

Caterpillar - Form Yellow Iron to Software Caterpillar

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What

Domain name dispute

Who

The Complainant, Caterpillar, is a MNC with a stellar reputation built in heavy equipment and construction.

The Respondent is a regional software house with offices in the Middle East & Canada operating a business known as Catcontrols.

The Prize

www.catcontrols.com

Why

CAT is the Complainant's house mark, which it has cultivated over decades to become a household name in heavy equipment and construction machinery. The Complainant enjoys substantial goodwill and reputation in its CAT mark.

The use of CAT in www.catcontrols.com is unauthorised and detrimental to the Complainant as its use is likely to create confusion amongst consumers that the website is dealing with CAT products and services or is somehow related to the Complainant. Such use is damaging to the Complainant's goodwill and reputation and results in brand dilution of its CAT mark.

Where

World Intellectual Property Organization ("WIPO") Arbitration and Mediation Centre under the Rules for Uniform Domain Name Dispute Resolution Policy

Facts of the Case

The Respondent had registered the disputed domain name and had been actively operating the website to provide extensive information on its software products, which were offered for sale.

The Complainant has trade mark registrations for Caterpillar & CAT in a number of countries and has been using both names as trade marks for decades.

The Complainant argued that the disputed domain name was confusingly similar to marks in which the Complainant has rights, the Respondent has no rights or legitimate interests in use of the disputed domain name and the Respondent's registration and use of the disputed domain name was in bad faith.

WIPO's Findings

1. The WIPO Panel agreed with the Complainant that the disputed domain name had incorporated its CAT trade mark in its entirety and that the addition of the word, "controls", had done nothing to remove the

confusion likely to be caused by the Respondent's use of the Complainant's CAT mark in the disputed domain name. Accordingly, the WIPO Panel found that the disputed domain name was confusingly similar to the Complainant's CAT mark.

2. It was found that the Respondent's use of the disputed domain name cannot be characterised as use in connection with the bona fide offering of goods and services. The Complainant had argued that the Respondent's prominent use of CAT and the adoption of the Complainant's well known "Caterpillar Yellow" in its corporate livery and website reinforced the impression of a false association with the Complainant and the Complainant's products. Such contrived use of CAT must necessarily lead to the inescapable conclusion that there was no bona fide offering of goods under the disputed domain name.
3. The WIPO Panel found that the disputed domain name was registered and used in bad faith.

The Complainant had vigorously argued that there was no plausible reason why the Respondent would have chosen to use CAT as part of the disputed domain name except to misappropriate the vault of goodwill and reputation, which the Complainant had painstakingly cultivated over decades of use. Quite clearly, www.catcontrols.com was not a domain name, which any user would have chosen unless they knew of the CAT trade mark and the custom, which it attracts. The Respondent had manifestly registered the domain name solely for the purpose of attracting users who would be misled into thinking that there was some association between the disputed domain name and the Complainant.

It was obvious from the matrix of use that the disputed domain name was being used in bad faith.

Accordingly, the WIPO Panel was satisfied that the Complainant had succeeded in proving its case and ordered that the disputed domain name be transferred to the Complainant.

Learnings

Caterpillar was able to leverage on its well known CAT trade mark to stop the use of Catcontrols in relation to software. Caterpillar had argued successfully that Caterpillar was more than yellow iron.

"Caterpillar is more than big heavy equipment – and much more than yellow iron. The products and applications it is best known for have evolved from simple mechanical workhorses to sophisticated, electronically controlled solutions driven by state of the art software.

Caterpillar is not just an iron company, it is a world class electronics company."

Counsel swayed the WIPO panel with arguments that Caterpillar's fame extended beyond its traditional core business of heavy equipment and into software.

This important case demonstrates Caterpillar's far reaching fame.

It is important to build brand equity in your trade mark as it will pay dividends in the years to come in arresting unauthorised use of your mark in domain names, which seek to capitalize on the goodwill and reputation subsisting in your mark.

Brand owners ought to be vigilant in monitoring any unauthorised usage of their trade marks in cyberspace and to act swiftly and decisively in rooting out the problem. Using the WIPO Arbitration and Mediation Centre as a means to do so has proven highly effective and quick in resolving domain name disputes. The fact that the Caterpillar had been vigilant in enforcing its rights against offenders in cyberspace was important in shoring up its arguments that any attempt to free ride on its substantial goodwill and reputation was damaging to its brand integrity and likely to cause brand dilution.

Fortifying one's cyber presence has never been more important as an increasing number of users log onto the internet to shop and be entertained especially in the Middle East where internet penetration has witnessed exponential growth as investments pour into the development of the online space as indicated by the proliferation of Arabic language content and Arabic domain names.

This significant case represents yet another decisive victory for the ATCO Domain Name Dispute Resolution practice, part of our award winning IP practice which continues to counsel clients in ensuring that their valuable goodwill and reputation is well protected in cyberspace.