online search would have shown numerous results on the Complainant and its mark. The Respondent has not provided an explanation for having registered the disputed domain name, and with no response to claim otherwise, the Panel finds that it is more probable that the Respondent was aware of the Complainant's trademark and learned of the availability of the disputed domain name and registered it primarily for the purpose of selling it to the Complainant for valuable consideration, in excess of the Respondent's documented out-of-pocket costs directly related to the domain name.

The disputed domain name resolves to what appears to be a fake website for a car tuning service business but there is no mention of the term SCANIA anywhere on the website. Further, while the disputed domain name contains the country name "korea", the business gives an address in the United States and there is no apparent connection to Korea at all except for a few words in Korean in the order sheet submission page for tuning services which appears to be nonfunctioning. In addition, the website is clearly unfinished because much of the content is Lorem ipsum, which is placeholder text used by designers in publishing in lieu of actual content. Based on the circumstances, and with no explanation from the Respondent as to why it registered the disputed domain name, the Panel is of the opinion that the Respondent has linked the disputed domain name to the website in order to avoid a possible negative UDRP decision.

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 <scaniakorea.com> be transferred to the Complainant.

/Kathryn Lee/

Kathryn Lee

Sole Panelist

Date: July 30, 2024