

## **ADMINISTRATIVE PANEL DECISION**

Caterpillar Inc. v. Hugh Wilson  
Case No. DAU2023-0017

### **1. The Parties**

The Complainant is Caterpillar Inc., United States of America (“United States”), represented by Kelly IP, LLP, United States.

The Respondent is Hugh Wilson, Australia.

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

The disputed domain name <catpartsaustralia.com.au> (“the Disputed Domain Name”) is registered with Web Address Registration Pty Ltd.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 24, 2023. On March 24, 2023, the Center transmitted by email to Web Address Registration Pty Ltd a request for registrar verification in connection with the Disputed Domain Name. On March 27, 2023, Web Address Registration Pty Ltd transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 28, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was April 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 19, 2023.

The Center appointed Nicholas Weston as the sole panelist in this matter on April 26, 2023. 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 United States incorporated, NYSE listed Fortune 100 company and the world's largest manufacturer of construction and mining equipment, diesel and natural gas engines, industrial gas turbines, and diesel-electric locomotives with 2021 sales and revenues of more than USD 50 billion. The Complainant holds a portfolio of registrations for the well-known trade marks CATERPILLAR and CAT and variations of these in numerous countries and categories, including Australian Trade Mark Registration No. 98534 for the mark CAT registered on April 14, 1949 in class 7.

The Complainant is also the owner of the domain name <cat.com> which is the address of its main website that offers, amongst other functions, online shopping for parts, products, and branded merchandise.

The Respondent registered the Disputed Domain Name on March 22, 2018. The Complainant has provided evidence that the Disputed Domain Name resolves to a webpage that offers for sale parts for the Complainant's products, and for third-party competing brands.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant cites numerous trade mark registrations including United States Trademark No. 85816 registered on March 19, 1912 for the mark CATERPILLAR and United States Trademark No. 564272 registered on September 23, 1952 for the mark CAT as, *prima facie*, evidence of ownership.

The Complainant submits that its rights in the mark CAT predate the Respondent's registration of the Disputed Domain Name. It submits that the Disputed Domain Name is identical or confusingly similar to its trade mark, because the Disputed Domain Name incorporates in its entirety the CAT trade mark and that identity is not removed by the addition of the words "parts" and "australia" or the Second-Level Domain suffix ("ccTLD") ".com.au".

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because "Complainant has not authorized Respondent, or any associated person or entity, to use or register the CAT Marks in any manner", and contends that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Complainant also submits that the Respondent's "webpage promotes and offers parts for third-party competing brands, such as KOMATSU" which does not constitute a *bona fide* use nor a legitimate noncommercial or fair use under the Policy.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and Rules and submits that the Respondent used "the [Disputed] Domain [Name for] a website that promotes and sells parts for Complainant's products and third-party brands while displaying Complainant's various intellectual property. All of this establishes that Respondent was aware of Complainant before registering and using the [Disputed] Domain [Name] and chose the [Disputed] Domain [Name] and built the website in a calculated and premeditated attempt to impersonate Complainant or otherwise create the false impression that the [Disputed] Domain [Name] and website were actually Complainant, or were otherwise connected or affiliated with, or a partner of, Complainant".

##### **B. Respondent**

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

## 6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights; and
- (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 or subsequently used in bad faith.

### A. Identical or Confusingly Similar

The Panel finds that the Complainant has rights in the mark CAT acquired through use and registration which predate the date of registration of the Disputed Domain Name by at least 69 years. The threshold requirement of the first element for purposes of the Policy is therefore, *prima facie*, met (see auDA Overview of Panel Views on Selected auDRP Questions First Edition (“auDRP Overview 1.0”), section 1.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the CAT trade mark, the Panel observes that the Disputed Domain Name comprises: (a) an exact reproduction of the Complainant’s trade mark CAT; (b) followed by the word “parts”; (c) followed by the word “australia”; and (d) followed by the Second-Level extension, or Namespace, “.com.au”.

The relevant comparison to be made is with the Third-Level portion of the Disputed Domain Name, specifically: “catpartsaustralia”. It is well established that the Second-Level Domain extension, (“com.au”), used as the technical part of a domain name, may be disregarded (see auDRP Overview 1.0, section 1.2).

It is also well established that, where a domain name incorporates the entirety of a trade mark, the domain name will normally be considered confusingly similar to that mark for purposes of auDRP standing. The Panel finds that the Disputed Domain Name, which contains the CAT trade mark in its entirety, is confusingly similar to the CAT trade mark despite the addition of the word “parts” and the geographical word “australia”.

The Panel therefore holds that the Complaint fulfills the first condition in paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of non-exhaustive circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in the disputed domain name:

- (i) before any notice to the Respondent of the dispute, the Respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business, or other organisation) has been commonly known by the disputed domain name even if the Respondent has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it has not licensed, permitted or authorised the Respondent to use the Complainant’s trade marks or to sell its products and for those reasons, the Respondent is not making a *bona fide* offering of goods or services. The Complainant submits that, in addition to the Respondent’s

webpage offering CAT and CATERPILLAR branded parts for sale, “the webpage promotes and offers parts for third-party competing brands, such as KOMATSU”. No evidence has been provided that the Respondent is commonly known by the Disputed Domain Name.

The minimum criteria to be satisfied before an unauthorised reseller’s use of a domain name can be held to constitute a *bona fide* offering of goods or services under the Policy must be satisfied are set out in a case applied by numerous past auDRP (and UDRP) panels, *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (“Oki Data”), as follows<sup>1</sup>:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must offer only those goods or services in connection with the disputed domain name;
- (iii) the respondent must accurately disclose its true relationship with the trademark owner prior to notice of the dispute; and
- (iv) the respondent must not have attempted to “corner the market” in all relevant domain names that reflect the trade mark.

This Panel accepts the uncontested *prima facie* evidence that the Respondent is not an authorized reseller with a legitimate interest in a domain name incorporating a Complainant’s mark, and there is no disclaimer on the website the Disputed Domain Name resolves to. The Panel therefore finds that, while the Respondent satisfies the first and fourth tests in *Oki Data*, it fails to satisfy the other two tests. The Respondent has used the Disputed Domain Name to promote the sale of CAT parts but also offers third party parts such as those of KOMATSU, and has also not disclosed its true relationship with the Complainant as an unauthorized dealer or reseller. The Respondent cannot, therefore, meet the *Oki Data* criteria (see: *Ford Motor Company of Australia Ltd. / Ford Motor Company of Canada, Ltd. / Ford Motor Company v. E.K.W. Auto Parts Recyclers Pty. Ltd., Munum Pty Ltd / Fordparts Recyclers Pty. Ltd.*, WIPO Case No. [DAU2018-0034](#)).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

### **C. Registered or Subsequently Used in Bad Faith**

Under paragraph 4(a)(iii) of the Policy the Complainant must demonstrate that the Respondent has registered or used the Disputed Domain Name in bad faith. Unlike the position under the UDRP, this is not a conjunctive requirement. It is sufficient to establish only one or the other.

Applying the Policy, evidence of use in bad faith will be shown under paragraph 4(b)(iv) of the Policy where by using the domain name, a respondent has intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant’s name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location. The circumstances identified in paragraph 4(b) of the Policy, however, are examples of registration or use in bad faith and not an exhaustive listing of such circumstances.

On the issue of registration, the Panel finds that the Respondent targeted the relevant trade mark. The Panel finds that the Respondent has taken the Complainant’s trade mark and incorporated it into the Disputed Domain Name without the Complainant’s consent or authorization, for the very purpose of capitalizing on the reputation of the trade marks by diverting Internet users to its webpage along with its colour scheme and branding, presumably to generate revenue.

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<sup>1</sup> Noting the substantial substantive similarities between the Policy and the Uniform Domain Name Dispute Resolution Policy (“UDRP”), the Panel has referred to prior UDRP cases and the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), where appropriate.

In addition, a gap of several years between registration of the Complainant's trade marks and the Respondent's registration of the Disputed Domain Name (containing a registered trade mark owned by the Complainant) can in certain circumstances be an indicator of bad faith. In this case, the Complainant's rights in the trade mark CAT predate any rights that could possibly flow from the Respondent's registration of the Disputed Domain Name by at least 69 years.

On the issue of use, the evidence is that the Disputed Domain Name resolves to a webstore that unlawfully offers the Complainant's parts and, it would appear from the evidence, parts of competitor brand KOMATSU, for sale unconnected with any *bona fide* supply of goods or services by the Respondent. This Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its webpage by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or of a product or service on that website contrary to paragraph 4(b)(iv) of the Policy (see auDRP Overview 1.0, section 3.1D).

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

## **7. Decision**

For all 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, <catpartsaustralia.com.au>, be transferred to the Complainant.

*/Nicholas Weston/*

**Nicholas Weston**

Sole Panelist

Date: May 3, 2023