Decision for dispute CAC-UDRP-100383

Case number	CAC-UDRP-100383
Time of filing	2014-01-21 11:06:21
Domain names	SBKFACTORY.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	DORNA WSBK ORGANIZATION S.R.L.

Complainant representative

Organization	desimone & partners

Respondent

Organization	DOMAINS BY PROXY, LLC

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any such legal proceedings.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several registered trademarks in the United States and internationally evidence of which has been annexed to the Complaint and is accepted by the Panel. The trademarks are for SBK or other words and expressions including SBK ("the SBK trademarks").

FACTUAL BACKGROUND

According to the Complainant, it is the owner of the World Superbike Championship, known as SBK ("SBK") which has evolved exponentially since its inception in 1988 when it emerged as a production-based motorcycle-racing program. The Complainant and its predecessors have been operating SBK for several decades.

The Complainant is the owner of several SBK trademarks in the United States and internationally that are used in the conduct of the SBK enterprise, identified above as the SBK trademarks. SBK events are well known under that name and are widely broadcast all over the world.

According to the Complainant, the Respondent is the Registrant of hundreds of domain names many of which are identical to famous trade marks such as MICHELINEGUIDES.COM and LEGO-GAMES.NET.

The Complainant contends that the disputed domain name is confusingly similar to the SBK trademarks as it is almost identical to the trademarks and incorporates SBK which is the most distinctive element of the trademarks. As part of its submission, the Complainant contends that the Respondent is trying to lead consumers to think that the disputed domain name is an authorised domain name of the SBK trademark owners and that it will lead to an authorised website dealing with the famous motorcycle racing Worldwide events conducted under the SBK name.

For those reasons the Complainant submits that having regard to their distinctive elements, it is self evident that the domain name is confusingly similar and almost identical to the SBK trademarks.

The Complainant then submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. In support of this contention, the Complainant argues that the Respondent has used the contested domain name to offer and commercialise motorcycle parts and fittings and has used it as a trademark to identify goods that come within class 12 , one of the classes of goods covered by the Complainant's SBK trademarks.

The Complainant further submits in this regard that the disputed domain name is targeted at motorcycle enthusiasts so that the Respondent may offer for sale its products which are in competition to those of the Complainant by virtue of the fact that they are naturally linked to the famous SBK racing events.This is shown by the fact that when Internet users connect to the disputed domain name they are directed to sites showing quasi identical signs for identical or similar goods. This is a definite diversion of potential customers of the Complainant and cannot be considered a bona fide offering of goods and services.

The Complainant therefore submits that this method of operation, which incorporates a third party’s trademark in connection with an Internet web site that merely lists links to third party web sites is not a bona fide offering of services and is not a legitimate non-commercial or fair use of the disputed domain name. Moreover, there is no evidence that the Respondent is commonly known by the disputed domain name. Also, the Respondent has not been licensed or otherwise authorized to use any of the Complainant’s trademarks or to apply for or use any domain name incorporating such trademarks.

The Complainant also submits that the disputed domain name has been registered and is being used in bad faith. In support of this contention, the Complainant argues that the Respondent was necessarily aware of the Complainant’s well-known business and widespread reputation in its SBK trademarks when it registered the disputed domain name. Moreover, the Respondent did not reply to a cease and desist letter sent by the Complainant. The domain name is also so obviously connected with the Complainant’s trademark and its services that its very use by someone with no connection with the Complainant suggests opportunistic bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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).

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).

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).

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.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that the disputed domain name is confusingly similar to Complainant's trademark. That is so because, first, the Complainant has adduced evidence which the Panel accepts showing a series of trademarks for SBK or trademarks including the expression SBK. For example the Complainant is the owner of the servicemark SBK, registered on July 29, 2008 with the United States Patent and Trademark Office and which together with the Complainant's other trademarks is referred to above as the SBK trademarks.

Secondly, the disputed domain name was registered on July 16, 2012 and contains the whole of the Complainant's SBK trademark with the addition only of the generic word "factory." It has been held many times that the addition of generic word such as "factory" in a domain name cannot negate a finding of confusing similarity which is otherwise present as it is in the present case.

The Panel next finds on the balance of probabilities that the Complainant has made a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. That is so because the Complainant has not licensed or otherwise permitted Respondent to use its SBK trademarks or to register domain names incorporating them. The Panel also finds on the evidence that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark of Complainant. On the evidence, the Respondent is also not commonly known by the disputed domain name nor has it acquired trademark rights. The Respondent has also failed to file a response and is accordingly unable to rebut the prima facie case against it. Thus the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds thirdly that the disputed domain name has been registered and is being used in bad faith by the Respondent. That is so because the Respondent clearly intended to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's SBK trademark as to the association of its website or of the products on it. Respondent has also not responded to the allegation of the Complainant that the website of the Respondent is used to defraud consumers by promoting the same kind of products as those that are promoted by the Complainant on its website. Moreover, the whole of the evidence shows that the Respondent was acting in bad faith when registering and using the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SBKFACTORY.COM**: Transferred

PANELLISTS

Name	**The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2014-02-27

Publish the Decision