Decision for dispute CAC-UDRP-100391

Case number	CAC-UDRP-100391
Time of filing	2012-04-16 00:00:00
Domain names	SBKGEAR.COM

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	Infront Motor Sports Licence S.r.l.

Complainant representative

Organization	desimone & partners

Respondent

Organization	MORGANHEIMER.com

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant states and provides evidence in support thereof, that it is the owner of numerous trademark registrations that contain the word SBK in the European Union and further countries, including the United States.

FACTUAL BACKGROUND

The Complainant, after having merged with the Italian Flammini Group (FGSports) in 2008, is organizing and hosting the “World Superbike Championship”, an event professionally organized by Flammini (and later Complainant) since the early 90th. The series is commonly known under the acronym “SBK”.

The Complainant is the owner of a number of registered trade marks containing the acronym “SBK” in, inter alia, classes 25 (for, e.g., clothing) and 41 (for, e.g., sports events) in several countries. Inter alia, Complainant registered international trademark “SBK” (word mark, No. 1006900) based on Community Trademark No. 5758404 in USA, Japan, and Australia, for goods and services, inter alia, in classes 25 and 41.

The Complainant is the registrant of some domain names containing the shortcut “SBK”, such as worldsbk.com or sbk.tv.

Complainant's trademarks at least partly predate Respondent's registration of the disputed domain name SBKGEAR.com that was made on November 9, 2009.

The Complainant sent a warning letter to the Respondent which was received by the Respondent who replied by its registered administrative and technical contact, stating that Respondent had been working on a web page for a School called Saint Brigid of Kildare School and for this reason they registered and used SBK as acronym for Saint Brigid Kildare. Respondent rejected the offer to transfer the domain name and to refund Respondent's expenses by payment of US-$ 2.000. Respondent finally offered the domain name SBKGEAR.com for sale and requested a purchase price of US-$ 20.000.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Complainant contends that:

World Superbike Championships, abbreviated "SBK" is a successful motorsports series of Complainant, the success of which was supported by an active trademark management worldwide.
Respondent is a brand promotion US consultant that describes itself as global import sourcing.

The domain name SBKGEAR.com is active and redirects to a parking page website with general links. Respondent has been diverting web users interested in the superbike events from Complainant's site to Respondent's web parking site being paid by internet companies such as Google.
There has never been any licensing of the trademark or domain name SBKGEAR.com to Respondent.
Saint Brigid of Kildare School never used the acronym SBK. Respondent did not work for Saint Brigid of Kildare School, which used different trademarks and websites, and, particularly, did not use "SBK". A domain name of a school would not be connected to a parking site, not would such site be registered in the name of an external consultant.

The contested domain name is almost identical to the trademarks of the Complainant. "SBK" is the most distinctive element in the domain name SKKGEAR.com and "SBK" is almost identical and certainly confusingly similar to the Complainant's word marks "SBK".GEAR as stated also by the Respondent in one of its e-mails is a descriptive term for clothing.

The suffix ".com" shall be disregarded by assessing the danger of confusion, as it is descriptive.
The risk of confusion is also increased by the fact that the Complainant's trademarks are also registered and used in relation to clothing in class 25. Amongst the most appreciated SBK items there are the T shirts with the description "SBK OFFICIAL GEAR".
The Respondent has no right or any legitimate interests in respect of the domain name SBKGEAR.com.
Paragraph 4(c) of the Policy shifts the burden of proof to the Respondent to provide evidence of a right or legitimate interest in the Domain Name, once the Complainant has made a prima facie indicating the absence of such rights or interests. The Respondent has only used SBKGEAR.com for a domain name parking website. This shifts the burden to the Respondent to demonstrate rights or legitimate interests in the domain names.
The Respondent is using the disputed domain names for pay-per-click parking pages, attracting as many Internet users as possible to its websites. This is a definite diversion of potential Complainant's consumers and cannot be considered a bona fide offering of goods and services.
Furthermore, the Respondent has no own trademarks with the element "SBK" and is a provider that is known under a different trade name and has no authorization or licence to use the trademark and acronym SBK.

Respondent registered and used the domain name in bad faith.

As to bad faith registration, when registering the disputed domain names, the Respondent was necessarily aware of the Complainant's well-known business and widespread reputation in its SBK trademarks And this is proved by the fact that the disputed domain name is used as a web parking site. Clearly, such manoeuvre would not have been generated if the Respondent did not know the Complainant's activities. Furthermore lack of reply to a soft warning letter may also be a proof of bad faith. Further, the Respondent's reply to Complainant's letter confirms its bad faith. Respondent argument to work for "Saint Brigid of Kildar School" is simply an unfounded justification.
The Respondent's final request of US-$20.000 for the contested domain name is further evidence of its bad faith. Thus, it is clear that the disputed domain name has been registered in order to prevent the Complainant from reflecting its mark in the corresponding domain name and that such pattern results form wilful acting of the Respondent.

Respondent has intentionally used Complainant's trade marks within the disputed domain name to attract Internet users to websites and other on-line locations for commercial gain by confusing consumers as to sponsorship of the website. This constitutes bad faith within the meaning of paragraph 4(b)(iv) of the Policy. The domain name is so obviously connected with the Complainant's trademark and its services that its use by someone with no connection to the Complainant suggests "opportunistic bad faith".

RESPONDENT:

Respondent did not file a Response to the Complaint.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

Firstly, the Panel agrees with the Complainant's contention that adding the top level domain ".com" does not help to avoid danger of confusion between the Complainant's trademark "SBK" and the disputed domain name, as they are commonly identified as mere suffixes, indicating the respective registry.

Secondly, the Panel agrees with the Complainant's argument that "gear" in "SBKGEAR.com" is commonly understood as a descriptive term with the meaning – inter alia – clothes and, therefore, that the only distinctive term in the disputed domain name is "SBK".

Thus, comparing the disputed domain name and the trademark "SBK", this Panel finds that the first requirement of paragraph 4(a) of the Policy is satisfied, particularly, as Complainant's trademark "SBK" is registered and used for clothing in class 25, inter alia.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

Complainant must show that Respondent has no rights or legitimate interests in respect of the disputed domain name. Respondent in a UDRP proceeding does not assume the burden of proof, but may establish a right or legitimate interest in a disputed domain name by demonstrating respective proof in accordance with paragraph 4(c) of the Policy.
As Respondent failed to file a Response and as Complainant states that Respondent does no have any such rights or interests, but merely uses the disputed domain name for domain parking purposes, the Panel is not aware of any rights and interests of the Respondent within the meaning of paragraph 4(a) of the Policy.
Even, if the Panel takes into account the facts provided by Complainant, it cannot be assumed that the Respondent indeed worked on a website for "Saint Brigid of Kildare School", as it is not even proven that this school used the abbreviation "SBK", or that the Respondent worked for this school on a contractual basis. This view is supported by the fact that Respondent finally offered to sell the disputed domain name for US-$ 20.000.

Therefore, the Panel finds that Complainant has satisfied the burden of proof with respect to paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

For the purpose of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

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

Accordingly, for a Complainant to succeed, the Panel must be satisfied that the domain name has been registered and is being used in bad faith.

The Respondent is using the disputed domain name for domain parking services. Further, the Respondent offered the disputed domain name for sale for the significant amount of US-$ 20.000, although Respondent had earlier argued that it was preparing a website for Saint Brigid Kilder School, which, as Respondent further maintained, was using the initials "SBK". Additionally, Complainant has brought forward that its bike series "SBK" is a famous series and has been organised and hosted by Complainant for many years. Therefore, it can be assumed that Respondent knew about the trademark of Complainant and, particularly its use for clothing ("gear").
These are indications that the holder (Respondent) has registered the domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the Complainant who is the owner of the trademark for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name. It is obvious that US-$ 20.000 likely exceed the Respondent's costs to register and maintain the disputed domain name. Even if it is argued that the costs to build a website under a certain domain name may exceed the costs for registering and maintaining a domain name, it is not understandable that the Respondent required a payment of such a high amount, as the content of the website could have been presented under another domain name, easily.
It is further doubtful that a school would have agreed to its domain name being used for domain parking services prior to the launch of its own website.
Taking all this into account, the Panel concludes that Respondent registered and is using the Domain Name in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy are satisfied.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

A. Procedurals Aspects
I. No Response
Respondent wrote an email to the CAC after its deadline to file a response, had expired. Respondent had enough time to file a proper response, timely, and did not provide any sufficient argument for its delay. The panel therefore decides to disregard

the content of Respondent's late email to the CAC.

II. Consequences of the Missing Response
According to § 5 e) of the Rules and as common in case law (ADR UDRP 100095 "LEROS-BOATYARD.COM", WIPO Case No. D2001-1488, WIPO Case No. D2000-0508) the Panel decides the dispute based upon the complaint, as the Respondent did not file a complete and valid response.

PRINCIPAL REASONS FOR THE DECISION

Complainant, a company hosting the motor sports event "SBK", a motor bike series, has established that it has prior rights in the trademark SBK. The Respondent registered the disputed domain name "SBKGEAR.com".

Respondent did not file a response to the Complaint.

Comparing the disputed domain name and the trademark "SBK", the Panel decided that the trademark SBK and the disputed domain name "SBKGEAR.com" are confusingly similar, as "gear" and ".com" can be disregarded in the comparison, because these elements are descriptive, only.
Respondent has not shown that it has any rights or interests in the disputed domain name.
The Respondent is using the disputed domain name for domain parking services. Further, the Respondent offered the disputed domain name for sale for the significant amount of US-$ 20.000, although Respondent had earlier argued that it was preparing a website for Saint Brigid Kilder School, which, as Respondent further maintained, was using the initials "SBK". Additionally, Complainant has brought forward that its bike series "SBK" is a famous series and has been organised and hosted by Complainant for many years. Therefore, it can be assumed that Respondent knew about the trademark of Complainant and, particularly its use for clothing ("gear").
Based on these indications the Panel held that Respondent has registered the domain name and is using it primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the Complainant who is the owner of the trademark for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name. It is obvious that US-$ 20.000 likely exceed the Respondent's costs to register and maintain the disputed domain name. Even if it is argued that the costs to build a website under a certain domain name may exceed the costs for registering and maintaining a domain name, it is not understandable that the Respondent required a payment of such a high amount, as the content of the website could have been presented under another domain name, easily.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **SBKGEAR.COM**: Transferred

PANELLISTS

Name	**Dominik Eickemeier**

DATE OF PANEL DECISION 2012-05-29

Publish the Decision