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| <p><b>Komatsu America Corp.</b><br/>8770 W. Bryn Mawr Ave., Suite 100<br/>Chicago, Illinois 600631<br/><b>(Complainant)</b></p> <p>v.</p> <p><b>Bryjus LLC</b><br/>Florida 33647</p> <p>and</p> <p><b>Registration Private / Domains by Proxy, LLC</b><br/>2155 E Warner Rd<br/>Tempe, Arizona 85284<br/><b>(Respondent)</b></p> | <p><b>Domain Names in Dispute:</b></p> <p><b>MYKOMATSUPART.COM</b></p> <p><b>MYKOMATSUPARTS.COM</b></p> <p><b>MYKMPARTS.COM</b></p> <p><b>File Number:</b> _____</p> |
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**COMPLAINT IN ACCORDANCE WITH**  
**THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY**

[1.] This Complaint is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy (UDRP), adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 and approved by ICANN on October 24, 1999, and the Rules for Uniform Domain Name Dispute Resolution Policy (UDRP Rules), with an effective date of July 31, 2015, and the FORUM's Supplemental Rules (Supp. Rules). UDRP Rule 3(b)(i). A copy of the Uniform Domain Name Dispute Resolution Policy is attached hereto as **Exhibit A**.

[2.] **COMPLAINANT INFORMATION**

[a.] Name: Komatsu America Corp.  
[b.] Address: 8770 W. Bryn Mawr Ave.  
Chicago, Illinois 60631  
[e.] Telephone: (312) 357-1313  
[d.] Fax: (312) 759-5646  
[e.] E-Mail: [Christopher.Dolan@btlaw.com](mailto:Christopher.Dolan@btlaw.com)  
[Joshua.Frick@btlaw.com](mailto:Joshua.Frick@btlaw.com)  
[trademarks-ch@btlaw.com](mailto:trademarks-ch@btlaw.com)

Complainant Komatsu America Corp (“Complainant”), is a corporation organized under the laws of Georgia.

**[3.] COMPLAINANT’S AUTHORIZED REPRESENTATIVE**

Pursuant to UDRP Rule 3(b)(ii), set forth below is the contact information for Complainant’s authorized representative in this administrative proceeding:

- [a.] Name: Christopher Dolan
- [b.] Address: Barnes & Thornburg LLP  
One North Wacker Drive, Suite 4400,  
Chicago IL 60606
- [c.] Telephone: (312) 357-1313
- [d.] Fax: (312) 759-5646
- [e.] Email: [Christopher.Dolan@btlaw.com](mailto:Christopher.Dolan@btlaw.com)  
[Joshua.Frick@btlaw.com](mailto:Joshua.Frick@btlaw.com)  
[trademarks-ch@btlaw.com](mailto:trademarks-ch@btlaw.com)

Pursuant to UDRP Rule 3(b)(iii), set forth below is Complainant’s preferred method for communications directed to Complainant in this administrative proceeding:

**Electronic-Only Material**

- [a.] Method: Email
- [b.] Contact Name: Christopher Dolan
- [c.] Contact Email: [Christopher.Dolan@btlaw.com](mailto:Christopher.Dolan@btlaw.com)  
[Joshua.Frick@btlaw.com](mailto:Joshua.Frick@btlaw.com)  
[trademarks-ch@btlaw.com](mailto:trademarks-ch@btlaw.com)

**Material Including Hard Copy**

- [a.] Method: Fax, followed by U.S. Post
- [b.] Contact Name: Christopher Dolan
- [c.] Address: Barnes & Thornburg LLP  
One North Wacker Drive, Suite 4400,  
Chicago IL 60606
- [d.] Fax: (312) 759-5646

Pursuant to UDRP Rule 3(b)(iv), Complainant chooses to have this dispute heard before a single-member administrative panel.

**[4.] RESPONDENT INFORMATION**

|      |               | <b>mykomatsuparts.com</b> | <b>mykomatsupart.com</b> | <b>mykmparts.com</b>                     |
|------|---------------|---------------------------|--------------------------|--|
| [a.] | Name:         | Bryjus LLC                | Not available            | Registration Private                     |
| [b.] | Organization: | Not available             | Bryjus LLC               | Domains By Proxy, LLC                    |
| [c.] | Address:      | Florida, United States    | Oklahoma, United States  | 2155 E Warner Rd<br>Tempe, Arizona 85284 |
| [d.] | Telephone:    | Not available             | Not available            | +1.4806242599                            |
| [e.] | Fax:          | Not available             | Not available            | +1.4806242598                            |
| [f.] | E-Mail:       | Not available             | Not available            | mykmparts.com@domainsb<br>yproxy.com     |

WHOIS information for the domain names <mykomatsuparts.com>, <mykomatsupart.com>, and <mykmparts.com>, attached as **Exhibit B** to this complaint, was obtained at GoDaddy (<https://www.godaddy.com/whois/>), the registrar for the disputed domains.

**[5.] DISPUTED DOMAIN NAMES**

[a.] Pursuant to UDRP Rule 3(b)(vi), the following domain names (collectively the “Disputed Domains”) is the subject of this Complaint:

**MYKOMATSUPARTS.COM, MYKOMATSUPART.COM, and MYKMPARTS.COM**

Upon information and belief, the same entity registered and/or has control of all of the Disputed Domains, and thus constitutes the “same domain name holder” under Paragraph 3(c) of the Rules. The evidence demonstrating that Respondent registered and/or has control of all of the Disputed Domains includes the following:

1. The Disputed Domains are registered with the same registrar (GoDaddy) (*see Exhibit B*);
2. The Disputed Domains all resolve to the same website (*see Exhibit F*);
3. The website to which the Disputed Domains resolve is the same website to which the <komatsupart.com> domain resolves, which was the subject of a prior UDRP proceeding filed by Complainant against Respondent. *Komatsu America Corp. v. XXXXX XXXXXXXX/Bryjus LLC*, FA2104001943237 (Forum June 10, 2021) (ordering the transfer of the <komatsupart.com> domain);
4. The Disputed Domains all reference Complainant and its KOMATSU Marks; and
5. The WhoIs information for the Disputed Domains <mykomatsuparts.com> and <mykomatsupart.com> both list the same entity, Bryjus LLC, as the registrant name or registrant organization.

Therefore, the Disputed Domains are registered by the same domain holder and are properly brought in this single proceeding.

[b.] Pursuant to UDRP Rule 3(b)(vii), set forth below is the Registrar Information for the Disputed Domains:

|        |            |   |
|--------|------------|---|
| [i.]   | Name:      | GoDaddy.com, LLC  |
| [ii.]  | Address:   | <a href="http://www.godaddy.com">http://www.godaddy.com</a> |
| [iii.] | Telephone: | +1.4806242505   |
| [iv.]  | E-Mail:    | abuse@godaddy.com   |

[6.] **COMPLAINANT’S MARKS UPON WHICH THE COMPLAINT IS BASED**

Pursuant to UDRP Rule 3(b)(viii), set forth below is the Trademark Information:

- [a.] Complainant is a wholly owned subsidiary of Komatsu Limited (“KL”), an equipment manufacturer and distribution company established in 1920. (Complainant and KL are collectively referred to herein as “Komatsu”).
- [b.] Complainant, being a wholly owned subsidiary of KL, has an exclusive license to use the KOMATSU and KOMATSU-formative marks in the United States and in various other countries in connection with construction, mining, utility and related equipment and services. *Komatsu America Corp. v. XXXXX XXXXXXXX / Bryjus LLC*, FA2104001943237 (Forum June 10, 2021)(recognizing Complainant is a wholly owned subsidiary of Komatsu Limited); *Komatsu America Corp. v. Kamatsu*, Case No. D2005-0749 (WIPO, September 13, 2005) (transferring <kamatsu.com> and finding substantial evidence to prove that its parent company KL has registered trademark rights in the KOMATSU mark in the United States of America and the Complainant has by a license obtained the rights to use the KOMATSU mark in connection to goods or services in the United States of America and elsewhere).
- [c.] Komatsu has made extensive use of the KOMATSU mark in connection with its goods and services. Over the years, the KOMATSU Marks (as defined below), through Komatsu’s extensive use, have become uniquely associated with Komatsu and its products and services. In particular, Complainant uses the KOMATSU Marks extensively on the Internet, including at its <komatsu.com> website (the “KOMATSU Website”) that provides links to KL’s website located at <home.komatsu/en/>. A printout of Complainant’s KOMATSU Website, which is also available at the <komatsuamerica.com> domain, is attached hereto as **Exhibit C**, along with a prior version of the website that was active during the prior UDRP proceeding between Complainant and Respondent concerning the <komatsupart.com> domain discussed in detail below . The KOMATSU Website enables Internet users to access information regarding Komatsu’s products and services and it is critical to Komatsu’s marketing efforts.
- [d.] Komatsu also uses the KOMATSU Marks on its <mykomatsu.komatsu> website (“Complainant’s MYKOMATSU Website”), among others, through which consumers and the trade may purchase parts for Komatsu’s KOMATSU-branded products. A printout for Complainant’s MYKOMATSU Website is attached hereto as


**Exhibit D.** The <mykomatsu.komatsu> domain was first registered on December 11, 2017, and consumers were able to purchase parts for KOMATU products through the MYKOMATSU Website at least as early as September 2018.

[e.] Complainant also heavily markets its products under the KOMATSU mark on social media platforms including the following:

- Facebook (<https://www.facebook.com/KomatsuConstruction>),
- Twitter (<https://twitter.com/KomatsuConstr>),
- Instagram (<https://www.instagram.com/komatsuconstruction/>),
- YouTube ([https://www.youtube.com/KomatsuConstruction?sub\\_confirmation=1](https://www.youtube.com/KomatsuConstruction?sub_confirmation=1)).

[f.] In addition to its extensive common law rights in the KOMATSU mark, Komatsu owns an extensive worldwide portfolio of registrations for the KOMATSU and KOMATSU-formative marks, including the following registrations in the United States (collectively the “KOMATSU Marks”):

| Mark           | Reg. No. | Reg. Date     | Goods/Services  | Owner  |
|----------------|----------|---------------|---|--|
| <b>KOMATSU</b> | 2041661  | March 4, 1997 | <p>Class 7: earth-working machines and apparatus, namely, bulldozers, swamp dozers, amphibious bulldozers, tire dozers, motor scrapers, towed scrapers, rippers and rake dozers; earth-handling machines and apparatus, namely, shovel loaders, wheel loaders, tractor loaders, compactors and loader buckets; excavators, namely, back-hoes, dozer shovels, swamp-type dozershovels, swing dozershovels, powershovels, bucket excavators, mining shovels, trenchers, tunnel boring machines; construction machines and apparatus, namely, drop-hammers, tirerollers, road rollers, asphalt finishers, vibration rollers, vibroplates, pipe-laying machines, motor graders; metal working machines and apparatus, namely, mechanical presses, hydraulic presses, extrusion presses, forging presses, press brakes, bending machines, shearing machines, stretching machines, peeling machines, gun-drill machines, crankpin millers, crankshaft millers, cylinder block deburring machines; slug choppers, slug upsetters, lathes, molding machines; engraving-type laser-marking machines; mask-type laser-marking machines; complex-type laser-marking machines; controllers for lasermarking; loaders; stackers; reclaimers; belt-conveyors; electric generators; dynamos; chain saws; bush cutters; air-compressors; truck cranes, engines and transmissions for said goods, and parts therefor</p> <p>Class 9: battery chargers, protective helmets; silicon wafers, silicon semiconductors; integrated circuits; optical integrated circuits; magnetic coded cards; floppy discs and cards; computer software programs for use in</p> | Kabushiki Kaisha Komatsu Seisakusho a/k/a Komatsu Ltd. |

| Mark  | Reg. No. | Reg. Date       | Goods/Services   | Owner  |
|---|----------|-----------------|--|--|
|   |          |                 | <p>data base management capable of being stored in an integrated circuit card or disc; computer programs for the purpose of control and/or maintenance of machines and apparatus for mining, earth-working and also of land vehicles; visual-sensor devices having an electronic computer, a monitoring display keyboard, an electronic camera and structural parts therefor for utilizing an optic algorithm, gray scale treatment for identifying and inspecting products, namely, micro-complicated electronic parts and semiconductors and computer software for such visual inspection and analysis of any defects in such micro-complicated electronic parts and semiconductors; optical character reading devices by semiconductor laser; radar devices for determining and/or identifying objects under the ground</p> <p>Class 12: transportation vehicles, namely, forklift trucks, electric lift trucks, electric reach trucks, tractors, towing tractors, dump trucks, concrete-mixer trucks, snow vehicles, engines and transmissions for above said land vehicles, and structural parts therefor</p> |  |
| <b>KOMATSU</b>  | 3618005  | May 12, 2009    | <p>Class 4: Industrial oils and greases; solid industrial lubricants; fuels for motor vehicles, namely, artificial oils</p> <p>Class 25: Working clothing, namely, coats, jackets, trousers, pants, sweaters, shirts, vests and waistcoats, socks and stockings, gloves and mittens, neckties, neckerchieves, scarves, bandanas, mufflers, nightcaps, belts for clothing; headgear, namely, hats, caps</p> <p>Class 28: golf implements, namely, golf bags, golf clubs, golf ball markers, golf tees, gloves, golf balls, putting practice mats, skiing implements, namely, seal skins for covering skis, skis, ski edges, ski cases, ski bindings, scrapers for skis, ski poles</p>   | Kabushiki Kaisha Komatsu Seisakusho a/k/a Komatsu Ltd. |
| <b>KOMATSU</b>  | 4667663  | January 6, 2015 | Class 1: Coolants, anti-freezing liquids.  | Komatsu Ltd.   |
| <b>KOMATSU REMARKETING</b>  | 2448864  | May 8, 2001     | Class 35: services; namely, distributorships featuring used construction equipment.  | Komatsu America Corp.                                  |
| <b>KOMATSU CARE</b>   | 4154113  | June 5, 2012    | Class 37: Maintenance and repair of construction equipment.  | Komatsu America Corp.                                  |
|  | 4154114  | June 5, 2012    | Class 37: Maintenance and repair of construction equipment.  | Komatsu America Corp.                                  |

Copies of the United States registration certificates and information from the United States Patent and Trademark Office (“USPTO”) Trademark Status and Document

Retrieval database for the registrations listed above as well printouts from the USPTO database showing the recordation of the assignment of these registrations to Complainant are attached hereto as **Exhibit E**.

- [g.] Complainant's registrations for the Registered KOMATSU Marks are *prima facie* evidence of validity and establish Complainant's rights for purposes of the Policy. *Metro. Life Ins. Co. v. Bonds*, FA 873143 (Nat. Arb. Forum Feb. 16, 2007) (finding that a trademark registration adequately demonstrates a complainant's rights in a mark). Accordingly, a Complainant can demonstrate its rights in the mark by evidencing registration by the USPTO. *Wahl Clipper Corporation v. Domain Admin / Whois Privacy Corp.*, FA2007001903584 (Forum August 8, 2020) ("It is well established by decisions under this Policy that a trademark registered with a national authority is evidence of trademark rights").
- [h.] Moreover, Komatsu's U.S. Reg. Nos. 2041661 for KOMATSU (Logo), 3618005 for KOMATSU (Logo), and 2448864 for KOMATSU REMARKETING have achieved incontestable status, and therefore serve as conclusive evidence of Komatsu's ownership of the registered marks and Komatsu's exclusive right to use the marks in United States commerce. *See Exhibit E* (indicating the Section 15 acknowledgements for each incontestable registration).
- [i.] Complainant's rights in the KOMATSU Marks have been previously recognized in UDRP proceedings. *See Komatsu America Corp. v. Nikolay Fedorchuk*, FA1707001741469 (Forum August 27, 2017) (transferring <komatsupartsbook.com>); *Komatsu America Corp. v. Komatsu Book / Space*, FA1703001719972 (Forum April 11, 2017) (transferring <komatsubook.com>); *Komatsu America Corp. v. Kamatsu*, D2005-0749 (WIPO, September 13, 2005) (transferring <kamatsu.com>. In addition, KL's wholly owned subsidiaries in Europe have sought and obtained relief from WIPO panels under the UDRP, as reported in the following decisions: *Komatsu Europe International N.V. v. Smartlogic*, Case No. 2009-0006 (WIPO, March 25, 2009) (transferring <komatsu.nl>); *Komatsu Deutschland GmbH v. Ali Osman / ANS*, Case No. D2009-0107 (WIPO, March 20, 2009) (transferring <komatsugermany.com> and <komatsugermany.net>); *Komatsu America Corp. v. XXXXX XXXXXXXX / Bryjus LLC*, FA2104001943237 (Forum June 10, 2021) (transferring the <komatsupart.com>).

[6.] **FACTUAL AND LEGAL GROUNDS**

Pursuant to UDRP Rule 3(b)(ix), this Complaint is based on the following factual and legal grounds:

- [a.] **The Disputed Domains are confusingly similar to the Komatsu's KOMATSU Marks. UDRP Rule 3(b)(ix)(1); UDRP Policy ¶ 4(a)(i).**
- [i.] To demonstrate that a domain name is confusingly similar to a complainant's trademark pursuant to UDRP Policy ¶ 4(a)(i), the complainant need only demonstrate

that its mark is included in the disputed domain name. *Yahoo! Inc. v. James Fato d/b/a 458 Online*, FA286410 (Forum, Jul. 26, 2004); *see also Avaya Inc. v. Jomar Technologies / Jomar Technologies, Inc.*, FA 1554827 (Nat. Arb. Forum May 15, 2014) (ending the Identical and/or Confusingly Similar analysis after finding that the domain included Complainant’s identical mark).

[ii.] Here, the Disputed Domains <mykomatsuparts.com> and <mykomatsupart.com> incorporate Komatsu’s KOMATSU mark in its entirety. The only differences between the Domains and Complainant’s KOMATSU mark is the addition of the generic terms “my” and “parts”/”part” and the generic top-level domain (gTLD) “.com.” These slight differences do nothing to distinguish these Disputed Domains in any way from Complainant’s KOMATSU mark. UDRP panels have consistently held that minor additions to a complainant’s mark are insufficient to negate the confusingly similar aspects of a respondent’s domain name pursuant to Policy ¶ 4(a)(i). *See Komatsu America Corp. v. Komatsu Book / Space*, FA1703001719972 (Forum April 11, 2017) (finding the addition of “book” and “.com” to the KOMATSU mark “do not substantially diminish the similarity between the domain name and Complainant’s mark”); *Komatsu America Corp. v. XXXXX XXXXXXXX / Bryjus LLC*, FA2104001943237 (Forum June 10, 2021) (finding Respondent’s addition of “part” and “.com” to the KOMATSU mark does not distinguish the <komatsupart.com> domain).

[iii.] The Disputed Domain <mykmparts.com> is also confusingly similar to Complainant’s famous KOMATSU mark in that the “KM” portion of the domain, in context, is an unmistakable reference to Complainant’s KOMATSU mark. This is clearly evidenced by (1) Respondent’s use of the <komatsupart.com>, <mykomatsuparts.com>, and <mykomatsupart.com> domains to direct consumers to the same website that resolves at the <mykmparts.com> domain; and (2) the appearance of Respondent’s Website, which as detailed below in Section 6(b) prominently and repeatedly displays the KOMATSU mark. The addition of the generic terms “my” and “part” and the generic top-level domain (gTLD) “.com” do not serve to distinguish the Disputed Domain in any way from Complainant’s KOMATSU mark.

[iii.] Accordingly, Paragraph 4(a)(i) of the UDRP, requiring that the domain name at issue be “identical or confusingly similar to a trademark or service mark in which the complainant has rights” is satisfied for all of the Disputed Domains.

**[b.] Respondent Has No Rights or Legitimate Interests in the Disputed Domains. UDRP Rule 3(b)(ix)(2); UDRP Policy ¶ 4(a)(ii).**

[i.] Respondent has no rights or legitimate interests in the Disputed Domains because Respondent (1) is not affiliated with, licensed or otherwise authorized by Komatsu to use the KOMATSU mark or any confusingly similar mark, and (2) has not used the Disputed Domains in connection with a *bona fide* offering of goods or services.



- [ii.] Neither Respondent nor any business or individual owned or controlled by or associated with Respondent is associated or affiliated with Komatsu. Furthermore, Komatsu has not licensed or otherwise authorized the use of the KOMATSU mark or any confusingly similar KM mark in the Disputed Domains or on or in connection with the website associated with the Disputed Domains by Respondent or any related party. This demonstrates Respondent's lack of rights or legitimate interest in the Disputed Domains. *Komatsu America Corp. v. Komatsu Book / Space*, FA1703001719972 (Forum April 11, 2017) (finding respondent lacked legitimate interests where the <komatsubook.com> domain incorporates complainant's registered mark without authorization, and its sole apparent use has been for a website that makes unauthorized use of Complainant's mark and other intellectual property). In fact, a prior panel found that Respondent lacked rights or legitimate interest in the nearly identical <komatsupart.com> domain, which Respondent is using to direct consumers to Respondent's Website because Complainant "has not licensed or otherwise authorized Respondent the use of KOMATSU mark." *Komatsu America Corp. v. XXXXX XXXXXXXX / Bryjus LLC*, FA2104001943237 (Forum June 10, 2021).
- [iii.] Respondent has not used and is not using the Disputed Domains in connection with a *bona fide* offering of goods or services. The Disputed Domains all resolve to the same website ("Respondent's Website"), printouts of which are attached hereto as **Exhibit F**, that constitutes a clear attempt to (1) impersonate Complainant, (2) pass off Respondent's Website as Complainant's official KOMATSU Website or a website that is authorized or sponsored by Komatsu, and (3) pass off the goods offered for sale through Respondent's Website as authentic KOMATSU goods and/or goods authorized, approved, endorsed, or sponsored by Komatsu. This is evidenced by at least the following:
- Respondent's Website is intentionally designed to deceive Internet users as it prominently and repeatedly displays the KOMATSU mark, and utilizes a blue and yellow color scheme that is nearly identical to the blue and yellow color scheme Complainant currently uses and has used in the past on its KOMATSU Website and MYKOMATSU Website. *See Exhibits C, D, and F.*
  - Respondent offers what are described as "Certified Premium Komatsu Parts" for sale through Respondent's Website, and Respondent's Website includes a statement that the Website "offers the largest single selection of Komatsu Parts in the world with over 30 thousand high quality and cost-effective Komatsu Replacement Parts." *See Exhibit F.* However, Komatsu has never authorized or "certified" any of the parts offered for sale through Respondent's Website, and Respondent's suggestion otherwise only serves to further increase the likelihood that Internet users will believe that Respondent's Website and the goods offered for sale through the Website are genuine KOMATSU parts manufactured, certified, or authorized by Komatsu when that is not the case.
  - The Disputed Domains are nearly identical and are confusingly similar to the <komatsuparts.com> domain, which Complainant uses to direct Internet users to its

KOMATSU America Website and the <mykomatsu.komatsu> domain, which directs consumers to Complainant's MYKOMATSU Website.

- Respondent's Website includes a statement that Respondent is doing business as "MyKomatsuParts.com," which further creates the false impression that Respondent's Website is owned, operated, or authorized by Komatsu. See **Exhibit F**.

[iv.] Respondent's Website contains an inconspicuous disclaimer displayed in fine print and evasively placed at the bottom of Respondent's Website (see **Exhibit F**) is inconsequential and does nothing to prevent the likelihood of confusion caused by the unauthorized use of the KOMATSU mark and the confusingly similar KM mark in the Disputed Domains and on Respondent's Website. This ineffective "disclaimer" appears calculated to perpetuate the mistaken belief among Internet users that Komatsu in some way approves of and/or authorizes Respondent's Website and the goods offered for sale through the Website. See *Komatsu America Corp. v. XXXXX XXXXXXXX / Bryjus LLC*, FA2104001943237 (Forum June 10, 2021) (finding the use of a similar disclaimer on Respondent's Website does not prevent confusion); see also *NCS Pearson, Inc. and Regents of the University of Minnesota v. Nana Boonkoom*, FA2005001894832 (June 1, 2020) ("The existence of a disclaimer on a webpage is not sufficient to confer rights and legitimate interests in a disputed domain name"); *Coachella Music Festival, LLC v. Beaudoin, Denis / Denis Beaudoin*, FA1724063 (Forum May 9, 2017) (finding respondent's disclaimer insufficient because "[t]he disclaimer is in small print, although it can be read, and it is in a position at the bottom of each page where it may well be overlooked and in any event it comes after the services offered on each page of the site... [t]he result is that each page starts with Complainant's unique stylized trademark and ends with a less than prominent or effective disclaimer").

[v.] Respondent's unauthorized use of the KOMATSU mark and the confusingly similar KM mark in the Disputed Domains, on Respondent's Website, and on and in connection with the goods offered for sale through the Respondent's Website clearly demonstrates that Respondent is not using the Disputed Domains in connection with a *bona fide* offering of goods or services or a noncommercial fair use. *Komatsu America Corp. v. XXXXX XXXXXXXX / Bryjus LLC*, FA2104001943237 (Forum June 10, 2021) (finding respondent is not using the <komatsupart.com> domain for any *bona fide* offering of goods or services because respondent "appears to be attempting to pass off its parts as Complainants"); *Komatsu America Corp. v. Nikolay Fedorchuk*, FA1707001741469 (Forum August 27, 2017) (finding respondent lacked rights and legitimate interests in the <komatsupartsbook.com> domain name where respondent used the domain to pass itself off as complainant and sell unauthorized versions of Complainant's products); *MTD Products Inc v WAYNE WICKER / WAYNE WICKER INC TRACTOR AND EQUIPMENT SALES*, FA1707001740654 (August 15, 2017) (finding respondent lacked rights or legitimate interest in <cubcadet-parts.com> domain where the domain resolved to a webpage displaying Complainant's mark and offering goods in competition with complainant's business); *Solar Turbines Incorporated v. Dan Borah / Webcore One*, FA1404001552145 (Forum May 12,

2014) (finding respondent lacked rights in the <solarturbineparts.com> domain “in as much it includes the usage of a registered trademark owned by a third party and ends leading the public to confusion” and “[t]he presence of the SOLAR trademark in the domain name and on the website is definitely not innocent, and misleads”).

- [vi.] Furthermore, Respondent’s Website offers for sale parts purportedly intended for goods manufactured by Komatsu’s competitors, including Hitachi and Carraro, and prominently displays the KOMATSU mark on the webpages on Respondent’s Website listing those products. *See Exhibit F*. Respondent’s use of Komatsu’s KOMATSU mark and the confusingly similar KM mark in the Disputed Domains and on Respondent’s Website to attract Internet users to the Website to sell parts intended for the goods of Komatsu’s competitors is not a *bona fide* offering of goods or services or a legitimate noncommercial or fair use under the Policy. *Komatsu America Corp. v. XXXXX XXXXXXXX / Bryjus LLC*, FA2104001943237 (Forum June 10, 2021) (finding Respondent’s sale of parts for the products of Komatsu’s competitors does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use); *see also Deere & Company v. Domain Admin / Whois Privacy Corp.*, FA1902001830480 (Forum March 25, 2019) (respondent’s use of the <jd-part.com> domain in connection with a website that offers for sale parts for heavy machinery that compete with those of complainant is not a *bona fide* offering of goods or services or a legitimate noncommercial or fair use under the Policy).
- [vii.] In addition, based on a set of facts that are nearly identical to the facts in this proceeding, the Panel in the <komatsupart.com> UDRP proceeding determined that Respondent has no rights in the <komatsupart.com> domain, and thus Complainant satisfied paragraph 4(a)(ii) of the Policy. *Komatsu America Corp. v. XXXXX XXXXXXXX / Bryjus LLC*, FA2104001943237 (Forum June 10, 2021). The result should be no different here, where Respondent is using the nearly identical Disputed Domains to direct to Respondent’s Website that continues to display the KOMATSU mark without Complainant’s authorization and offers “Certified Premium Komatsu Parts” that are neither certified nor authorized by Complainant in any way.
- [c.] **Respondent Registered and is Using the Disputed Domains in Bad Faith. UDRP Rule 3(b)(ix)(3); UDRP Policy ¶ 4(a)(iii).**
- [i.] Respondent registered and is using the Disputed Domains in bad faith as evidenced by (1) the Forum’s prior decision against Respondent ordering the transfer of the <komatsupart.com> domain name to Complainant; (2) Respondent had actual notice of Komatsu’s rights to KOMATSU mark; and (3) Respondent is using Komatsu’s KOMATSU mark and the confusingly similar KM mark in the Disputed Domains and on Respondent’s Website without authorization in an attempt to attract Internet users to Respondent’s Website for its own financial gain.
- [ii.] Respondent’s bad faith use and registration of the Disputed Domains is evidenced by the fact the Complainant has already obtain a favorable decision against Respondent and Respondent’s President XXXXX XXXXXXXX ordering the transfer of the

<komatsupart.com> domain. *Komatsu America Corp. v. XXXXX XXXXXXXX / Bryjus LLC*, FA2104001943237 (Forum June 10, 2021). The facts of that proceeding are strikingly similar to the facts here as Respondent registered and was using the <komatsupart.com> domain to direct consumers to Respondent’s Website, which at the time was nearly identical in appearance to the current version of Respondent’s Website. A printout showing Respondent’s Website at the time Complainant filed its Complaint concerning the <komatsupart.com> domain is attached hereto as **Exhibit G.**, which like the current version.

[iii.] In the <komatsupart.com> proceeding, based on the Panel’s consideration of Complainant’s complaint, Respondent’s response, and Complainant’s supplemental filing, the Panel ruled in Complainant’s favor and ordered the transfer of the domain to Complainant. A copy of the Panel’s decision is attached hereto as **Exhibit H.** With regard to Respondent’s bad faith registration and use of the <komatsupart.com> domain, the Panel found that Respondent’s bad faith was evidenced by the following:

1. Respondent had actual knowledge of Komatsu’s right in the KOMATSU mark;
2. Respondent intentionally attempted to attract, for commercial gain, customers by creating a likelihood of confusion and is disrupting Complainant’s business by directing Internet users to Respondent’s website; and
3. Respondent’s use of the KOMATSU mark is damaging to Complainant by creating the erroneous perception that the parts sold through Respondent Website are affiliated with the Complainant, which is “particularly problematic in that Respondent is also selling parts made by competitors of Complainant’s.”

*Komatsu America Corp. v. XXXXX XXXXXXXX / Bryjus LLC*, FA2104001943237 (Forum June 10, 2021)

[iv.] After the Panel issued its decision ordering the transfer of the <komatsupart.com> domain to Complainant, rather than cease its use of the KOMATSU mark and allow for the orderly transfer of the domain to Complainant, Respondent attempted to thwart the Panel’s decision by filing a complaint in the United States District Court of the Middle District of Florida, which was the incorrect jurisdiction under the UDRP. Furthermore, Respondent failed to cease its use of the KOMATSU mark, continued to use and direct the <komatsupart.com> domain to Respondent’s Website, and began using all of the Disputed Domains that are the subject of this complaint to direct to Respondent’s Website.<sup>1</sup> Respondent’s failure to comply with the Panel’s order and

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<sup>1</sup> According to the WhoIs records for the Disputed Domains (*see* Exhibit B), the <mykomatsuparts.com> domain was first registered on November 27, 2019, the <mykmparts.com> domain was first registered on November 30, 2020, and the <mykomatsupart.com> domain was first registered on April 17, 2021. However, Complainant did not become aware of Respondent’s registration and use of the Disputed Domain until after the Panel issued the decision in the <komatsupart.com> proceeding,

his continued unauthorized use of the KOMATSU mark and the confusingly similar KM mark in the Disputed Domains and on Respondent's Website demonstrates Respondent's actual knowledge and blatant disregard for Komatsu's rights in and to the KOMATSU Mark. This is clear evidence of Respondent's bad faith use and registration of the Disputed Domains.

- [v.] In addition, Respondent's bad faith registration and use of the Disputed Domains and actual knowledge of Komatsu's rights in the KOMATSU Marks is demonstrated by, among other things, Respondent's prominent and extensive use of the KOMATSU mark on Respondent's Website and offering of parts purportedly intended for Komatsu's products. It is inconceivable that Respondent had no knowledge of Komatsu and its KOMATSU Marks prior to registering and using the Disputed Domains. In fact, XXXXX XXXXXXXX, Respondent's president, is a former employee of a distributor of Komatsu, and thus is well aware of Komatsu and Komatsu's rights to the KOMATSU mark. This is further evidence of Respondent's prior knowledge and bad faith registration and use of the Disputed Domains. *Komatsu America Corp. v. XXXXX XXXXXXXX / Bryjus LLC*, FA2104001943237 (Forum June 10, 2021) (finding Respondent had actual knowledge based on Respondent's use of the KOMATSU mark, Complainant's well-known presence in the market and communications between Complainant and Respondent); *Komatsu* No. D2005-0749 (WIPO, September 13, 2005) ("[t]he Panel finds the Complainant's trademark KOMATSU to be a well-known trademark in the relevant sector of manufacturing and selling of construction and mining equipment, industrial machinery and vehicles, and electronics products. Therefore, the Panel accepts the Complainant's submission that the Respondent had actual notice of the Complainant's trademark rights at the time of the registration of the domain name).
- [vi.] As the record makes clear, Respondent had actual knowledge of Komatsu and its rights in the KOMATSU mark prior to registering and using the Disputed Domains and Respondent's continued unauthorized use of the KOMATSU mark in the Disputed Domains and on Respondent's Website is clear evidence of Respondent's bad faith. *Komatsu America Corp. v. XXXXX XXXXXXXX / Bryjus LLC*, FA2104001943237 (Forum June 10, 2021) (finding bad faith because Respondent had actual knowledge of Complainant's rights in the KOMATSU mark); *see also Komatsu America Corp. v. Nikolay Fedorchuk*, FA1707001741469 (Forum August 27, 2017) (finding bad faith registration of the <komatsupartsbook.com> domain where the respondent had actual knowledge of complainant's rights); *Logitech International S.A. v. Alexander Walker*, FA1909001860966 (Nat. Arb. Forum Sept. 13, 2019) (finding bad faith where Respondent knew of Complainant and its rights); *Dollar Shave Club, Inc. v. Andrew Prince*, FA 1502001604130 (Forum March 12, 2015) (finding respondent had knowledge of Complainant's DOLLAR SHAVE CLUB mark, and thus registered the <dollarshaveclubreview.com> domain name in bad faith).

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when Respondent began to using the Domains to direct Internet users to Respondent's Website.

[vii.] Moreover, Respondent is using the Disputed Domains to attract Internet users, who may be seeking Komatsu's official websites, including Complainant's KOMATSU Website and MYKOMATSU Website, to Respondent's Website for Respondent's own financial gain. Respondent has done this, and continues to do this, knowing full well that such use is not authorized. This is further clear evidence of Respondent's bad faith registration and use of the Disputed Domains. *See Komatsu America Corp. v. XXXXX XXXXXXXX / Bryjus LLC*, FA2104001943237 (Forum June 10, 2021) (finding bad faith where Respondent intentionally attempted to attract, for commercial gain, customers by creating a likelihood of confusion to Respondent's ~~Website~~); *Wahl Clipper Corporation v. rayan cash / gewcorps.com*, FA2006001898556 (Forum June 26, 2020) (finding bad faith where the disputed domain resolved to parked page displaying sponsored hyperlinks labeled with terms related to Complainant's Wahl Products); *Wahl Clipper Corporation v. Domain Admin / Whois Privacy Corp.*, FA2007001903584 (Forum August 8, 2020) (finding bad faith where the confusingly similar disputed domain resolved to a website "exists for commercial gain, most likely by way of click-through referral fees"); *Enterprise Holdings, Inc. v. Qian Jihai*, FA2002001882533 (Forum May 7, 2020) (finding respondent's use of disputed domain to attract, for commercial gain, internet users to its website by creating a likelihood of confusion constitutes bad faith registration and use of the domain).

[v.] For all of the foregoing reasons, there is no dispute that Respondent registered and is using the Disputed Domains in bad faith to deceive consumers and to profit from the goodwill and value of Complainant's Marks.

#### [7.] **REMEDY SOUGHT**

Pursuant to UDRP Rule 3(b)(x), Complainant requests that the Panel issue a decision that the <mykomatsuparts>, <mykomatsupart.com>, and <mykmparts.com> domain name registrations be transferred from Respondent to Complainant.

#### [8.] **OTHER LEGAL PROCEEDINGS**

No other legal proceedings have been commenced or terminated in connection with or relating to the Disputed Domains. UDRP Rule 3(b)(xi).

#### [9.] **MUTUAL JURISDICTION**

The Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the Disputed Domain, to jurisdiction in the location of the principal office of the registrar of the Disputed Domain. UDRP Rule 3(b)(xiii).

#### [10.] **CERTIFICATION**

Complainant agrees that its claims and remedies concerning the registration of the Disputed Domain, the dispute, or the dispute's resolution shall be solely against the Respondent and

waives all such claims and remedies against (a) the FORUM and panelists, except in the case of deliberate wrongdoing, (b) the registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.

Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully Submitted on this 13<sup>th</sup> day of October 2021.

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