

ADMINISTRATIVE PANEL DECISION

Toyota Motor Sales, U.S.A., Inc. v. B Kramer, KramERICA Holdings, LLC
and Brian Kramer
Case No. D2024-4024

1. The Parties

The Complainant is Toyota Motor Sales, U.S.A., Inc., United States of America (“United States” or “U.S.”), represented by Dinsmore & Shohl, LLP, United States.

The Respondents are B Kramer, KramERICA Holdings, LLC and Brian Kramer, United States.

2. The Domain Names and Registrars

The disputed domain name <lexusofpensacola.com> is registered with GoDaddy.com, LLC.

The disputed domain name <toyotaofcapecoral.com> is registered with Squarespace Domains II LLC .

GoDaddy.com, LLC and Squarespace Domains II LLC are hereinafter referred to as the “Registrar”. The disputed domain names <lexusofpensacola.com> and <toyotaofcapecoral.com> are hereinafter referred to together as the “Disputed Domain Names”.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 1, 2024. On October 1, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <toyotaofcapecoral.com>. On October 1, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name <toyotaofcapecoral.com> which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on October 4, 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 the First Amended Complaint on October 18, 2024, and requested that the domain names <lexusofpensacola.com> and <toyotaofnaples.com> be added to the proceeding. On October 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names <lexusofpensacola.com> and <toyotaofnaples.com>. On October 21, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names <lexusofpensacola.com> and <toyotaofnaples.com> which differed from the named Respondent and contact information in the Complaint.

The Center sent an email communication to the Complainant on October 22, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. The Complainant filed the Second Amended Complaint on October 25, 2024, which includes only the Disputed Domain Names.

The Center verified that the Complaint together with the amended Complaints 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 November 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 25, 2024. The Respondent sent four email communications to the Center on October 6, October 23, November 5, and November 23, 2024, respectively.

The Center appointed Douglas M. Isenberg as the sole panelist in this matter on December 4, 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 states that it is "a wholly-owned subsidiary of Toyota Jidosha Kabushiki Kaisha, DBA Toyota Motor Corporation ('TMC'), a corporation organized under the laws of Japan"; that it is "the exclusive importer and distributor of Toyota automobiles throughout the U.S. (except the state of Hawaii), the Commonwealth of Puerto Rico, and the U.S. Virgin Islands"; and that it is "the exclusive licensee of TMC's trademarks in the distribution territory and contractually obligated to monitor for trademark infringements and abate any infringements found". The Complainant further states that it "has offered goods and services under its well-known TOYOTA brand for more than seventy-five years"; that its "TOYOTA-branded vehicles and related goods and services are now marketed in over 170 countries and territories worldwide, including Serbia"; that it "is consistently ranked as one of the top 100 brands in the world". The Complainant further states that its "LEXUS-branded vehicles were introduced in the U.S. in 1989" and are "[c]ommonly viewed as Toyota's luxury vehicle line"; that LEXUS-branded vehicles "are now marketed in over 90 countries and territories worldwide"; and that its LEXUS brand "is well-known and has achieved global recognition, and has been ranked as one of the top ten car brands globally".

The Complainant states, and provides documentation in support thereof, that it is the registrant of "a substantial number of registrations for its Toyota Mark around the world", including the following (the "TOYOTA Trademark"):

- U.S. Reg. No. 1,274,261 for TOYOTA for use in connection with, inter alia, automobiles (registered April 17, 1984);
- U.S. Reg. No. 1,721,365 for TOYOTA for use in connection with, inter alia, "parts and components made of metal for automobiles, trucks, and automotive vans" (registered October 6, 1992); and
- U.S. Reg. No. 1,888,870 for TOYOTA for use in connection with "repair and maintenance services for automotive vehicles" (registered April 11, 1995).

The Complainant states, and provides documentation in support thereof, that it is the registrant of U.S. Reg. No. 1,574,718 for LEXUS for use in connection with automobiles (registered January 2, 1990) (the “LEXUS Trademark”).

The Panel observes that all of the above registrations are owned by TMC. However, as noted above, the Complainant states that it is the exclusive licensee of TMC’s trademarks. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.4.1: “an exclusive trademark licensee is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint.”

The Disputed Domain Names were created on February 23, 2014 (<lexusofpensacola.com>) and December 15, 2017 (<toyotaofcapecoral.com>). As stated in the Complaint and as supported by relevant documentation, the Disputed Domain Name <lexusofpensacola.com> “resolves to a GoDaddy parking page with a link that suggests that the domain name is for sale”; and the Disputed Domain Name <toyotaofcapecoral.com> “does not resolve to its own web page, but instead is automatically redirected to a website associated with the domain name <appraiseyourvehicle.com>”.

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 Names.

Notably, the Complainant contends that

- The Disputed Domain Name <toyotaofcapecoral.com> is confusingly similar to the TOYOTA Trademark, and the Disputed Domain Name <lexusofpensacola.com> is confusingly similar to the LEXUS Trademark because, inter alia, each of the domain names includes the respective trademark in its entirety plus a “geographically descriptive phrase” that “fails to distinguish” the domain names from the trademarks.
- The Respondent has no rights or legitimate interests in the Disputed Domain Names because, inter alia, “Respondent is not commonly known by any of the domain names or any portion thereof, nor is there any indication that Respondent registered any of the domain names as a trademark”; “Complainant has never assigned, sold or transferred any rights in any of its Toyota Marks or Lexus Marks to Respondent”; “Complainant has not granted Respondent permission to use or register any of its marks as a domain name”; with respect to the Disputed Domain Name <toyotaofcapecoral.com>, “[u]se of a domain name to redirect users to a different website does not give rise to any rights or legitimate interests”; and with respect to the Disputed Domain Name <lexusofpensacola.com>, “[a] domain name that resolves to a parking page does not give rise to any rights or legitimate interests”.
- The Disputed Domain Names were registered and are being used in bad faith because, inter alia, with respect to the Disputed Domain Name <toyotaofcapecoral.com>, redirecting it to a website using the domain name <appraiseyourvehicle.com>, although inactive, shows that it is “likely that the plans for the site will involve the valuation of vehicles, likely automobiles, to be used in connection with the buying or selling of vehicles – in other words, a business closely related to, if not overlapping with, Complainant’s business” and “presumably, the intention is for Respondent to profit from the Complainant’s Toyota Mark and reputation by using the <toyotaofcapecoral.com> domain name to redirect traffic to its own website, once that site it up and running” and “[u]se of a domain name to divert internet traffic to the registrant’s own site for profit or other commercial benefit is a prime example of bad faith”. With respect to the Disputed Domain Name <lexusofpensacola.com>, the passive holding doctrine applies given that “Complainant’s LEXUS mark is well known, and is an uncommon, coined term that is unlikely to have any meaning other than to identify Complainant, and any website associated with the domain name will confuse and mislead consumers”.

B. Respondent

Although the Respondent did not formally reply to the Complainant's contentions, the Respondent sent four communications to the Center (as noted above), stating, inter alia, that "my primary concern at this juncture is the reimbursement of the monthly fees paid to maintain the domain name(s) in question since their initial registration"; "I was never made aware of any potential trademark violations, when the domains were initially purchased"; "I do not challenge the UDRP rules regarding these [...] website domains"; "I do not contest that it is not my intellectual property"; "I secured it as we anticipated that market as a future open point, and to my knowledge it is still an open point"; and "I am willing to settle this complaint, in exchange for reimbursement of GoDaddy, SquareSpace & Google Domains fees paid to date for www.toyotaofcapecoral.com and www.lexusofpensacola.com".

6. Discussion and Findings

Consolidation: Multiple Respondents

The Second Amended Complaint was filed in relation to nominally different domain name registrants - although they use similar names "Brian Kramer" and "B Kramer" and their contact details (address, phone and email) are identical. Plus, a single entity has communicated with the Center with respect to both of the Disputed Domain Names. Therefore, it is clear that "(i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties".

[WIPO Overview 3.0](#), section 4.11.2.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

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.

Based on the trademark registrations cited in the Complainant, the Complainant has shown rights in respect of two trademarks or service marks for the purposes of the Policy, that is, the TOYOTA Trademark and the LEXUS Trademark. [WIPO Overview 3.0](#), section 1.2.1.

The Disputed Domain Names are confusingly similar to the TOYOTA Trademark and the LEXUS Trademark. The relevant comparison to be made is with the second-level portion of the Disputed Domain Names only (i.e., "lexusofpensacola" and "toyotaofcapecoral"), as it is well-established that the Top-Level Domain (i.e., ".com") may be disregarded for this purpose. [WIPO Overview 3.0](#), section 1.11.1: "The applicable Top-Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test."

The second-level portion of each of the Disputed Domain Names contains either the TOYOTA Trademark or the LEXUS Trademark in its entirety, plus the words "ofpensacola" or "ofcapecoral". As set forth in [WIPO Overview 3.0](#), section 1.7: "[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing." Further, "[w]here 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". [WIPO Overview 3.0](#), section 1.8. Therefore, the descriptive word "of" and the geographic words "pensacola" and "cape coral" – cities in Florida, where the Respondent is located – do nothing to prevent a finding of confusing similarity.

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.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Names. The Respondent has not 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 Names such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by evaluating four (non-exhaustive) factors set forth in the Policy: (i) circumstances indicating that the registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration 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 registrant’s documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant’s 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 the registrant’s website or location or of a product or service on the registrant’s website or location. Policy, paragraph 4(b).

In the present case, the Panel notes that the TOYOTA Trademark and the LEXUS Trademark are strong trademarks based on their registrations and other details set forth above, as well as the Panel’s personal knowledge of these brands.¹ This alone is evidence of bad faith under the Policy. See, e.g., [WIPO Overview 3.0](#), section 3.1.4 (“the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith”).

¹ “In some circumstances, a panel may also rely on personal knowledge (e.g., to take ‘judicial notice’ of the reputation of a well-known mark, or a corporate affiliation/structure).” [WIPO Overview 3.0](#), section 4.8.

Plus, the Panel agrees that the passive holding doctrine applies – not only to the Disputed Domain Name <lexusofpensacola.com> but also to the Disputed Domain Name <toyotaofcapecoral.com> given that both of these domain names were not, according to the Complaint, associated with active websites. As set forth in [WIPO Overview 3.0](#), section 3.3:

From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding.

While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

Citing *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

Here, as already stated, the TOYOTA Trademark and the LEXUS Trademark are strong trademarks. Further, the Respondent has not submitted a substantive response to any of the Policy’s three elements (and, on the contrary, the Respondent has stated: “I do not challenge the UDRP rules regarding these [...] website domains” and “I do not contest that it is not my intellectual property”. In the circumstances of this case, it is implausible that either of the Disputed Domain Names could be put to any good faith use without the Complainant’s consent.

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 Names <lexusofpensacola.com> and <toyotaofcapecoral.com> be transferred to the Complainant.

/Douglas M. Isenberg/

Douglas M. Isenberg

Sole Panelist

Date: December 16, 2024