

## **ADMINISTRATIVE PANEL DECISION**

Scania CV AB v. Sergey Rodev  
Case No. D2024-2137

### **1. The Parties**

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

The Respondent is Sergey Rodev, Russian Federation.

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

The disputed domain name <scania-multi.com> (the "Domain Name") is registered with Registrar of Domain Names REG.RU LLC (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 Domain Name. On May 24, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Personal data, can not be publicly disclosed according to applicable laws), and contact information in the Complaint. The Center sent an email communication to the Complainant on May 28, 2024, 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 29, 2024.

On May 28, 2024, the Center informed the Parties in Russian and English, that the language of the registration agreement for the Domain Name is Russian. On May 29, 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 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").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint in both English and Russian, and the proceedings commenced on June 4, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 24, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 28, 2024.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on July 8, 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 is a manufacturer of trucks, buses and engines for heavy transport applications. Moreover, it also markets and sells a broad range of service-related products and financing services.

The Complainant was founded in 1891 and registered as a Swedish company in 1962. Currently, the Complainant operates across Latin America, Europe, Africa and Oceania, Eurasia, and Asia. The Complainant presently has 58,000 employees in over 100 countries. It 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 reported net sales of more than SEK 204 billion.

The Complainant is the owner of numerous SCANIA trademark registrations, including:

- the International Trademark Registration for SCANIA (figurative) No. 1415644, registered on January 24, 2018;
- the United States of America Trademark Registration for SCANIA No. 879387, registered on October 28, 1969; and
- the European Union Trade mark for SCANIA (word) No. 002896215, registered on January 22, 2004.

The Complainant is also the owner of the domain name <scania.com> which incorporate its SCANIA trademark.

The Domain Name was registered on July 2, 2023.

At the time of submitting the Complaint, the Domain Name resolved to a website purportedly offering for sale the software used for repair and diagnostics of the equipment under the SCANIA trademark and consisting of manuals, instructions, parts catalogues and diagrams (the "Website").

As of the date of this Decision, the Domain Name does not resolve to any active website.

#### **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 Domain Name.

First, the Complainant contends that the Domain Name is confusingly similar to the trademark in which the Complainant has rights.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Name.

Third, the Complainant submits that the Domain Name was registered and is being used in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Preliminary Matters – Language of the Proceeding**

The language of the Registration Agreement for the Domain Name is Russian. 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. First, the Complainant submits that it is unable to communicate in Russian. The translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceedings and adjudication of this matter. Second, the Complainant alleges that the additional delay, considering the obviously abusive nature of the Domain Name and the Website, poses continuing risk to the Complainant and unsuspecting consumers seeking the Complainant or its products. Third, the Complainant notes that the Domain Name is comprised of Latin characters. Fourth, the Complainant states that the Website displays the content entirely in English language. Finally, the Complainant contends that the SCANIA trademark, which is the dominant portion of the Domain Name, does not carry any specific meaning in the Russian language.

The Respondent did not comment on the Complainant's request for the language of the proceeding be English.

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 section 4.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel agrees that substantial additional expense and delay would likely be incurred if the Complaint had to be translated into Russian. Moreover, the Panel notes that the Respondent did not comment or let alone object to the Complainant's arguments concerning the language of the proceeding.

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.

### **6.2. Substantive Matters – Three Elements**

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

- (i) the 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 the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The requested remedy may only be granted if the above criteria are met. At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”. See section 4.2 of the [WIPO Overview 3.0](#).

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

Under the first element, the Complainant must establish that the Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights.

The Complainant holds valid SCANIA trademark registrations. The Domain Names incorporate this trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to that trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The addition of the term “-multi” in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the Complainant’s SCANIA trademark. Panels have consistently held that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See section 1.8 of the [WIPO Overview 3.0](#).

The Top-Level Domain “.com” in the Domain Names is viewed as a standard registration requirement and as such is typically disregarded under the first element test. See section 1.11.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Name is confusingly similar to the Complainant’s SCANIA trademark for purposes of the Policy. Thus, the Complainant has satisfied the requirements under paragraph 4(a)(i) of the Policy.

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

Under the second element, the Complainant must prove that the Respondent has no rights or legitimate interests in the Domain Name.

The Respondent may establish a right or legitimate interest in the Domain Name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made preparations to use the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services prior to the dispute; or
- (ii) that it is commonly known by the Domain Name, even if it has not acquired any trademark rights; or
- (iii) that it is making a legitimate noncommercial or fair use of the Domain Name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence on record that the Complainant’s SCANIA trademark registrations predate the Respondent’s registration of the Domain Name. There is no evidence in the case record that the Complainant has licensed or otherwise permitted the Respondent to use the SCANIA trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it results from the evidence on record that the Respondent does not make use of the Domain Name in connection with a bona fide offering of goods or services, nor does it make a legitimate noncommercial or fair use of the Domain Name. On the contrary, at the time of submitting the Complaint, the Domain Name resolved to the Website purportedly offering for sale unauthorized software used for repair and diagnostics of the equipment under the SCANIA trademark, therefore competing with the repair and support services provided by the Complainant's authorized resellers and distributors. Such use of the Domain Name does not confer rights or legitimate interests on the Respondent.

A respondent could make a bona fide offering of goods and services as a reseller or distributor of a complainant's products, and thus have a legitimate interest in the disputed domain name, if this use meets certain requirements as set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). While the Respondent is not reselling or distributing the Complainant's software, taking into consideration the nature of the Domain Name as compared to the trademark, the Panel will for completeness analyze the "fair use" factors enumerated under the above-referenced "Oki Data test". These requirements are that: (1) the Respondent must actually be offering the goods or services at issue; (2) the Respondent must use the Website to sell only the trademarked goods or services, otherwise, it could be using the trademark to bait Internet users and then switch them to other goods or services; (3) the Website must accurately disclose the Respondent's relationship with the trademark owner; and (4) the Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in the Domain Name.

In the present case, the above referred requirements are not met. The Domain Name and the Website suggest at least an affiliation with the Complainant and its SCANIA trademark. The Panel believes that the use of the Complainant's trademark in the Domain Name and on the Website misleads Internet users regarding the relationship between the Respondent and the Complainant, as Internet users may falsely believe that the Respondent is an entity associated with the Complainant. At the same time, the relationship between the Respondent and the Complainant (or a lack thereof) is not disclosed on the Website. This further perpetuates the false impression of a relationship between the Respondent and the Complainant.

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Name. Thus, there is no evidence in the case file that refutes the Complainant's prima facie case. The Panel concludes that the Complainant has also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

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

Under the third element, the Complainant must prove that the Domain Name has been registered and is being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1 of the [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or

(iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the Complainant's rights in the SCANIA trademark predate the registration of the Domain Name. This Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration. This finding is supported by the content of the Website allegedly offering the software used for repair and diagnostics of the Complainant's products. Moreover, it has been proven to the Panel's satisfaction that the Complainant's SCANIA trademark is well known and unique to the Complainant. Thus, the Respondent could not reasonably ignore the reputation of goods and services under this trademark. In sum, the Respondent in all likelihood registered the Domain Name with the expectation of taking advantage of the reputation of the Complainant's SCANIA trademark.

Furthermore, as previously noted, the Domain Name has been used in bad faith by the Respondent to resolve Internet users to the Website. The Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to this Website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Website.

For the reasons discussed above, the Panel finds that the Complainant has satisfied the requirements under paragraph 4(a)(iii) 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 <scania-multi.com> be transferred to the Complainant.

*/Piotr Nowaczyk/*

**Piotr Nowaczyk**

Sole Panelist

Date: July 18, 2024