

ADMINISTRATIVE PANEL DECISION

Carsforsale.com, Inc. v. Robert Heck
Case No. D2022-1124

1. The Parties

Complainant is Carsforsale.com, Inc., United States of America (“United States”), represented by Dinsmore & Shohl LLP, United States.

Respondent is Robert Heck, United States.

2. The Domain Name and Registrar

The disputed domain name <cars4sale.com> (the “Domain name”) 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 March 31, 2022. On April 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 4, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 Respondent of the Complaint, and the proceedings commenced on April 5, 2022. On April 7, 2022, Respondent sent an informal communication.

In accordance with the Rules, paragraph 5, the due date for Response was April 25, 2022. Respondent did not submit any formal response. Accordingly, the Center notified the Parties that it will proceed to Panel Appointment on April 26, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on May 2, 2022. 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

According to the Complaint, “Complainant, Carsforsale.com, Inc., operates a leading automotive shopping platform that connects over 22,000 auto dealers across the United States with millions of highly active car buyers”.

Complainant has owned the domain name <carsforsale.com> since 1999, and uses that domain name to host a commercial website connecting automobile purchasers with car sellers.

Complainant holds a registration for the word mark CARSFORSALE.COM with the United States Patent and Trademark Office, Reg. No. 4,134,016, registered on May 1, 2012 in connection with “Internet marketplace for dissemination of automobile advertisements for others and means for connecting prospective purchasers with desired automobiles”, with a September 1, 2004 date of first use in commerce.

The Domain Name was originally registered on February 21, 2000. Complainant alleges that it is unlikely that Respondent was the original owner of the Domain Name. Complainant annexed to the Complaint documentation that the named registrant of the Domain Name (and the registrant’s location) changed many times between 2000 and 2017. Specifically, Complainant noted changes in the registrant name and location on December 6, 2003, March 31, 2005, July 3, 2008, January 18, 2011, July 5, 2014, July 3, 2015, and October 6, 2017. The latter date is the first time that Respondent Robert Heck appears as the named registrant of the Domain Name.

Also annexed to the Complaint are various screenshots (taken from the “Wayback Machine”, www.archive.org) of the website to which the Domain Name resolved at various dates between December 16, 2003 and December 28, 2015. These various website screenshots are markedly different in appearance over time, though each iteration of the site advertises automobiles for sale.

Respondent does not deny that the ownership of the Domain Name changed many times, and Respondent does not claim that he was the original registrant of the Domain Name. Respondent does not disclaim knowledge of Complainant’s mark, nor does he put forward arguments regarding the strength of the mark or the likely uses for the Domain Name. Nor does Respondent claim that he owned the Domain Name at any time prior to October 6, 2017.

For some period of time (which included 2019, based on a copyright notice and other website references), the Domain Name resolved to a commercial website which connected consumers interested in buying a car with automobile dealerships in the Commonwealth of Pennsylvania, United States (Respondent’s home state).

On September 21, 2021, Complainant’s counsel sent a cease-and-desist letter to an address which counsel believed to correspond to Respondent. In that letter, Complainant asserted its trademark rights, alleged that the domain Name and corresponding website infringed the trademark, and demanded that Respondent cease using the Domain Name and transfer it to Complainant.

After this cease-and-desist letter was sent, the Domain Name no longer resolved to a well-developed website. Rather, it resolved to a GoDaddy parking page, which contained various hyperlinks such as “Used Cars”, “Used Vehicles”, and “Dealership Used Cars”. Complainant alleges that Respondent probably derives pay-per-click (“PPC”) revenue from these hyperlinks. Respondent does not specifically deny that he derives PPC revenue from the hyperlinks. (Respondent’s entire commentary vis-à-vis the Domain Name is set forth below in Section 5.B.)

Respondent sent an email to Complainant’s counsel on November 22, 2021, stating, “Hi were you trying to reach me about Cars4Sale.com?”.

On November 30, 2021, Complainant’s counsel sent an email to Respondent, thanking Respondent for taking down the allegedly offending website but also asking Respondent to transfer the Domain Name to

Complainant. Getting no reply, Complainant's counsel sent follow-up emails to Respondent on December 8, 2021 and December 23, 2021.

On December 25, 2021, Respondent replied by email: "If you are interested in purchasing the name for 100K let me know. I have a Automotive dealer group in the UK that is looking at purchasing the domain."

This appears to have been the final communication between the Parties before the filing of the Complaint in this proceeding on March 31, 2022.

5. Parties' Contentions

A. Complainant

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not reply to Complainant's substantive contentions. As noted above, Respondent sent a February 7, 2022 email to the Center, in which Respondent stated:

"Hi, I'm Robert Heck the domain owner of Cars4Sale.com This domain is parked with Go Daddy and not be being used at all. I'm not sure what this is about can you give me more details as to where the problem is with the said domain. I would be interested in selling the domain name because the name is not being used."

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark CARSFORSALE.COM through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The only difference between the mark and the Domain Name is the substitution of the number "4" for the word "for". In modern marketing, especially on the Internet, the number "4" is frequently used a substitute for its homonym, "for". The Panel concludes that Complainant's mark is clearly recognizable within the Domain Name, notwithstanding this small difference.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable 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; or
- (ii) you [Respondent] (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 [Respondent] 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.

Notwithstanding the descriptive nature of Complainant's mark, Respondent has not come forward in this proceeding to articulate or prove any legitimate reason for registering the Domain Name, which is very similar to Complainant's senior and registered mark, and which Respondent has used to offer the same types of services as Complainant offers under its registered mark.

Based on the evidence presented by Complainant, and Respondent's lack of any contrary assertions or evidence, the Panel concludes that Respondent was not the owner of the Domain Name before October 6, 2017 by which time Complainant's mark had been registered for 5 years. The Panel also finds it more likely than not that, for a time (at least in 2019), Respondent operated a website that connected prospective car buyers with Pennsylvania auto dealerships. As noted above, Respondent's home state is Pennsylvania. Moreover, illustrating likely knowledge of Complainant's mark the website content changed after Complainant's counsel sent a cease-and-desist letter, which ultimately reached Respondent.

In the Panel's view, Respondent likely acquired the Domain Name in 2017, well after Complainant's CARSFORSALE.COM trademark was registered and had acquired some measure of notoriety, and Respondent set up a commercial website offering services essentially identical to those offered by Complainant (albeit limited to Pennsylvania auto dealerships). Such use of the Domain Name to trade off of a prior registered mark is not in the Panel's view a *bona fide* offering of goods or services that would allow Respondent to claim a legitimate interest in the Domain Name.

The Panel concludes that Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation", are evidence of the registration and use of the Domain Name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel incorporates its discussion above in the "Rights or Legitimate Interests" section. The Panel bases its conclusion on the evidence presented by Complainant – and Respondent's failure to dispute

Complainant's evidence and plausible allegations – regarding the timing of Respondent's acquisition of the Domain Name (found by the Panel to be in 2017), and on the fact that the mark and the Domain Name are exceedingly similar and the services offered at Respondent's website competed directly with Complainant's trademarked offerings. In short, the Panel concludes that Respondent more likely than not was aware of, and targeted, Complainant's trademark when registering the Domain Name.

The Panel further concludes that Respondent's operation of a website in 2019 (at least) which offered services identical to those offered by Complainant supports a finding of targeting Complainant's mark with knowledge of the same, which the Panel notes Respondent has not denied (Policy paragraph 4(b)(iv)).

In the alternative, the Panel finds respondent's offer to sell the Domain Name for USD 100,000 constitutes bad faith use within the meaning of the above-quoted Policy paragraph 4(b)(i).

Complainant has established Policy paragraph 4(a)(iii).

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 Domain Name <cars4sale.com> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: May 11, 2022