

ADMINISTRATIVE PANEL DECISION

Doosan Bobcat North America, Inc. v. mohit jagwani, engine world usa
Case No. D2024-3191

1. The Parties

The Complainant is Doosan Bobcat North America, Inc., United States of America (“United States”), represented by Quarles & Brady LLP, United States.

The Respondent is mohit jagwani, engine world usa, United States, represented by Kulseth Law P.L.L.C. dba Mighty Marks, United States.

2. The Domain Name and Registrar

The disputed domain name <bobcatfinaldrivesales.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 2, 2024. On August 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 6, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on August 7, 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 August 9, 2024.

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, and the proceedings commenced on August 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 2, 2024. The Respondent requested and was granted a 4-day extension to file its Response. The Response was filed with the Center on September 3, 2024.

The Center appointed Evan D. Brown as the sole panelist in this matter on September 16, 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 provider of compact construction equipment, well-known for its loaders, excavators, backhoes and other related equipment. It owns the mark BOBCAT for which it enjoys the benefit of registration in the United States and in other countries (e.g., United States Reg. No. 670,566, registered on December 2, 1958).

The Respondent is in the business of selling aftermarket “final drives”¹ for a variety of heavy equipment manufacturer applications. It identifies itself as a small company that competes against the much larger Complainant by using search engine optimization to drive the sale of cheaper aftermarket products that match or exceed the quality and performance of the Complainant’s original products.

According to the Whois information, the disputed domain name was registered on July 6, 2020. The Respondent has used the disputed domain name to set up a website to sell aftermarket final drives that work with the Complainant’s products.

By letter dated December 11, 2023, counsel for the Complainant contacted the Respondent to object to the Respondent’s registration of the disputed domain name and the use of the Complainant’s BOBCAT mark on the Respondent’s website. The Respondent then made certain changes to its website which it says were done in an “effort to appease” the Complainant. The Respondent re-categorized aftermarket “final drive” parts for Bobcat applications, changing them from individual product listings to a dropdown menu. Additionally, the Respondent included a disclaimer on the site, stating that it is not an authorized dealer or representative of the Complainant, and that any use of the Complainant’s logos or trademarks is solely for identification and compatibility purposes. The Respondent also modified the presentation of the Complainant’s BOBCAT mark by using a different typography and refraining from using the Complainant’s logo.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant’s trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

The Respondent makes no substantive argument against the Complainant’s assertion that the disputed domain name is identical or confusingly similar to the Complainant’s trademark.

Concerning any rights or legitimate interests in the disputed domain name, the Respondent principally argues that it has used the disputed domain name in connection with a bona fide offering of goods. More specifically, the Respondent asserts that its actions satisfy all four parts of the test set forth in *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (the “Okidata Test”).

¹ According to the Respondent, a final drive is the last set of gears in a machine that transfers power from the engine/transmission assembly to the wheels or tracks of that machine.

As for bad faith registration and use, the Respondent asserts that (1) its knowledge of the BOBCAT mark does not serve as evidence of any bad faith, (2) the Respondent's refusal to transfer the disputed domain name to the Complainant does not show bad faith but instead shows the Respondent's rights or legitimate interests in the disputed domain name, (3) the Complainant failed to demonstrate that the Respondent sought to mislead Internet users for commercial gain.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (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 has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

This first element functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. 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. *Id.* This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the BOBCAT mark by providing evidence of its trademark registrations. See [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name incorporates the BOBCAT mark in its entirety with the words "final", "drive", and "sales" which does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's BOBCAT mark. See [WIPO Overview 3.0](#), section 1.8. The BOBCAT mark remains recognizable for a showing of confusing similarity under the Policy.

Accordingly, the Panel finds that the Complainant has satisfied this first element of the Policy.

B. Rights or Legitimate Interests

Under the second element of the Policy, the Panel must evaluate whether the Respondent has rights or legitimate interests in respect of the disputed domain name. This element serves as a crucial threshold in distinguishing between legitimate business activities and those carried out with the intent to wrongfully exploit the Complainant's trademark.

The Respondent has argued and has provided evidence that it operates a legitimate business selling aftermarket parts for Bobcat machinery. The Respondent asserts that under the *Okidata* Test, the disputed domain name is thereby being used in connection with a bona fide offering of goods.

Panels often apply the *Okidata* Test when a respondent is using a disputed domain name to sell goods subject to a complainant's trademark rights. The test helps panels determine whether that respondent has legitimate interests in the disputed domain name. The test sets out four requirements:

- The respondent must actually be offering the goods or services at issue.
- The respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods.

- The site must accurately disclose the respondent's relationship with the trademark owner.
- The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. [D2001-0903](#).

A key basis for the *Oki Data* Test is that the defense of nominative trademark use requires a respondent's use of a complainant's trademark to be "only so much as is necessary for [...] identification" of that respondent's goods or services. See *Project Management Institute v. CMN.com*, WIPO Case No. [D2013-2035](#), citing *New Kids on the Block v. News American Publishing, Inc.*, 971 F.2d 302 (9th Cir. 1992) and *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171 (9th Cir. 2010).

One may reasonably criticize the conduct the Respondent engaged in prior to hearing from the Complainant. The BOBCAT mark appeared prominently in the website header, leaving visitors possibly unsure whether they were being presented with actual BOBCAT products or aftermarket parts. One had to read carefully and make some assumptions to ascertain that the Respondent was offering aftermarket parts. But applying a holistic approach, the Panel finds on balance that the changes the Respondent made illuminate the overall bona fide offering of goods using the disputed domain name.

After the December 11, 2023 letter, the Respondent made certain notable changes to its website to seek to address the Complainant's concerns. The Panel credits these activities as demonstrating the bona fide nature of the Respondent's offering of goods – there is no dispute that the Respondent is indeed using the disputed domain name to offer aftermarket parts for Bobcat machinery. After hearing from the Complainant, the Respondent changed the website header to remove prominence of the BOBCAT mark, added language that makes it clearer that the Respondent is a supplier of aftermarket parts, and made certain that a disclaimer appears on the site, intended to lessen any potential confusion. Overall, the Respondent has not engaged in the typical sorts of actions one sees with domain name registrants accused of bad faith cybersquatting.

Moreover, the Panel recognizes that this case may more accurately be characterized as a trademark dispute rather than a simple case of domain name abuse. A core issue here is whether the Respondent's use of the BOBCAT mark – in the disputed domain name and on the Respondent's website – to sell aftermarket parts infringes upon the Complainant's trademark rights. This involves a nuanced analysis of trademark law, including the likelihood of confusion and the scope of the Respondent's fair use of the BOBCAT mark. It may be more appropriate for a court of competent jurisdiction to address the trademark issues involved, where a full analysis of the likelihood of confusion and other relevant factors can be undertaken.

Accordingly, the Panel finds that the Respondent has demonstrated a legitimate interest in the disputed domain name for the purposes of the Policy, by making a bona fide offering of products – aftermarket parts for the Complainant's machinery – and by taking significant steps to bring its conduct within the scope of what the *Oki Data* Test permits.

C. Registered and Used in Bad Faith

Because of the determination under the second element of the Policy, the Panel declines to address the issues arising under the third element.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: October 14, 2024