



**WIPO Arbitration and Mediation Center**

**ADMINISTRATIVE PANEL DECISION**

Fall Nummer: D200-0648

Entscheidung vom 1. Oktober 2003

1. The Parties

The Complainant is Volvo Trademark ..., ..., Sweden, ....

The Respondent is Cosmos1, ..., Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <vovlo.com> is registered with Intercosmos Media Group d/b/a directNIC.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 15, 2003. On August 18, 2003, the Center transmitted by email to Intercosmos Media Group d/b/a directNIC.com a

request for registrar verification in connection with the domain name at issue. On August 19, 2003, Intercosmos Media Group d/b/a directNIC.com transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 20, 2003. In accordance with the Rules, paragraph 5(a), the due date for Response was September 9, 2003.

The Notification of Complaint and Commencement of Administrative Proceeding and a copy of the Complaint (with attachments) were dispatched by DHL courier and email to the Respondent. The tracking record of DHL shows that delivery of these documents was unsuccessful. Moreover, the Center received notice on August 25, 2003, that the email delivery to one of the Respondent's email addresses had been ineffective. The message reported "permanent fatal errors". On the other side, the Complainant stated in its complaint that a copy thereof had been sent by U.S. airmail to the Respondent (Complaint, para. 30 p. 12).

The Panel is satisfied that the Center has complied with its obligations under paragraph 2(a) of the Rules "to employ reasonably available means calculated to achieve actual notice to Respondent" (see e.g. Charles Schwab & Co, Inc. v Polanski, WIPO Case No. D2001-0959).

On August 22, 2003, the Center advised the Complainant that it had come to its attention that the Respondent did not submit in its Registration Agreement to the jurisdiction at the location of the principal office of the Registrar for court adjudication of disputes in respect of the use of the domain name pursuant to paragraph 1 of the Rules; the Complainant was therefore requested to expressly consent to the jurisdiction of the courts at the location of the domain-holder's address in filing a signed amendment to the Complaint to this effect. The Complainant filed such an amendment under the form and conditions required on that same date.

The Respondent did not submit any response to the Complaint. Accordingly, the Center notified via email the Respondent's default on September 12, 2003. There is no indication available in the file that would evidence that this electronic communication did not reach its recipient.

The Center appointed the undersigned as the sole panelist in this matter on September 17, 2003. 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 paragraph 7 of the Rules.

#### 4. Factual Background

The Complainant is a corporation which owns the "VOLVO" trademark throughout the world and licenses this trademark to AB Volvo and Volvo Car Corporation for use in connection with their respective businesses.

The "VOLVO" mark, alone and in combination with many other terms and designs, is registered extensively as a trademark and service mark in the United States and elsewhere throughout the world (Exhibits A and B to the Complaint).

The Respondent registered the domain name <vovlo.com> on February 17, 2000, (Exhibit C to the Complaint). By letters dated March 28, 2003, and June 4, 2003, the Complainant requested the Respondent to immediately assign the domain name <vovlo.com> to the Complainant and to agree not to register, use or own any other domain name which includes the "VOLVO" mark (Exhibits E and F to the Complaint). No answer to these letters was ever received.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant essentially submits the following:

(i) The Complainant's "VOLVO" mark is famous.

By virtue of a long and extensive use, the "VOLVO" mark has become famous, and it is one of the best known trademarks in the world today. The "VOLVO" mark is well recognized as a symbol of the highest quality in vehicles and other goods. By virtue of the Complainant's long use and the renown of the Complainant's "VOLVO" mark, "VOLVO" is associated exclusively with the Complainant. The reputation associated with the Complainant's marks is excellent by virtue of the quality of the Complainant's goods and services.

In many previous administrative proceedings, the Complainant's "VOLVO" mark was found to be famous. In these cases, the Complainant was successful in having the domain names <thevolvooceanrace.com>, <volvooceanrace.nu>, <volvoinsurance.com>, <volvoexhausts.com>, <volvovehicles.com>, <volvoclub.com>, <volvocars.tv>, <volvodele.nu> and <newvolvoparts.com> transferred to it (see Volvo Trademark Holding AB v. Cup International Limited, WIPO Case No. D2000-0338; Volvo Trademark Holding AB v. Eurovendic (erik schroder, WIPO Case No. D2001-0001; Volvo Trademark Holding AB v. e-motordealer Ltd, WIPO Case No. D2002-0036; Volvo Trademark Holding AB v. Peter Lambe, WIPO Case No. D2001-1292; Volvo Trademark Holding AB v. Nicklas Uvelov, WIPO Case No. D2002-0521; Volvo Trademark Holding AB v. Lost In Space, SA, WIPO Case No. D2002-0445; Volvo Trademark Holding AB v. Roger Nichols, WIPO Case No. DTV2001-0017; Volvo Trademark Holding AB v. Soeren Groenlund, WIPO Case No. DNU2002-0003 and Volvo Trademark Holding AB v. Nick Bauer, WIPO Case No. D2002-1025).

(ii) The domain name <vovlo.com> is confusingly similar to Complainant's "VOLVO" mark.

There is no question that "vovlo" is confusingly similar to Complainant's famous "VOLVO" trademark.

Domain name proceedings before WIPO have found that a domain name comprised of another's trademark or service mark with merely a transposition of letters does not serve to dispel confusion (e.g. National Association of Professional Baseball Leagues, Inc. v. Zuccarini, WIPO Case No. D2002-1011; Daimler Chrysler Corp. v. Carrington, WIPO Case No. D2002-0756; Pfizer Inc. v. Enamecorp.com, WIPO Case No. D2001-0791).

(iii) The Respondent has no rights or legitimate interests in the domain <vovlo.com> based on Complainant's continuous and long prior use of its mark and trade name "VOLVO".

None of the situations described in paragraph 4(c) of the Policy can be established in this case.

The Respondent cannot conceivably claim to have been unaware of the famous "VOLVO" trademark, or the fact that the mark is owned by Volvo. Nor can the Respondent deny that it did not have permission to use "vovlo" or "volvo" as part of a domain name or in any other way.

Nor is the Respondent making a legitimate non-commercial or fair use of the domain name "without intent for commercial gain." The Respondent is in business, for the purpose of his own commercial gain.

The Respondent's web site (Exhibit D to the Complaint) offers price quotes on all makes and models of automobiles, and auto insurance, including Volvo cars as well as cars from Volvo's many competitors. The Respondent's intent is not only to make a commercial gain, but to do so by attracting customers to its site by using the famous "VOLVO" mark and thereby to mislead them, and deceive them into believing its

business is somehow sanctioned or approved by the Complainant.

(iv) The domain name in dispute was registered in bad faith.

At the time the Respondent registered <vovlo.com> and began operation of its web site, it was on constructive notice of the Complainant's famous "VOLVO" mark by virtue of Section 22 of the Lanham Act, 15 U.S.C. §1072, in the United States. It is further inconceivable that the Respondent was unaware of the "VOLVO" mark, which has been famous for decades throughout the world by virtue of the Complainant's long, exclusive and ubiquitous use thereof. Nor could the Respondent's selection of <vovlo.com> have been in anything other than bad faith; there is no reason for the Respondent to use "vovlo" except to attract consumers to its web site.

(v) The domain name in dispute is used in bad faith.

There is no reason for the Respondent to use "vovlo", an incorrect spelling of the Complainant's mark in his domain name other than to use it to attract the public to Respondent's web site for commercial gain.

The Respondent's web site is devoted to the sale and insuring of cars, the Complainant's exact product line. If the Respondent is permitted to continue to use and hold "www.vovlo.com", the public will be confused into believing or assuming that the Complainant does not object to use of an infringement of its trademark in a domain name used to sell vehicles and insurance therefor. This constitutes trademark infringement and dilution in the blurring sense, irreparably damaging a famous trademark and an invaluable asset of the Complainant.

This is clearly a case of typosquatting which WIPO Panels have found to constitute bad faith (see WIPO Case No. D2002-1011 already mentioned above).

The Respondent's bad faith is further evidenced by the fact that <vovlo.com> is a blatant infringement and dilution of the Complainant's trademark rights. The marks are virtually indistinguishable: VOLVO vs. VOVLO. It is inevitable that the public will assume that <vovlo.com> belongs to the Complainant or that the holder and user of the name has been authorized or endorsed by the Complainant. In addition to traditional confusion arising from infringement, if the Respondent is permitted to continue to use <vovlo.com>, the public will be confused into believing or assuming that the Complainant does not object to use of "vovlo" in a domain name for goods and services related to the products which the Complainant itself offers. Confusion in both senses constitutes trademark infringement and dilution, irreparably damaging a famous mark and an invaluable asset of the Complainant.

To conclude, the Complainant requests that the Respondent's domain name <vovlo.com> be transferred to the Complainant.

## B. Respondent

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

## 6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth three requirements, which have to be met for the Administrative Panel to order the transfer of the disputed domain name to the Complainant. Those requirements are that:

(i) Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) Respondent has no rights or legitimate interests in respect of the domain name; and

(iii) Respondent's domain name has been registered and is being used in bad faith.

The Complainant must prove in the administrative proceeding that each of the aforesaid three elements is present so as to warrant relief, according to paragraph 4(a) of the Policy.

The Panel has to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable, pursuant to paragraph 15(a) of said Rules.

## A. Identical or Confusingly Similar

There is no doubt that there is confusing similarity between the Complainant's trade and service marks "VOLVO" and the domain name <vovlo.com>. There is no reason to depart from the precedents cited by the Complainant in its Complaint on that issue.

The Complainant has also established its rights in trade and service marks "VOLVO" with various registrations for such a name.

## B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances, if found by the Panel to be proved based on its evaluation of all evidence submitted, shall demonstrate rights to or legitimate interests in the domain name in dispute. Those circumstances are described as follows:

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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 or service mark at issue.

It is the Panel's finding that the Complainant has established that the trade and service marks "VOLVO" have been known worldwide for a significant period of time. Furthermore, absent evidence to the contrary, the Complainant has not granted any license or otherwise permitted the Respondent to use such trade and service marks or to apply for any domain name incorporating the said trade and service marks.

Moreover, as pointed out by the Complainant in its complaint, none of the circumstances described above are present in this case. Much to the contrary, it is this Panel's view that the Respondent is making a commercial illegitimate use of the domain name in dispute.

The Panel finds therefore that the Respondent has no rights or legitimate interests in respect of the domain name at stake.

### C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following behaviors is sufficient to support a finding of bad faith:

(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

The Panel concludes without any doubt that the circumstance described under paragraph 4(b)(iv) of the Policy occurs in this matter.

It has been held that actual or constructive knowledge of the Complainant's rights in the trademarks is a factor supporting a finding of bad faith (see *Trip.com v. Daniel Deamone*, WIPO Case No. D2001-1066; *Expedia, Inc. v European Travel Network*, WIPO Case No. D2000-0137). It is obvious from the facts in issue that the Respondent had actual knowledge of such rights.

Previous cases have also established that the deliberate choice and registration of a famous mark as domain names suggests, in the absence of an explanation from the Respondent, that the registrations were made in bad faith.

From a quick examination of the Respondent's web site, it flows that the Respondent is using the domain name <vovlo.com> in order to derive commercial gains therefrom; moreover, it uses it in such a way that a

likelihood of confusion is maintained with the Complainant's mark as to the source and the products which are in the same line of those offered by the Complainant.

Moreover, the Sole Panelist shares the Complainant's submission that the Respondent's behavior may be characterized as "typosquatting" which falls within the general meaning of paragraph 4(b) of the Policy.

The transfer of the domain name subject to these administrative proceedings shall therefore be ordered in favor of the Complainant.

## 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 domain name <vovlo.com> be transferred to the Complainant.

...

Sole Panelist