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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91207836
Party	Plaintiff Volvo Trademark Holding AB
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Date	05/11/2016
Attachments	Deposition of M. Dempe Exhibit 68 part 1.pdf(3422284 bytes) Deposition of M. Dempe Exhibit 68 part 2.pdf(3532499 bytes) Deposition of M. Dempe Exhibit 69 part 1.pdf(2900668 bytes) Deposition of M. Dempe Exhibit 69 part 2.pdf(4187334 bytes) Deposition of M. Dempe Exhibit 69 part 3.pdf(4071454 bytes) Deposition of M. Dempe Exhibit 70 part 1.pdf(3123163 bytes) Deposition of M. Dempe Exhibit 70 part 2.pdf(4495035 bytes) Deposition of M. Dempe Exhibit 70 part 3.pdf(4249330 bytes) Deposition of M. Dempe Exhibit 70 part 4.pdf(4360351 bytes) Deposition of M. Dempe Exhibit 71 part 1.pdf(4039623 bytes) Deposition of M. Dempe Exhibit 71 part 2.pdf(4075851 bytes) Deposition of M. Dempe Exhibit 72 part 1.pdf(2500987 bytes) Deposition of M. Dempe Exhibit 72 part 2.pdf(3751845 bytes)

EXHIBIT 68

**UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION**

AB VOLVO, a corporation organized under the laws of Sweden, **VOLVO CONSTRUCTION EQUIPMENT NORTH AMERICA, INC.**, a corporation organized under the laws of Delaware, **VOLVO TRUCKS NORTH AMERICA, INC.**, a corporation organized under the laws of Delaware, **VOLVO TRADEMARK HOLDING AB**, a corporation organized under the laws of Sweden, and **VOLVO CARS OF NORTH AMERICA, INC.**, a corporation organized under the laws of New Jersey, and **FORD MOTOR COMPANY**, a Delaware Corporation,

Plaintiffs,

v.

MACHINEWORKS, INC., a New Jersey corporation, and **NEAL MCKEAN**, an individual,

Defendants.

**ORDER AND PERMANENT
INJUNCTION, JUDGMENT, ORDER
TRANSFERRING DOMAIN NAMES,
AND ORDER OF DISMISSAL WITH
PREJUDICE**

**HONORABLE VICTORIA A.
ROBERTS**

**MAGISTRATE JUDGE STEVEN R.
WHALEN**

CIVIL ACTION NO. 2:06-CV-10562

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Attorneys for Defendants

At a session of said Court held in the Federal Building, City of Detroit, County of Wayne, and State of Michigan, on May 18, 2006

PRESENT: Hon. Victoria A. Roberts
U.S. District Court Judge

Based upon the Stipulation and Consent of the parties, plaintiffs AB Volvo, Volvo Construction Equipment North America, Inc., Volvo Trucks North American, Inc., Volvo Trademark Holding AB, Volvo Cars of North America, Inc., and Ford Motor Company (collectively "Plaintiffs"), on the one hand, and defendants Machineworks, Inc., and Neal McKean (collectively "Defendants"), on the other hand, the Court, pursuant to 15 U.S.C. § 1116 (1988), hereby enters the following Order and Permanent Injunction, Judgment, Order Transferring Domain Names, and Order of Dismissal With Prejudice relating to Defendants' use of the trademarks, both registered in the United States Patent and Trademark Office, and at common law, developed by Plaintiffs, including but not limited to, FORD® and VOLVO® (collectively "Plaintiffs Marks"):

1. Defendants are hereby enjoined permanently from all unauthorized uses of Plaintiffs' Marks in their products, services, advertisements, videos, promotional literature, promotional telecasts, broadcasts, signage, on the Internet, or otherwise, in connection with the advertisement and sale of any product, good, part, or service. Specifically, by way of illustration and without limiting the above, Defendants are enjoined permanently from:

a. using in any way the Internet domain names USED FORD TRUCKS.COM and USED VOLVO.COM, or any other domain name containing or using any of Plaintiffs' Marks or variations of Plaintiffs' Marks (the "Domains").

b. registering and/or using in the future other Internet domain names that use Plaintiffs' Marks, or a variation of Plaintiffs' Marks.

2. Defendants stipulate and agree that on or before May 19, 2006, Defendants shall pay to Plaintiffs by cashier's check the sum of \$5,000.00.

3. On or before May 19, 2006, Defendants shall disclose to counsel for Plaintiffs in writing any other domain names that Defendants have registered that use or contain any of Plaintiffs' Marks, or any variation of Plaintiffs' Marks.

4. The Internet domain names USED FORD TRUCKS.COM and USED VOLVO.COM, and any other domain name containing or using any of Plaintiffs' Marks or variations of Plaintiffs' Marks, are hereby transferred to Plaintiffs immediately. Defendants shall perform all acts necessary to effect the transfer of the Domains to Plaintiffs.

5. Defendants are ordered, pursuant to 15 U.S.C. § 1116 (1988), to file with the Court and serve on Plaintiffs' counsel, on or before November 30, 2006, a report in writing under oath setting forth in detail the manner and form in which Defendants have complied with this Order.

6. The Order and Permanent Injunction set forth above shall remain in effect indefinitely and the Court retains jurisdiction to enforce the terms of said Order and Permanent Injunction; and

7. The above-captioned action is hereby dismissed with prejudice, with each party bearing its own costs and attorneys' fees except as set forth in paragraph 2 above.

IT IS SO ORDERED.

S/Victoria A. Roberts

United States District Judge

**UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION**

AB VOLVO, a corporation organized under the laws of Sweden, **VOLVO CONSTRUCTION EQUIPMENT NORTH AMERICA, INC.**, a corporation organized under the laws of Delaware, **VOLVO TRUCKS NORTH AMERICA, INC.**, a corporation organized under the laws of Delaware, **VOLVO TRADEMARK HOLDING AB**, a corporation organized under the laws of Sweden, and **VOLVO CARS OF NORTH AMERICA, INC.**, a corporation organized under the laws of New Jersey, and **FORD MOTOR COMPANY**, a Delaware Corporation,

Plaintiffs,

v.

MACHINEWORKS, INC., a New Jersey corporation, and **NEAL MCKEAN**, an individual,

Defendants.

STIPULATION FOR ORDER OF PERMANENT INJUNCTION, JUDGMENT, ORDER TRANSFERRING DOMAIN NAMES, AND ORDER OF DISMISSAL WITH PREJUDICE

HONORABLE VICTORIA A. ROBERTS

MAGISTRATE JUDGE STEVEN R. WHALEN

CIVIL ACTION NO. 2:06-CV-10562

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Attorneys for Defendants

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1. Defendants are hereby enjoined permanently from all unauthorized uses of Plaintiffs' Marks in their products, services, advertisements, videos, promotional literature, promotional telecasts, broadcasts, signage, on the Internet, or otherwise, in connection with the advertisement and sale of any product, good, part, or service. Specifically, by way of illustration and without limiting the above, Defendants are enjoined permanently from:

a. using in any way the Internet domain names USED FORD TRUCKS.COM and USED VOLVO.COM, or any other domain name containing or using any of Plaintiffs' Marks or variations of Plaintiffs' Marks (the "Domains").

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6. The Order and Permanent Injunction set forth above shall remain in effect indefinitely and the Court retains jurisdiction to enforce the terms of said Order and Permanent Injunction; and

7. The above-captioned action is hereby dismissed with prejudice, with each party bearing its own costs and attorneys' fees except as set forth in paragraph 2 above.

SO STIPULATED NOTICE OF ENTRY WAIVED:

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DATED: May 16, 2006

EXHIBIT 69

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

VOLVO TRADEMARK HOLDING AB,)	
et al.)	
)	
Plaintiffs,)	
)	
v.)	No. 1:09cv1247 (AJT/IDD)
)	
VOLVOSPARES.COM)	
)	
Defendant.)	

ORDER

Upon consideration of Plaintiffs' Motion for Summary Judgment (Doc. No. 9) and the memoranda and exhibits in support thereof, the Court finds for the reasons set forth in the accompanying Memorandum Opinion that there are no genuine issues of material fact and that Plaintiffs are entitled to judgment in its favor as a matter of law; and it is hereby

ORDERED that Plaintiffs' Motion for Summary Judgment (Doc. No. 9) be, and the same hereby is, GRANTED; it is further

ORDERED that judgment be, and the same hereby is, entered in favor of Plaintiffs and against Defendant volvospare.com; and it is further

ORDERED that the domain name volvospare.com be, and the same hereby is, cancelled, forfeited, and transferred to Plaintiffs pursuant to 15 U.S.C. § 1125(d)(2).

The Clerk is directed to enter judgment in favor of Plaintiffs pursuant to Fed. R. Civ. P. 58 and to forward copies of this Order and accompanying Memorandum Opinion to all counsel of record and to Ken White.

This Order is final.



Anthony J. Trenga
United States District Judge

Alexandria, Virginia
April 1, 2010

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

VOLVO TRADEMARK HOLDING AB,)	
et al.)	
)	
Plaintiffs,)	
)	
v.)	No. 1:09cv1247 (AJT/IDD)
)	
VOLVOSPARES.COM)	
)	
Defendant.)	

MEMORANDUM OPINION

This matter is before the Court on Plaintiffs' Motion for Summary Judgment (Doc. No. 9). In their motion, Plaintiffs Volvo Trademark Holding AB, AB Volvo, Volvo Car Corporation, and Volvo Cars of North America, Inc. (collectively, "Plaintiffs" or "Volvo") request that the Court order VeriSign Naming Services to change the registrant of the domain name in dispute, "volvospares.com" to Volvo Trademark Holding AB pursuant to the Anticybersquatting Consumer Protection Act ("ACPA"), 15 U.S.C. § 1125(d)(2).

I. BACKGROUND

Plaintiffs filed a Verified Complaint (the "Complaint") on November 5, 2009 alleging that volvospares.com, a website that sells Volvo used parts, is an unauthorized use of the Plaintiffs' registered VOLVO mark, that such use is likely to cause confusion, that such use dilutes and tarnishes the VOLVO mark, and that the mark is being used in bad faith and with the intent to profit.

Volvo mailed a copy of the Complaint via First Class Mail and email to the volvospares.com registrant, Ken White, ("White") and then published notice of the action on

December 3, 2009 pursuant to a Court Order permitting service by publication. Defendant domain name volvospare.com (through White) was required to file a responsive pleading by December 23, 2009. No answer or other responsive pleading was filed by that date, although, as discussed *infra*, White mailed a document to the Court that was received on February 12, 2010 and another received on February 18, 2010.

II. UNDISPUTED FACTS

The following facts are undisputed:

1. Volvo, along with Volvo's network of authorized dealers, sell Volvo goods and services, automobiles, parts, replacement parts, and other products related to Volvo. Volvo is a successful automobile manufacturer and is known worldwide.
2. Volvo Trademark Holding AB first obtained a trademark registration for VOLVO in 1956 and has obtained other registrations for VOLVO over the years.
3. Volvo has used the VOLVO mark continuously since its registration in advertisements and promotions all over the world.
4. The VOLVO mark is a well recognized mark in the United States as a designation of a source of Volvo goods or services.
5. Volvo operates a number of websites using the VOLVO mark, including volvo.com and volvocars.com, to advertise its goods and services.
6. White registered volvospare.com on January 13, 1997, forty-one years after Volvo registered the VOLVO mark.
7. The website volvospare.com currently displays images of Volvo automobiles and advertises the sale of "new, used, and reconditioned Volvo parts."

8. Volvospare.com is used to conduct business offering for sale new and used parts in direct competition with authorized Volvo dealers and service centers.

9. Since receiving notice that his use of the domain name was being challenged, White has added a disclaimer on the volvospare.com website that states:

DISCLAIMER: Volvospare.com has no affiliation with Volvo Group and makes no claim to or implication of being associated in any official business capacity in conjunction with or for such companies.

10. White altered the registrant name from "Cyberzone Ltd." with an address in the United Kingdom to "VolvoSpare" with an address in Spain after he was given actual notice that his use of the domain name was being challenged.

11. After White failed to respond to a series of demand letters, Volvo initiated an administrative process against White pursuant to the Uniform Domain Name Dispute Resolution Policy ("UDRP") and adjudicated by the World Intellectual Property Organization ("WIPO"). The panelist assigned to the case determined that volvospare.com was confusingly similar, but that Volvo did not establish that White's use of the domain name was in bad faith, a requirement under the UDRP, since there was no evidence in those proceedings that White misrepresented his business to customers or the public at large.

III. STANDARD OF REVIEW

Summary judgment is appropriate only if the record shows that "there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." FED. R. CIV. P. 56(c); *see also Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48 (1986); *Evans v. Techs. Apps. & Serv. Co.*, 80 F.3d 954, 958-59 (4th Cir. 1996). The party seeking summary judgment has the initial burden to show the absence of a material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). A genuine issue of material fact exists "if the evidence is

such that a reasonable jury could return a verdict for the nonmoving party.” *Anderson*, 477 U.S. at 248. Once a motion for summary judgment is properly made and supported, the opposing party has the burden of showing that a genuine dispute exists. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586-87 (1986). To defeat a properly supported motion for summary judgment, the non-moving party “must set forth specific facts showing that there is a genuine issue for trial.” *Anderson*, 477 U.S. at 247-48 (“[T]he mere existence of *some* alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no *genuine* issue of *material* fact.”) (emphasis in original). Whether a fact is considered “material” is determined by the substantive law, and “[o]nly disputes over facts that might affect the outcome of the suit under the governing law will properly preclude the entry of summary judgment.” *Id.* at 248. The facts shall be viewed, and all reasonable inferences drawn, in the light most favorable to the non-moving party. *Id.* at 255; *see also Lettieri v. Equant Inc.*, 478 F.3d 640, 642 (4th Cir. 2007).

IV. ANALYSIS

The Court has *in rem* jurisdiction in this matter over Defendant pursuant to 15 U.S.C. § 1125(d)(2)(A)(ii)(I) because (1) Plaintiffs cannot obtain *in personam* jurisdiction over the registrant, White, since he is located outside of the United States and (2) the domain name registry, VeriSign Naming Services, is located in this district.

To prevail in this ACPA claim on summary judgment, Plaintiffs must establish that there is no genuine issue of material fact as to the following elements: (1) White has a bad faith intent to profit from the VOLVO mark and (2) White registered or uses a domain name that “is identical or confusingly similar to or dilutive of” a famous mark. 15 U.S.C. § 1125(d)(1)(A).

The Court finds that no genuine issue of material fact exists, and that summary judgment should be granted in favor of Plaintiffs.

A. Whether there is a “bad faith intent to profit”

There is no applicable statutory definition of “bad faith” or “bad faith intent to profit.”

Rather, 15 U.S.C. § 1125(d)(1)(B) sets forth factors that a court may consider in assessing whether there is bad faith intent to profit. The factors relevant to this case are:

(III) the person’s prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

* * *

(V) the person’s intent to divert consumers from the mark owner’s online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

* * *

(VII) the person’s provision of material and misleading false contact information when applying for the registration of the domain name, the person’s intentional failure to maintain accurate contact information, or the person’s prior conduct indicating a pattern of such conduct; [and]

* * *

(IX) the extent to which the mark incorporated in the person’s domain name registration is or is not distinctive and famous within the meaning of subsection (c).

A court is obligated to look at the individual circumstances of each case, and a court need not consider every factor in each case; instead the factors are intended to serve as a guide while the court carefully considers “whether the conduct at issue is motivated by a bad faith intent to profit.” *Lamparello v. Falwell*, 420 F.3d 309, 319-320 (4th Cir. 2005) (internal quotations omitted). Because “intent is rarely discernable directly, it must typically be inferred from pertinent facts and circumstances.” *Int’l Bancorp, LLC v. Societe Des Baines De Mer Et Du Cercle Des Etrangers a Monaco*, 192 F. Supp. 2d 467, 486 (E.D. Va. 2001) (inferring bad faith

intent in use of infringing domain name based on defendant's use of commonly recognized mark to divert business from rightful holder) *aff'd on other grounds*, 329 F.3d 359 (4th Cir. 2003).

Applying the facts here to the factors listed in 15 U.S.C. § 1125(d)(1)(B), the Court finds and concludes that White was acting in bad faith with intent to profit from use of the VOLVO mark in *volvospares.com*. White intended to divert sales from authorized Volvo dealers, the VOLVO mark was registered long before White began using *volvospares.com*, and White should have known that he was infringing based on the distinctiveness of the VOLVO mark.

B. Whether *volvospares.com* is a domain name that is “confusingly similar to or dilutive of” the VOLVO mark.

As a preliminary matter, the Court concludes that the VOLVO mark is distinctive and famous. A mark is famous if it is “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.” 15 U.S.C. § 1125(c)(2)(A). In determining whether a mark is famous, the Court may consider all relevant factors including: (1) the duration, extent, and geographic extent of advertising and publicity of the mark; (2) the amount, volume, and geographic extent of sales of goods or services offered under the mark; and (3) the extent of actual recognition of the mark. *Id.* Here, Volvo has been using the VOLVO mark continuously in connection with promotion and advertisement of Volvo products since at least the registration of the VOLVO mark more than fifty years ago in 1956; and the VOLVO mark enjoys widespread recognition in the United States. The Court therefore concludes that the mark is famous. *See Continental Airlines, Inc. v. Continentalair.com*, 1:09cv770, 2009 WL 4884534, *6 (E.D. Va. Dec.17, 2009) (finding the Continental Airlines mark distinctive and famous because of its continuous use in interstate commerce, use in advertising services, and wide recognition).

The Court next finds and concludes that *volvospares.com* is confusingly similar to or dilutive of the VOLVO mark. In assessing whether a mark is confusingly similar, the allegedly infringing domain name does not need to be identical to the registered mark. Rather, the “dominant or salient portions” of the domain name must be sufficiently similar. *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Virginia, Inc.*, 43 F.3d 922, 936 (4th Cir. 1995). In this case, the Court finds that “Volvo” is the dominant portion of *volvospares.com* and that *volvospares.com* is therefore confusingly similar to VOLVO. *See Lone Star Steakhouse & Saloon, Inc.*, 43 F.3d at 936 (prohibiting use of name Lone Star Grill because it infringed on “Lone Star” mark). *See also Harrods Ltd. v. Sixty Internet Domain Names*, 157 F. Supp. 2d 658, 677-78 (E.D. Va. 2001) (holding that combining mark with “other generic or geographic terms” does not “diminish the similarity of the defendant Domain Names to the HARROD’s mark” and citing a law review article for the proposition that “among the various forms of cybersquatting is the registration of another’s mark or name as part of a domain name, such as ‘dellspareparts.com’ for a business selling spare parts for Dell computers”) (internal quotations omitted) *aff’d in relevant part*, 302 F.3d 214 (4th Cir. 2002); *Prime Publishers, Inc. v. Am.-Republican, Inc.*, 160 F. Supp. 2d 266, 280 (D. Conn. 2001) (“We do not believe the Defendant’s addition of a generic or geographic term such as ‘ct’ is sufficient to distinguish the domain name from Plaintiff’s protected mark. An internet user might reasonably assume that [ct] was added to the Plaintiff’s mark by Plaintiff.”).

The Court further finds and concludes that the disclaimer added to *volvospares.com* does not negate this confusion. *Green Prods. Co. v. Independence Corn By-Prods. Co.*, 992 F. Supp. 1070, 1076, 1078 (N.D. Iowa 1997) (holding that even though the domain holder did not intend to pass his products off as the mark holder’s, he “did intend to pass off its domain name as

though it belonged to Green Products. . . . [Defendant domain name] could deceptively lure potential customers onto its own turf. . . . [S]uch a deceptive use of competitor's trademark as a way to lure customers away from the competitor is a kind of consumer confusion"); *New York State Soc. Of Certified Public Accountants v. Eric Louis Assocs., Inc.*, 79 F. Supp. 2d 331, 342 (S.D.N.Y. 1999) (finding that disclaimer defense "ignores the *initial* confusion caused by defendant's use of" the infringing trademark) (emphasis in original).

As noted above, White has not filed an answer or formally responded to Plaintiffs' Motion for Summary Judgment. He has, however, addressed the merits of Volvo's claims in two submissions, which the Court has considered despite the procedural irregularity of these filings. First, in a submission received February 12, 2010, White attaches the UDRP decision and asks the Court to consider it as evidence. Second, in a one-page submission received February 18, 2010, White notes that the registration of *volvospares.com* predated Plaintiffs' registration of the domain names pairing the VOLVO mark with other generic terms, such as *volvoparts.com* and *volvoaccessories.com*. These considerations do not establish a genuine issue of material fact and do not alter the Court's conclusions regarding the confusing similarity of *volvospares.com* to Volvo and the bad faith registration of the domain name. With respect to the UDRP decision, the Court concludes that the UDRP decision does not preclude Plaintiffs from seeking relief in this Court. *Eurotech, Inc. v. Cosmos European Travels Aktiengesellschaft*, 213 F. Supp. 2d 612, 618 n.10 (E.D. Va. 2002) ("Worth noting here is that the result reached in the WIPO proceeding is neither admissible, nor entitled to any deference, with respect to the merits issues presented in this suit. Review here must be *de novo* and independent of any WIPO panel conclusion."). With respect to the timing of the registration of *volvospares.com* relative to other Volvo domain names, the critical inquiry is whether *volvospares.com* infringes the VOLVO mark, which

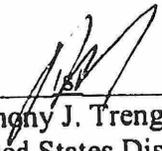
predated volvospare.com by several decades. Having concluded that volvospare.com infringes the VOLVO mark, the timing of its registration before other referenced Volvo sponsored domain names does not negate its actionable infringement.

Volvo has established that White registered the domain name in bad faith with the intent to profit and that volvospare.com is confusingly similar to the registered mark, VOLVO.

V. CONCLUSION

For the reasons stated herein, summary judgment is granted in favor of Plaintiffs and the domain name volvospare.com should be transferred to Volvo Trademark Holding AB.

An appropriate Order will issue.



Anthony J. Trenga
United States District Judge

Alexandria, Virginia
April 1, 2010

EXHIBIT 70

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FILED
U.S. DISTRICT COURT
2010 JAN 11 P 2:05
DISTRICT OF UTAH
BY: [Signature] CLERK

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF UTAH**

<p>FORD MOTOR COMPANY, a Delaware corporation, VOLVO TRADEMARK HOLDING AB, a corporation organized under the laws of Sweden, and VOLVO CARS OF NORTH AMERICA, INC. a corporation organized under the laws of New Jersey,</p> <p style="text-align: center;">Plaintiffs,</p> <p style="text-align: center;">vs.</p> <p>RANDE BLAIR PETERSON, an individual and doing business as NATIONWIDE HUBCAPS, and VARIOUS JOHN AND JANE DOES AND ABC COMPANIES</p> <p style="text-align: center;">Defendants.</p>	<p>STIPULATED FINAL JUDGMENT, ORDER OF PERMANENT INJUNCTION, AND ORDER OF DISMISSAL</p> <p>Civil No. 1:09-CV-00031 CW</p> <p>Judge Clark Waddoups</p>
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I. STIPULATION

Plaintiffs Ford Motor Company (“Ford”), Volvo Trademark Holding AB, and Volvo Cars of North America, Inc. (collectively “Volvo”) (all collectively “Plaintiffs”), and defendants Rande Blair Peterson, an individual doing business as Nationwide Hubcaps (collectively

“Defendant”), having reached a settlement of all claims asserted in this action, hereby stipulate to and jointly move the Court for the entry of the following:

II. ORDER OF PERMANENT INJUNCTION

The Court, having considered the parties’ stipulation, along with the submission of evidence submitted by Plaintiffs during earlier proceedings in this action, including during the hearing on Plaintiffs’ Motion for *Ex Parte* Seizure Order on March 12, 2009, and good cause appearing therefore, now enters the following:

FINDINGS OF FACT

1. Plaintiff Ford is a Delaware corporation with its principal place of business in Dearborn, Michigan. Plaintiff Volvo Trademark Holding AB is a corporation organized under the laws of Sweden. Plaintiff Volvo Cars of North America, Inc. is a New Jersey corporation with its principal place of business in Rockleigh, New Jersey.

2. Defendant Rande Blair Peterson is an individual with his principal place of business at 1361 West 3150 South, Syracuse, Utah 84075. Defendant Peterson has done and continues to do business under the registered DBA “Nationwide Hubcaps.”

Findings Regarding Plaintiffs’ Trademark Rights

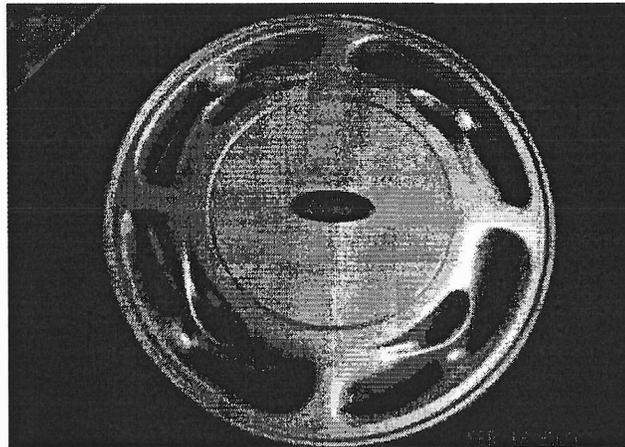
3. Ford owns federally protected trademark rights in the trademark FORD®, which was first registered with the United States Patent and Trademark Office in 1909, and Ford has subsequently obtained numerous registrations for that mark, including but not limited to U.S. Registration No. 74,530. [Verified Complaint, Ex. B] Ford’s registrations for the trademark FORD® are valid, unrevoked, subsisting, and incontestable.

4. Ford began using the FORD BLUE OVAL LOGO®, as depicted below, in 1966, and first obtained a trademark registration for the FORD BLUE OVAL LOGO® in 1986. Ford has subsequently obtained registrations for that mark, including but not limited to U.S

Registration No. 1,399,080. [Verified Complaint, Ex. C] Ford's registrations for the FORD BLUE OVAL LOGO® mark are valid, unrevoked, subsisting, and incontestable.



5. Ford uses the FORD® trademark and the FORD BLUE OVAL LOGO® (collectively the “Ford Marks”) to identify its products and services. Ford produces wheels, wheel covers, and hubcaps that bear the Ford Marks. An example of a genuine Ford hubcap is depicted below:



[Verified Complaint ¶ 12; Pl. Hearing Ex. 1]¹

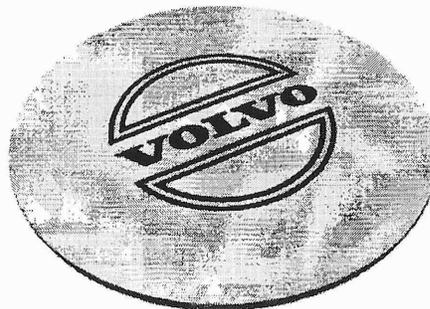
¹ At the sealed hearing to consider Plaintiff's Application for *Ex Parte* Seizure Order held on March 12, 2009, Plaintiff proffered, and the Court considered, a number of Exhibits as examples of both Plaintiff's and Defendant's goods, packaging, and records of purchases of products from Defendant. These Exhibits shall be referred to in this Order as “Pl. Hearing Ex. ___.”

6. Volvo Trademark Holding AB, through its predecessors in interest, first obtained a United States Trademark Registration for the trademark VOLVO® in 1956, including but not limited to U.S. Registration No. 636,129. [Verified Complaint, Ex. D] Volvo Trademark Holding AB United States trademark registrations for the trademark VOLVO® and the design mark VOLVO® depicted below:

VOLVO

The trademark VOLVO® and the design mark VOLVO® are collectively referred to as the “Volvo Marks.” These registrations are valid, unrevoked, subsisting, and incontestable. The Ford Marks and the Volvo Marks are sometimes collectively referred to herein as “Plaintiffs’ Marks.”

7. Volvo and its licensees and related companies use the Volvo Marks to identify their products and services. Volvo and its licensees and related companies have produced and sold and produces and sells wheels, wheel covers, and/or hubcaps that bear the Volvo Marks that compete directly with Defendant’s merchandise. An example of a genuine Volvo hubcap is depicted below:



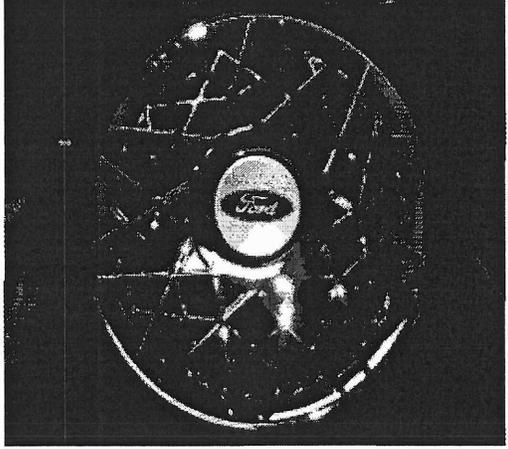
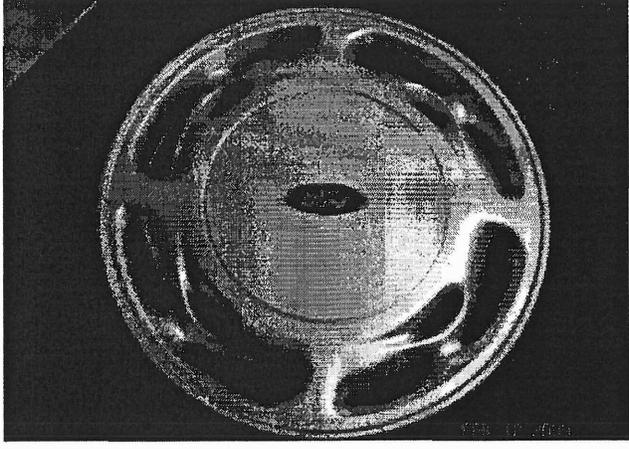
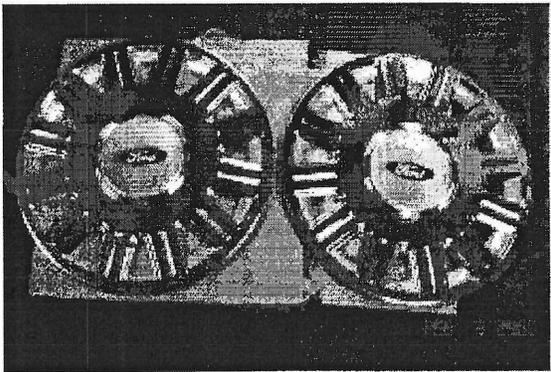
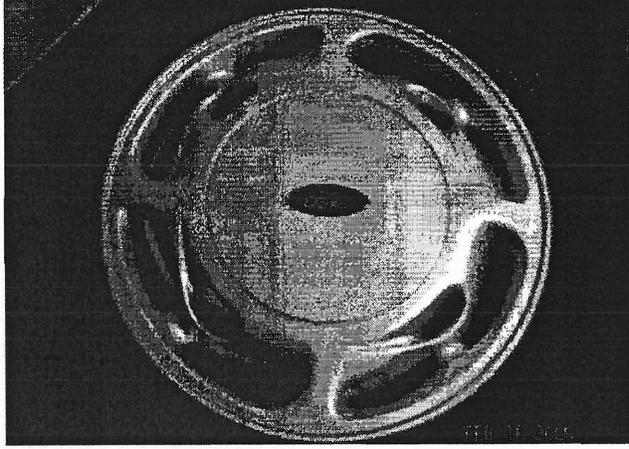
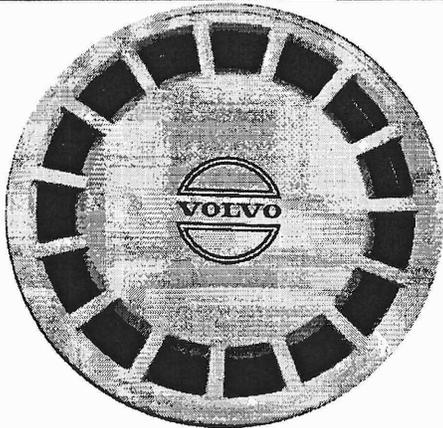
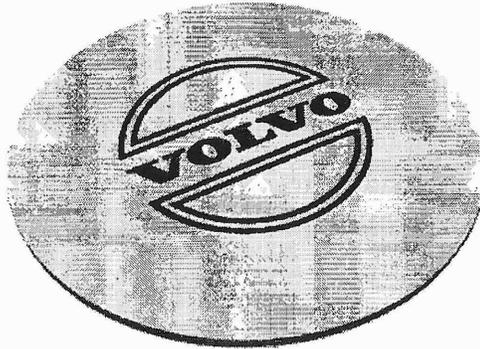
[Verified Complaint ¶ 14]

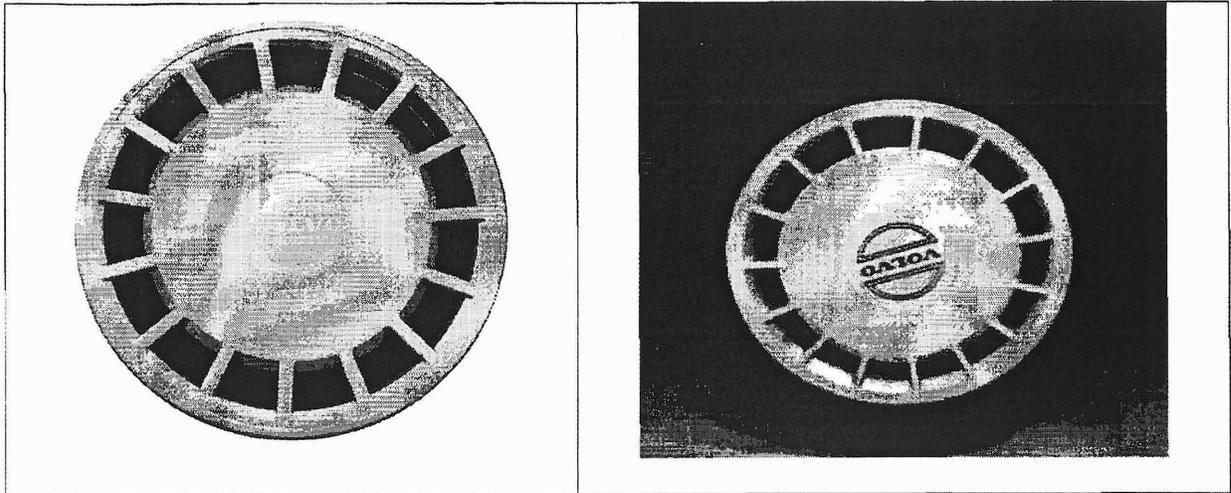
8. Plaintiffs have spent hundreds of millions of dollars and have expended significant effort in advertising, promoting, and developing Plaintiffs' Marks throughout the world. As a result of such advertising and expenditures, Plaintiffs' Marks have become widely known and recognized throughout the world and are famous and distinctive within the meaning of the Lanham Act. [Verified Complaint ¶ 16]

Findings Regarding Defendant's Violations of Plaintiffs' Marks

9. Subsequent to Plaintiffs' development, use, and registration of Plaintiffs' Marks and without Plaintiffs' consent, Defendant began using counterfeits of Plaintiffs' Marks, or confusingly close and extremely similar versions of them, on and in connection with Defendant's products. Defendant has admitted that he purchased copies of Plaintiffs' Marks on stickers, and then applied such stickers to hubcaps and wheel center caps, thereby creating products for resale bearing unauthorized counterfeits of Plaintiffs' Marks. [Declaration of Scott R. Ryther ¶¶ 4-7]

10. As shown in the following side-by-side comparison, Defendant has produced, advertised, offered for sale, and sold wheel covers and/or hubcaps that incorporate counterfeits of the FORD BLUE OVAL® trademark and that incorporate a counterfeit of the VOLVO® trademark.

Defendants' Products	Genuine Ford and Volvo Products
	
	
	



[Verified Complaint ¶ 17; Pl. Hearing Exs. 1-5]

11. Defendant operates an Internet website at www.nationwidehubcaps.net where Defendant has advertised and sold the counterfeit Ford and Volvo hubcaps. [Verified Complaint ¶ 20 & Ex. E thereto]

12. Defendant is not affiliated with, authorized, or sponsored by Plaintiffs and Defendant has never been given authority to use Plaintiffs' Marks to identify Defendant's products, or to apply Plaintiffs' Marks to Defendant's products.

Findings Regarding Plaintiffs' Claims For Trademark Infringement And Counterfeiting

13. Defendant's application of stickers replicating Plaintiffs' Marks on Defendant's hubcaps and other products is likely to cause potential purchasers of Defendant's products, as well as the public at large, to believe that Defendant's products are affiliated with, authorized, sponsored by, or endorsed by Plaintiffs. Thus, the Court finds that Defendant's unauthorized use of Plaintiffs' Marks creates a strong likelihood of initial-interest (pre-sale) confusion, and post-sale confusion, as well as a substantial likelihood of point-of-sale confusion.

14. Defendant has used Plaintiffs' Marks and/or intentionally similar copies of them with actual knowledge of Plaintiffs' prior adoption and use of Plaintiffs' Marks.

15. The Court further finds that Defendant has carried out its acts with the intent to trade on the goodwill and reputation of Plaintiffs and Plaintiffs' Marks, and with the intent to mislead at least those observers of Defendant's products away from the point of sale (*i.e.*, Defendant intended to create initial-interest and post-sale confusion).

16. Defendant's activities have caused irreparable damage to Plaintiffs and to the value of Plaintiffs' Marks. Without the entry of permanent injunctive relief preventing Defendant from future use of Plaintiffs' Marks, Plaintiffs would continue to suffer irreparable harm.

Findings Regarding Plaintiffs' Claims For Trademark Dilution

17. Plaintiffs' Marks became famous and distinctive within the meaning of the Lanham Act before Defendant began using Plaintiffs' Marks and/or close and very similar copies of Plaintiffs' Marks.

18. Defendant's use of Plaintiffs' Marks or confusingly similar versions of Plaintiffs' Marks is likely to dilute and therefore decrease the sharp distinctiveness of Plaintiffs' Marks.

19. In addition, because Defendant uses cheap and non-durable stickers to apply Plaintiffs' Marks to Defendant's products, Defendant's use of Plaintiffs' Marks on hubcaps and other products is likely to cause dilution of Plaintiffs' Marks by tarnishing them.

CONCLUSIONS OF LAW

1. This Court has subject matter jurisdiction over the claims asserted by Plaintiffs.

2. Venue is proper under 28 U.S.C. § 1391(b) given that a substantial part of the events giving rise to the claims occurred in this District and because Defendants may be found here.

3. Based on the findings set forth above, Plaintiffs are entitled to judgment in their favor on their claims for trademark infringement and counterfeiting (First Claim), false

designation of origin (Second Claim), and federal trademark dilution (Third Claim) asserted in the Verified Complaint.

4. The entry of permanent injunctive relief is necessary to prevent continued irreparable harm to Plaintiffs and to Plaintiffs' Trademarks.

PERMANENT INJUNCTION

1. Defendant, and all of Defendant's owned legal entities, agents, servants, employees, attorneys, and all other persons in active concert or participation with Defendant who receive actual notice of this Order, are hereby ordered and enjoined as follows:

a. To the extent that Defendant has not already done so, Defendant shall, within 5 business days of the entry of this Order, immediately deliver to Plaintiffs and/or Plaintiffs' legal representatives, all wheels, wheel covers, hubcaps, wheel center caps, or any other products bearing counterfeits or copies of the trademark FORD®, the FORD BLUE OVAL® trademark, and the trademark VOLVO® and the design mark VOLVO®, and any equipment or means for copying or making any product, sticker, label, and all tags, signs, prints, packages, videos, and advertisements in Defendant's possession or control, bearing or using any or all of Plaintiffs' Marks or any confusingly similar variation thereof, and all other plates, molds, matrices and other means of making the same, pursuant to 15 U.S.C. § 1118. To the extent that Defendant has already surrendered items covered by this subparagraph pursuant to the execution of the Court's *Ex Parte* Seizure Order issued and executed on March 13, 2009, such surrendered items shall remain in the possession of Plaintiffs and/or their counsel, and may be disposed of and/or destroyed by Plaintiffs;

b. Defendant, and all of Defendant's owned legal entities, agents, servants, employees, attorneys, and all other persons in active concert or participation with Defendant who receive actual notice of this Order, are hereby enjoined from:

(1) imitating, copying, or making unauthorized use of any of Plaintiffs' Marks, counterfeits thereof, or any confusingly similar variations thereof on or in connection with any of Defendant's products, including hubcaps, wheel covers, wheel center caps, or any other products or services of Defendant;

(2) importing, manufacturing, producing, distributing, circulating, selling, offering for sale, advertising, promoting or displaying any service or product using any simulation, reproduction, counterfeit, copy, or any confusingly similar variation of any of Plaintiffs' Marks;

(3) using any simulation, reproduction, counterfeit, copy or confusingly similar variation of Plaintiffs' Marks in connection with the promotion, advertisement, display, sale, offering for sale, manufacture, production, circulation or distribution of any service or product;

(4) using any false designation of origin or false description (including, without limitation, any letters or symbols constituting Plaintiffs' Marks or trade dress), or performing any act, which can, or is likely to lead members of the trade or public to believe that any service or product manufactured, distributed or sold by Defendants is in any manner associated or connected with Plaintiffs, or is sold, manufactured, licensed, sponsored, approved or authorized by Plaintiffs;

(5) transferring, consigning, selling, shipping or otherwise moving any goods, packaging or other materials in Defendant's possession, custody or control bearing a design or mark substantially similar to any or all of Plaintiffs' Marks;

(6) engaging in any other activity constituting unfair competition with Plaintiffs with respect to Plaintiffs' Marks, or constituting an infringement of any or all of Plaintiffs Marks, or of Plaintiffs' rights in, or to use or exploit, any or all of Plaintiffs' Marks or trade dress; and

(7) instructing, assisting, aiding or abetting any other person or business entity in engaging in or performing any of the activities referred to in subparagraphs b(1) through b(6) above.

2. Defendant is ordered to disclose to Plaintiffs, and to permit Plaintiffs, and/or auditors for Plaintiffs, to audit and inspect the books and records of Defendant, upon reasonable notice of not less than three business days, for a period two years after entry of this Order, to determine and verify Defendant's compliance with this Order Of Permanent Injunction.

III. PARTIES' SETTLEMENT

Plaintiffs and Defendant have entered into a Settlement Agreement for the resolution of Plaintiffs' claims asserted in this matter. A copy of the parties' Settlement Agreement (with its Paragraph 2 redacted for purposes of confidentiality) is attached to this STIPULATED FINAL JUDGMENT, PERMANENT INJUNCTION, AND ORDER OF DISMISSAL as Exhibit "A." The Court hereby incorporates the terms of the Settlement Agreement into this FINAL JUDGMENT, PERMANENT INJUNCTION, AND ORDER OF DISMISSAL, and retains jurisdiction to enforce the terms of the Settlement Agreement (including the confidential provisions set forth in its Paragraph 2).

IV. ORDER DISMISSING CLAIMS WITH PREJUDICE

Based upon the parties' Stipulation and Settlement, all claims asserted by Plaintiffs in this action are hereby DISMISSED WITH PREJUDICE. However, the Court retains and shall have continuing jurisdiction to enforce the terms of this FINAL JUDGMENT AND PERMANENT INJUNCTION as well as the Settlement Agreement as set forth above.

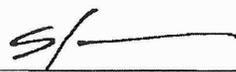
IT IS SO ORDERED.

DATED: January 11, 2010

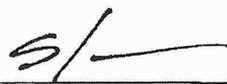
BY THE COURT:


CLARK WADDOUPS
United States District Judge

STIPULATED AND AGREED TO:



Gregory D. Phillips
Scott R. Ryther
Howard Phillips & Andersen
560 East 200 South, Suite 300
Salt Lake City, Utah 84102



Rande Peterson, *Pro Se*
1361 West 3150 South
Syracuse, Utah 84075

Attorneys for Plaintiffs

SETTLEMENT AGREEMENT

THIS SETTLEMENT AGREEMENT dated October 21, 2009 is by and between Ford Motor Company ("Ford") Volvo Trademark Holding AB, and Volvo Cars of North America, Inc. (collectively "Volvo") (all collectively "Ford/Volvo"), on the one hand, and Rande Blair Peterson, an individual doing business as Nationwide Hubcaps ("Peterson"), on the other hand.

BACKGROUND STATEMENT

- A. This Settlement Agreement is made as a complete compromise between the parties for the settlement of the claims, differences and causes of action described below.
- B. Ford/Volvo have demanded that Peterson cease using Ford's and Volvo's famous and distinctive trademarks FORD OVAL Logo®, FORD®, and VOLVO® (collectively the "Ford and Volvo Trademarks") and counterfeits of them on and in connection with the sale by Peterson of hubcaps, wheel center caps, and other products. Ford/Volvo have asserted that Peterson's use of the Ford and Volvo Trademarks as described above constitutes infringement and dilution of the Ford and Volvo Trademarks.
- C. Thus, Ford/Volvo filed a Complaint in the United States District Court for the District of Utah entitled *Ford Motor Company, et. al. v. Peterson, et. al.* (Case No. 1:09-CV-00031 CW) (the "Lawsuit") in which Ford/Volvo filed claims against Peterson for trademark infringement and dilution and other claims.
- D. Ford/Volvo and Peterson have now reached a compromise and settlement of all disputes asserted in the Lawsuit and desire to memorialize the terms of their compromise and settlement in the writing as set forth below, along with a Stipulated Final Judgment, Order Of Permanent Injunction, And Order Of Dismissal, said stipulation to which is entered concurrently with this Settlement Agreement.

STATEMENT OF AGREEMENT

NOW, THEREFORE, in consideration of the promises and covenants contained herein, the parties agree as follows:

1. Agreement to Cease and Desist Unauthorized Use of the Ford and Volvo Trademarks. Peterson agrees to refrain from any uses of the Ford and Volvo Trademarks and/or any variations or confusingly similar versions of such marks, in any products, services, advertisements, videos, promotional literature, promotional telecasts, broadcasts, signage, on the Internet, or otherwise, in connection with the advertisement and sale of any product, good, part, or service, without express written permission from Ford and/or Volvo.
2. Stipulated Judgment, Order Of Permanent Injunction and Dismissal of Lawsuit. Simultaneous with the execution of this Settlement Agreement, Ford/Volvo and Peterson shall stipulate to and jointly move the Court for the entry of the Stipulated Final Judgment, Order

Of Permanent Injunction, And Order Of Dismissal (the "Stipulated Judgment") attached hereto as Exhibit "1."

3. Payment to Ford/Volvo by Peterson. Peterson hereby agrees to pay to Ford Motor Company in bank-certified funds the following sums over the periods set forth below:

- A. No later than October 15, 2009, Peterson shall pay to Ford \$5,000;
- B. Not later than the 15th day of each calendar month beginning on November 15, 2009, Peterson shall pay to Ford eighteen (18) monthly payments of \$1,666 each.

4. Ownership of Ford and Volvo Trademarks; Agreement Not to Challenge Validity. Peterson hereby acknowledges, agrees and assents to Ford/Volvo's exclusive ownership of the Ford and Volvo Trademarks, the validity of Ford and Volvo Trademarks, the unique value of such marks, the goodwill associated therewith in the minds of the public, the world-wide fame and distinctiveness of the Ford and Volvo Trademarks, and the validity of the registrations therefore. Peterson represents, warrants, and covenants to Ford/Volvo that he shall never directly or indirectly raise, cause to be raised, take any action or assert any claim of any kind relating to the exclusive rights of Ford/Volvo and their affiliates in and to the Ford and Volvo Trademarks or the validity of the Ford and Volvo Trademarks or registrations, or oppose, seek or attempt to cancel, object to or otherwise challenge any application or registration for any of the Ford and Volvo Trademarks. Peterson shall never assist, aid or abet any other person or entity in engaging in or performing any of the activities set forth in this Settlement Agreement that Peterson is prohibited from engaging in or performing directly.

5. Mutual Release. Ford/Volvo hereby release and discharge Peterson and his agents, attorneys, and employees from all causes of action asserted (or that might have been asserted) in the Lawsuit arising from any activities or actions by Peterson occurring prior to the entry of the Stipulated Judgment. Peterson hereby releases Ford/Volvo and their related companies, officers, agents, attorneys, directors, and employees from all claims and causes of action asserted or that might have been asserted against Ford/Volvo up to and including the date of entry of the Stipulated Judgment.

6. Mutually Drafted Settlement Agreement and Release: Each of the parties have had the opportunity to be fully and completely represented by counsel of their own choosing in the negotiation and drafting of this Settlement Agreement, and the Stipulated Judgment attached hereto as Exhibit 1. Accordingly, the parties agree that any rule of construction of contracts resolving any ambiguities against the drafting party shall be inapplicable. Further, each party hereto acknowledges reading this entire document and Stipulated Judgment attached as Exhibit 1, understanding their terms and effects, and that this Settlement Agreement is being signed freely by each of the parties. Each of the terms of this Settlement Agreement is contractual, not a mere recital, and are the results of negotiations among the parties.

7. Breach of Settlement Agreement or Violation of Stipulated Judgment, Attorney's Fees. In the event that either party violates the terms of this Settlement Agreement, or in the

event that Peterson violates the Stipulated Judgment, the parties agree that the non-breaching and non-violating party shall be entitled to recover all reasonable attorney's fees and costs incurred in enforcing or seeking relief for any such breach or violation.

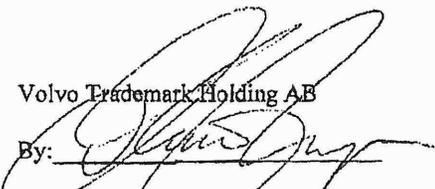
8. Entire Agreement. It is understood and agreed that this Settlement Agreement and the Stipulated Judgment constitute the entire agreement between Ford/Volvo and Peterson and that there are no written or oral understandings or agreements that are directly or indirectly connected with these documents that are not expressly stated herein.

9. Counterparts This Settlement Agreement may be executed in counterparts, each of which shall constitute an original, but all of which when taken together shall constitute one and the same instrument.

WITNESS WHEREOF, the parties have duly executed this Settlement Agreement as of the date first above written.

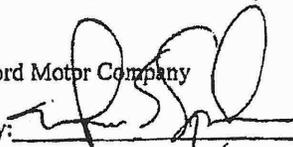
Rande Peterson

Volvo Trademark Holding AB

By: 

Title: Monica Dempe
Managing Director

Ford Motor Company

By: 

Title: ATTORNEY/AUTHORIZED
SIGNATORY

Volvo Cars of North America, Inc.

By: _____

Title: _____

WITNESS WHEREOF, the parties have duly executed this Settlement Agreement as of the date first above written.

Rande Peterson



Ford Motor Company

By: _____

Title: _____

Volvo Trademark Holding AB

By: _____

Title: _____

Volvo Cars of North America, Inc.

By: _____

Title: _____

event that Peterson violates the Stipulated Judgment, the parties agree that the non-breaching and non-violating party shall be entitled to recover all reasonable attorney's fees and costs incurred in enforcing or seeking relief for any such breach or violation.

8. Entire Agreement. It is understood and agreed that this Settlement Agreement and the Stipulated Judgment constitute the entire agreement between Ford/Volvo and Peterson and that there are no written or oral understandings or agreements that are directly or indirectly connected with these documents that are not expressly stated herein.

9. Counterparts This Settlement Agreement may be executed in counterparts, each of which shall constitute an original, but all of which when taken together shall constitute one and the same instrument.

WITNESS WHEREOF, the parties have duly executed this Settlement Agreement as of the date first above written.

Rande Peterson

Volvo Trademark Holding AB

By: _____

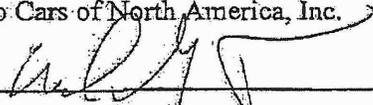
Title: _____

Ford Motor Company

By: _____

Title: _____

Volvo Cars of North America, Inc.

By:  _____

Title: Vice President & General Counsel

EXHIBIT 71



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Volvo Trademark Holding AB v. Wang Songxu

Case No. D2013-0355

1. The Parties

The Complainant is Volvo Trademark Holding AB of Goteborg, Sweden, represented by Sughrue Mion, PLLC, United States of America.

The Respondent is Wang Songxu of Weifang, Shandong, China.

2. The Domain Name and Registrar

The disputed domain name <volvorss.info> 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 February 22, 2013. On February 22, 2013, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 25, 2013, the Registrar 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 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 1, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response was March 21, 2013. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 22, 2013.

The Center appointed Alessandra Ferreri as the sole panelist in this matter on April 4, 2013. 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 corporation which owns the VOLVO trademark throughout the world and licenses the VOLVO trademark to the companies AB Volvo and Volvo Car Corporation - each of which owns 50% of the Complainant - for use in connection with their respective business.

The Complainant's predecessor was founded in 1915, and in 1927 the construction of Volvo cars began, followed by production of trucks, buses, construction equipment, marine and industrial engines, and many other goods and services. In 1935, AB Volvo was introduced on the Stockholm Stock Exchange. The VOLVO trademark, alone and in combination with other terms and designs, is registered extensively as a trademark and service mark worldwide.

The Complainant has submitted evidence (Exhibits B, C and D of the Complaint showing Certificates of Registrations) that it is the owner of a large number of trademark registrations for VOLVO in numerous country of the world, including China, where the Respondent is located.

The disputed domain name was registered on November 22, 2012 and it resolves to a website where pornographic images are displayed with text in Chinese.

5. Parties' Contentions

A. Complainant

The Complainant contends that, by virtue of the Complainant's 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 and is associated exclusively with the Complainant.

Further, the Complainant refers to more than 25 prior UDRP cases wherein the Complainant's trademark VOLVO was found to be famous and the disputed domain names transferred from the respondents in those cases, to the Complainant.

The Complainant contends that the disputed domain name is confusingly similar to the trademark VOLVO, as it incorporates the entirety of the world famous VOLVO mark with the addition of the generic term "rss" (that is a generic term for Rich Site Summary); such minor addition is not sufficient to distinguish the disputed domain name from the famous trademark owned by the Complainant or to avoid confusion.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. 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 the Complainant. The Respondent did not have any permission or authorization or license to use VOLVO as part of a domain name or in any other way.

The Respondent is clearly not making a legitimate noncommercial or fair use of the disputed domain name "without intent for commercial gain". The disputed domain name resolves to a website where pornographic images are displayed with text in Chinese.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith. The Respondent chose the disputed domain name with full knowledge of the Complainant's rights therein, and there is no reason for the Respondent to use the VOLVO trademark in its domain name except to try to sell it to the Complainant and prevent the Complainant from registering the said domain name or for other commercial gain. Moreover the Respondent's use of the disputed domain name violates the terms of the Go Daddy Universal Terms of Service Agreement and is a blatant infringement and dilutes the strength of the Complainant's trademark rights. If the Respondent is permitted to continue to use the disputed domain name, the public will continue to be confused into believing or assuming that the Complainant has no objection to such use of its trademark in the disputed domain name. The Complainant's famous mark, which is an invaluable asset, would be irreparably damaged.

The Respondent's registration and use of the disputed domain name have been committed with the intent and purpose of creating a likelihood of confusion and exploiting the Complainant's considerable goodwill and reputation.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements:

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

A. Identical or Confusingly Similar

Having considered the Complainant's submissions and the evidences adduced with the Complaint, this Panel finds that the Complainant has established that it owns prior rights in the VOLVO trademark and that the disputed domain name is confusingly similar to the Complainant's VOLVO trademark which falls in the category of a "famous mark".

Indeed, as submitted by the Complainant and as several prior UDRP panels have held, this Panel finds that the Complainant's trademark VOLVO, has to be considered a strong, distinctive and famous mark, on the basis of its worldwide use, reputation and goodwill in connection with automobiles, other vehicles and several connected products.

The Complainant owns numerous VOLVO trademark registrations all over the world, in the European Union, in the United States and in China, where the actual registrant of the disputed domain name is located. This Panel took a look at the list of Chinese trademark registrations owned by the Complainant, and checked out that all the Chinese trademark registrations for VOLVO precede by decades the date upon which the Respondent registered the disputed domain name (*i.e.* November 22, 2012). In particular, the first Chinese trademark registration for VOLVO, No. 1147127, was registered on January 28, 1998.

In the present case, the disputed domain name incorporates the Complainant's worldwide famous and widely-registered trademark VOLVO with the addition of the generic term "rss" (the abbreviation for Rich Site Summary, a format used to publish frequently updated works - such as blog entries, news headlines, audio, and video - in a standardized format). The addition of such generic term is purely descriptive and is not enough to prevent confusing similarity between the disputed domain name and the incorporated well-known trademark but may actually increase the likelihood of confusion (see *America Online Inc., v. Yeteck Communication, Inc.*, WIPO Case No. D2001-0055; *GA Modefine SA v. Riccardo Bin Kara-Mat*, WIPO Case No. D2002-0195; *Volkswagen AG v. Emir Ulu*, WIPO Case No. D2005-0987; for the addition of a geographical indicator see *Rolls-Royce PLC v. Hallofpain*, WIPO Case No. D2000-1709, *PepsiCo, Inc. v. QWO*, WIPO Case No. D2004-0865).

See, also, *Harrods Limited v. Simon Harkin Travel*, WIPO Case No. D2004-0546 in which the panel held that:

“Although the [d]omain [n]ame consists of the word ‘harrods’ and the word ‘travel’, it is well settled that a domain name suffix, such as the word ‘travel’ in the present case, is merely descriptive and does not add any distinctiveness to the word ‘harrods’, which is the quintessential and distinctive part of the [d]omain [n]ame. See *Harrods Limited v. Vineet Singh*, WIPO Case No. D2001-1162, where the [p]anel held that ‘... any use of the name Harrods in conjunction with a description... would suggest a false sense of origin...for any associated goods or services’. See also *Harrods Limited v. Brad Shaw*, WIPO Case No. D2004-0411, where the [p]anel held that “The [d]omain [n]ame consists of the word HARRODS plus a hyphen and the generic term ‘poker’. The latter is not a distinguishing feature and does not lessen the likelihood of confusion with the trademark”.

With regards to the suffix “.info” (which indicates that the domain name is registered in the “.info” gTLD), as it was established in many previous UDRP decisions (see *A.P. Møller v. Web Society*, WIPO Case No. D2000-0135; *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. D2000-0429; *Arab Bank for Investment And Foreign Trade (ARBIFT) v. Mr. Kenn Wagenheim / 07@usa.net*, WIPO Case No. D2000-1400; *Delikomat Betriebsverpflegung Gesellschaft m.b.H. v. Alexander Lehner*, WIPO Case No. D2001-1447 and *Crédit Industriel et Commercial S.A v. Name Privacy*, WIPO Case No. D2005-0457), it does not affect the domain name for the purpose of determining whether it is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; indeed the suffix is a necessary component of the domain name and does not give any distinctiveness.

In light of the above reasoning, the Panel finds that the disputed domain name registered by the Respondent is confusingly similar to the Complainant’s worldwide known and widely-registered trademark VOLVO, in which the Complainant has demonstrated, to the satisfaction of the Panel, that it has rights for several years; therefore the Panel finds that the Complainant has satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Respondent did not reply to the Complainant’s contentions. For that reason, the Panel has taken careful note of the factual assertions that have been made and supported by evidence by the Complainant.

In particular, the Respondent has failed to offer the Panel any of the types of evidence set forth in paragraph 4(c) of the Policy from which the Panel might conclude that the Respondent has rights or legitimate interests in the disputed domain name, such as:

- (i) use or preparation 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 prior to notice of the dispute; or
- (ii) being commonly known by the disputed domain name (as an individual, business or other organization) even if the Respondent has not acquired any trademark or service mark rights; or
- (iii) making 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.

There is no evidence in the record that the Respondent has any rights or legitimate interests in the disputed domain name. The Respondent has not been and is not commonly known by the VOLVO mark or the disputed domain name, and it has not acquired any trademark or service mark rights in that name or mark. Moreover, the Respondent was not licensed or otherwise permitted to use the Complainant’s widely-known and widely-registered VOLVO trademark.

Furthermore, the use of the disputed domain name cannot be considered a *bona fide* offering of goods or services. Indeed the use of the website for the provision of pornographic material can in no way constitute a legitimate noncommercial or fair use of disputed the domain name in this case.

In light of the circumstance that VOLVO is a well-known mark, it is very unlikely that the Respondent would have been unaware of the Complainant or its mark. On the contrary, the Respondent has registered and is using the disputed domain name with the clear intention to use the Complainant's mark and name for its own profit, by misleading and diverting consumers to its own website, or for the purpose of tarnishing the Complainant's trademark. Such use does not constitute a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name. And even if there may not have been a specific intention on the Respondent's part to tarnish the Complainant's mark, the ultimate result of tarnishment of such mark would have been inevitable.

Finally, given the circumstances of this case, the Panel finds that the Respondent's lack of rights or legitimate interests in the disputed domain name may also be inferred from the fact that no response was filed by the Respondent. According to earlier UDRP decisions (see *Pomellato S.p.A. v. Richard Tonetti*, WIPO Case No. [D2000-0493](#), and *GA Modefine S.A. and Giorgio Armani S.p.A. v. Yoon-Min Yang*, WIPO Case No. [D2005-0090](#)) it may be the case that "non-response is indicative of a lack of interests inconsistent with an attitude of ownership and a belief in the lawfulness of one's own rights".

Therefore, based on the evidence, the Panel is satisfied that the second element is met.

C. Registered and Used in Bad Faith

The Panel finds that the disputed domain name was registered and is being used in bad faith.

The Complainant's VOLVO trademark and activity are very widely-known throughout the world and considering the widespread use, fame and reputation of VOLVO name and mark, also in China where the Respondent is located, in this Panel's view the Respondent must have been aware of them when it registered the disputed domain name.

The choice of the disputed domain name by the Respondent, in the Panel's view, could not result from a mere coincidence.

In line with other prior UDRP decisions (*Banca Sella S.p.A. v. Mr. Paolo Parente*, WIPO Case No. [D2000-1157](#); *Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#); *Parfums Christian Dior v Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#); *Ferrero S.p.A. v. Mario Pisano*, WIPO Case No. [D2000-1794](#); *Ferrero S.p.A. v. Publinord S.r.l.*, WIPO Case No. [D2002-0395](#)), the Panel believes that, in the absence of any rights or legitimate interests and lacking any contrary evidence by the Respondent, the registration of the disputed domain name confusingly similar to the Complainant's widely-known trademark may suggest opportunistic bad faith (see also *MasterCard International Incorporated v. North Tustin Dental Associates*, WIPO Case No. [D2007-1412](#) and *Mastercard International Incorporated v. Total Card Inc.*, WIPO Case No. [D2007-1411](#) mentioned in the Complaint).

Concerning the use of the disputed domain name, the Complainant has proven that the disputed domain name resolves to a website where Internet users find pornographic material.

This Panel agrees with several prior UDRP decisions (see e.g. *Ty, Inc. v. O.Z. Names*, WIPO Case No. [D2000-0370](#), *Oxygen Media, LLC v. Primary Source*, WIPO Case No. [D2000-0362](#), *Dell Computer Corporation v. RaveClub Berlin*, WIPO Case No. [D2002-0601](#) *Six Continents Hotels, Inc. v. Seweryn Nowak*, WIPO Case No. [D2003-0022](#),

and *Miroglio S.p.A. v. Mr. Alexander Albert W. Gore*, WIPO Case No. D2003-0557) that the redirection to pornographic sites from a domain name incorporating a well-known trademark is evidence of bad faith. As the panel stated in *Six Continents Hotels, Inc. v. Seweryn Nowak*, WIPO Case No. D2003-0022):

“Preliminary, it is commonly understood, under WIPO case law, that, whatever the motivation of Respondent, the diversion of the domain names to a pornographic site is itself certainly consistent with the finding that the domain name was registered and is being used in bad faith.”

Therefore in the Panel’s view, the Respondent’s intention has been to attract or misleadingly divert Internet users to the Respondent’s website either for commercial gain or for the purpose of tarnishing the Complainant’s trademark.

Indeed, by exploiting the renown of the VOLVO trademark, the Respondent diverts Internet users looking for the Complainant’s marks and website and seeks to gain profit out of the disputed domain name from the diverted traffic or to tarnish the Complainant’s trademark. In this Panel’s view Internet users seeking information on Volvo, accessing the disputed domain name, would have the legitimate expectation to find information relating to the Complainant and/or its automobiles and would, consequently be misled, to the possible detriment of the Complainant because of the existence of pornographic material. Even if, in this Panel’s view, most Internet users would not believe that the Complainant has endorsed or authorized such use of the disputed domain name, the Panel agrees with the Complainant’s argument that the negative image and association created, would be detrimental to the Complainant’s interests and would cause the tarnishment of the VOLVO trademark and the dilution of its strength (see *Volvo Trademark Holding AB v. Jinjin Zhang*, WIPO Case No. D2010-1930, cited by the Complainant, where the panel stated that “such infringing use of the Complainant’s trade mark and manner of use of the website cannot by any means be considered to be *bona fide*”).

In light of the above circumstances, the Panel is satisfied that the third element under paragraph 4(a) of the Policy is met and that the disputed domain name <volvorss.info> was registered and is being used in bad faith.

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 name <volvorss.info> be transferred to the Complainant.

Alessandra Ferreri
Sole Panelist
Date: April 18, 2013

EXHIBIT 72



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Volvo Trademark Holding AB v. Glenn Karlsson-Springare

Case No. D2012-0003

1. The Parties

The Complainant is Volvo Trademark Holding AB of Goteborg, Sweden, represented by Sughrue Mion, PLLC, United States of America.

The Respondent is Glenn Karlsson-Springare of Huddinge, Sweden.

2. The Domain Names and Registrars

The disputed domain names <volvoconcept.com> and <volvoenvironment.com> are registered with eNom.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 3, 2012. On January 3, 2012, the Center transmitted by email to eNom a request for registrar verification in connection with the disputed domain names. On January 3, 2012, eNom 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 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 10, 2012. In accordance with the Rules, paragraph 5(a), the due date for Response was January 30, 2012. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 31, 2012.

The Center appointed Petter Rindforth as the sole panelist in this matter on February 9, 2012. 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.

The Panel shall issue its Decision based on the Complaint, the Policy, the Rules, the Supplemental Rules, and without the benefit of any Response from the Respondent. The case before the Panel was conducted in the English language.

4. Factual Background

The Complainant is the registered owner of the VOLVO trademark throughout the world and licenses the VOLVO trademark to the companies AB Volvo and Volvo Car Corporation - each of which owns 50% of the Complainant - for use in connection with their respective business.

The Complainant's predecessor was founded in 1915, and in 1927 the construction of VOLVO cars began, followed by production of trucks, bus chassis and marine engine. In 1935, AB Volvo was introduced on the Stockholm Stock Exchange (in Sweden). The trademark VOLVO, alone and in combination with other terms and designs, is registered extensively as a trademark and service mark worldwide.

The Complainant has submitted evidence (Exhibits B, C and D of the Complaint showing Certificates of Registrations) that it is the owner of a number of trademark registrations for VOLVO as a word mark or as a figurative mark, such as

VOLVO (word), Reg. No. 636,128; registered October 23, 1956 for goods in Class 12 - issued by the United States Patent and Trademark Office ("USPTO");

VOLVO (fig), Community Trademark Registration (CTM) No. 9,045,311; registered September 27, 2010 for goods in Classes 7, 12 and 28;

VOLVO (fig), CTM No 4,804,522; registered September 18, 2008 for goods and services in Classes 1, 2, 3, 4, 6, 7, 9, 11, 12, 14, 16, 18, 25, 28, 35, 36, 37, 38, 39, 41

VOLVO (word), CTM No 2,361,087; registered June 20, 2005 for goods and services in Classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 11, 12, 14, 16, 17, 18, 20, 21, 22, 24, 25, 26, 27, 28, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42

VOLVO (word), CTM No 2,347,193; registered January 28, 2003 for services in Classes 35, 36, 39

A Community Trademark Registration automatically includes Sweden, being a member of the European Union.

The disputed domain names <volvoconcept.com> and <volvoenvironment.com> were registered on October 3, 2011. No detailed information is provided about the Respondent's activities, apart from what is mentioned below by the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant states that, by virtue of the 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 and is associated exclusively with the Complainant.

Further, the Complainant refers to more than 25 prior UDRP cases wherein the Complainant's trademark VOLVO was found to be famous and transferred from respondents in those cases, to the Complainant.

The Complainant argue that the disputed domain names are confusingly similar to the trademark VOLVO, as they consist of VOLVO with the generic addition of the word “concept” (being generally used for a car that showcases new styling and new technology, as shown in Exhibits G and H of the Complaint) in <volvoconcept.com> and the word “environment” in <volvoenvironment.com>.

The Complainant states that the Respondent has no rights or legitimate interests in the disputed domain names.

The Respondent is not making any legitimate noncommercial or fair use of <volvoconcept.com> or <volvoenvironment.com>, the Respondent is not commonly known as VOLVO, and the Complainant has not authorized the Respondent to use the VOLVO trademark.

Finally, the Complainant argues that the disputed domain names are both registered and used in bad faith.

The Complainant concludes that there is no reason for the Respondent to use the Complainant’s trademark in the disputed domain names other than to try to sell them to the Complainant and prevent the Complainant from registering said domain names.

The Respondent was obviously aware of the Complainant’s trademark rights to VOLVO at the time of registration. The Respondent is based in Sweden, where the Complainant is the largest employer.

The Respondent’s bad faith registration is further evidenced by the fact that the Respondent on October 2, 2011, sent an unsolicited email to the Complainant, informing the Complainant of the disputed domain names - as well as others hold by the Respondent - and offering to sell these to the Complainant (Exhibit K of the Complaint). The Complainant responded to the Respondent and demanded that the Respondent transfer the disputed domain names without any payment to the Respondent. After a further reminder to the Respondent, the Respondent replied on November 13, 2011, now claiming that the disputed domain names were not for sale and that they were registered as a “hobby” (Exhibit N of the Complaint). The Respondent sent the said reply days before the decision issued in *F. Porsche AG v. Glenn Stefan Karlsson-Springare*, WIPO Case No. D2011-1727.

Referring to prior UDRP cases, the Complainant concludes that the Respondent appears to have registered a number of different domain names that correspond with car manufacturers, all registered on the same day, October 3, 2011, and all for commercial gain.

The Complainant requests that the Panel issue a decision that the disputed domain names be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove each of the following:

(i) that the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and

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

(iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant is the owner of the VOLVO trademark, registered and well-known in a number of countries, including Sweden – the home country of the Respondent.

The relevant part of the disputed domain names are “volvoconcept” and “volvoenvironment”. The Panel concludes that the domain names consist of the Complainant’s trademark VOLVO, with the addition of the generic words “concept” and “environment”. As stated in many UDRP cases, the addition of a generic term does not necessarily distinguish a domain name from a trademark.

The generic word may even add to the confusing similarity (see *Scholastic Inc. v. 366 Publications*, WIPO Case No. D2000-1627, holding that “[t]he addition of the generic term ‘online’...is not a distinguishing feature. In fact, in this case it seems to increase the likelihood of confusion because it is an apt term for [the] Complainant’s online business”); see also *F. Porsche AG v. Glenn Stefan Karlsson-Springare*, WIPO Case No. D2011-1727, and *Audi AG and Volkswagen AG v. Glenn Karlsson-Springare*, WIPO Case No. D2011-2121 (“The additional word “environment” following the trademarks AUDI, VW and VOLKSWAGEN in the disputed domain names is merely generic and does not avoid a finding of confusing similarity of the disputed domain names with Complainants’ trademarks.”)

The Panel therefore concludes that <volvoconcept.com> and <volvoenvironment.com> are confusingly similar to the Complainant’s trade mark VOLVO.

B. Rights or Legitimate Interests

Once the Complainant makes a *prima facie* case in support of its allegations in respect of the second element of the Policy, the burden shifts to the Respondent to show that it does have rights or legitimate interests pursuant to paragraph 4(a)(ii) of the Policy, see *Clerical Medical Investment Group Limited v. Clericalmedical.com (Clerical & Medical Services Agency)*, WIPO Case No. D2000-1228 (finding that, under certain circumstances, the mere assertion by the complainant that the respondent has no right or legitimate interest is sufficient to shift the burden of proof to the respondent to demonstrate that such a right or legitimate interest does exist).

By not submitting a Response, the Respondent has failed to invoke any circumstance which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name, or to rebut the Complainant’s *prima facie* case under this paragraph of the Policy.

The Respondent is not an authorized agent or licensee of the Complainant’s products or services and has no other permission to apply for any domain name/s incorporating the trade mark VOLVO. See *Compagnie de Saint Gobain v. Com-Union Corp.*, WIPO Case No. D2000-0020 (finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name).

There is nothing in the Respondent’s name that indicates it may have become commonly known by the disputed domain names, enabling it to establish a legitimate interest in <volvoconcept.com> and/or <volvoenvironment.com>, nor any evidence in the present record to indicate that the Respondent is making any legitimate noncommercial or fair use of the disputed domain names. On the contrary – the Panel finds that the Respondent’s initial offer to sell the disputed domain names to the Complainant clearly indicates that both <volvoconcept.com> and/or <volvoenvironment.com> have been both registered and used only in order to sell them to the Complainant. Such use can never establish legitimate interests.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

As the Complainant has described and proved, the trademark VOLVO is well-known and the trademark registrations are covering, among other countries, Sweden – the home country of the Respondent.

The Respondent appears to have registered a number of different domain names that correspond with car manufacturers. See *F. Porsche AG v. Glenn Stefan Karlsson-Springare*, WIPO Case No. D2011-1727, and *Audi AG and Volkswagen AG v. Glenn Karlsson-Springare*, WIPO Case No. D2011-2121. This further indicates that the Respondent also registered the disputed domain names well aware of that VOLVO is a well-known trademark in the name of the Complainant.

Registration of a well-known trademark by a party with no connection to the owner of the trademark and no authorization and no apparent legitimate purpose to use the trademark is a strong indication of bad faith. See *Société pour l'Oeuvre et la Mémoire d'Antoine de Saint Exupéry - Succession Saint Exupéry - D'Agay v. Perlegos Properties*, WIPO Case No. D2005-1085.

As also shown by the Complainant, the Respondent has used <volvoconcept.com> and <volvoenvironment.com> to offer them for sale directly to the Complainant. Although no specific amount was mentioned in the initial email, the Panel concludes that the Respondent's late reply that the disputed domain names were not for sale was an attempt to force the Complainant to come back with an offer of a considerable amount to meet the Respondent's initial sales offer.

This use of the disputed domain names primarily for the purpose of selling or renting it to the Complainant for a monetary consideration in excess of the Respondent's out-of-pocket expenses directly related to the disputed domain names, are evidence of registration and use of the disputed domain names in bad faith.

The Panel concludes that the disputed domain names are both registered and used in bad faith.

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 names <volvoconcept.com> and <volvoenvironment.com> be transferred to the Complainant.

Petter Rindforth

Sole Panelist

Dated: February 20, 2012