Decision for dispute CAC-UDRP-100381

Case number	CAC-UDRP-100381
Time of filing	2014-06-12 11:05:49
Domain names	SBKTHEGAME.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	DORNA WSBK ORGANIZATION S.R.L.

Complainant representative

Organization	desimone & partners

Respondent

Organization	PRIVATE REGISTRATION

OTHER LEGAL PROCEEDINGS

No other proceedings have been notified to the Panel.

IDENTIFICATION OF RIGHTS

Numerous trademarks under several Nice Classification categories are registered in favour of the Complainant in a range of jurisdictions. The Complainant has furthermore offered extensive proof of reputation and of being the holder of several domain name registrations. The rights thereby identified relate to the brand "SBK" in several variants and include in particular rights related to electronic games which have been marketed on the basis of the notoriety the SBK brand has won in the sporting world.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant contends that the disputed domain name was registered on 23 April 2014.

It states that DORNA WSBK Organization S.r.l. acts as owner today of the interests in the World Superbike (SBK) motorbike racing brand, following acquisition of the brand in March 2013 by the Spanish group DORNA, which was already owner of the MOTOGP Championship.

The Complainant gave details of the SBK championship's commercial success and of trademarks registered in different parts of the world, in particular its ownership of several registrations and applications in classes 41 for motor sport events and for all the services comprised in this class but also in class 12 for motorbikes and vehicles in general their accessories, parts and fittings and in class 9 for electronic games. The Complainant submitted a copy of the certificates for registrations of SBK trademarks obtained in the United States and at the European level, as international registrations extended to the US and other jurisdictions. These registrations are now in the name of the Complainant even though they were obtained by the former proprietors. The Complainant also claims to be the proprietor of a list of several domain names (e.g.sbk.tv, wsbk.eu, sbkworld.com etc.).

The Complaint presents further information on the connection between the original founding of the SBK motor events for production motorcycles and the extraordinary growth of and coverage given to the championships, with support from manufacturers and fans.

Furthermore the Complainant claims that SBK has been developed into a very successful electronic game; SBK games have been on the market for almost a decade.

The Complainant contends that the Registrant is hidden behind a proxy privacy service and seems to trade in domain names and web parking. The web site related to the disputed domain name is a web parking site with links to different websites on motor event themes such as "Play motor racing Games"; "Where I can download Games"; "The Game on line; Dirt Car Racing Games"; "Car and Bike Games". According to the Complainant the Respondent has no registered trademark rights in SBK and there is no evidence that the Respondent is commonly known by the disputed domain name.
The Complainant states that on 28 May 2014 it sent a warning letter by e-mail to the Respondent which must have been received by the Respondent on the same day. According to the Complainant the Respondent has never replied.

The Complainant alleges that the disputed domain name is almost identical to the trademarks in which the Complainant has rights.

The Complainant claims that the Respondent has no right or legitimate interests in respect of the contested domain name.

Furthermore the Complainant contends that the Respondent is trying to induce consumers to think that SBKTHEGAME is an authorized site linked to the SBK events and games provided by the Complainant and protected by trademark. According to the Complainant the Respondent's web site has been used the contested domain name to provide pay per click links to web sites concerning motor racing games. It claims the Respondent is thus using the disputed domain name to attract especially motorcycle enthusiasts and motor electronic game players to divert the Complainant's potential consumers elsewhere both without authorization and in a manner that cannot be considered bona fide.

The Complainant claims that the disputed domain name has been registered and is being used by the Respondent in bad faith. As to bad faith registration, the Complainant asserts that when registering the disputed domain name, 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 tool to reach consumers interested in motorcycles and electronic games on motor races and thus to take unauthorized advantage of the reputed trademark SBK especially amongst the youth. Clearly, such a stratagem would not have been employed if the Respondent did not know the Complainant's activities. The Respondent did not reply to the Complainant's warning letter and this attitude is invoked as in itself showing bad faith. According to the Complainant the domain name is so obviously connected with the Complainant's trademark and its services that their 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.

At the time of filing of the Complaint the owner of the record of the disputed domain name was PRIVATE REGISTRATION. Once notified of the Complaint, the Registrar disclosed the real owner of the disputed domain name - Mr. Oleg Mandrik. However, the Complainant preferred not to amend the Complaint with reference to the arguments of CAC decision No. 100221.

PRINCIPAL REASONS FOR THE DECISION

The Complainant has adduced a compelling body of evidence proving its rights in relation to the SBK brand, in the form of trademarks under distinct classes in the Nice Classification, domain names and the notoriety the brand has won. The disputed domain name is confusingly similar to the Complainant’s registered trademarks since it incorporates the Complainant’s "SBK" mark, merely (i) adding generic term THE GAME, and (ii) adding the generic top level domain identifier “.com” at the end. Adding such a generic term as THE GAME does not distinguish the disputed domain name from the Complainant’s trademarks.

The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, or is making a legitimate non-commercial or fair use of the disputed domain names, or is commonly known under the disputed domain names. This prima facie evidence was not challenged by the Respondent.

The Respondent's identity was concealed by the nugatory registration of "PRIVATE REGISTRATION" as its name; the contact details shed no light on the Respondent's identity either, until revealed by the Registrar in the course of the present proceedings. The evidence adduced by the Complainant of the Respondent's website and not challenged by the Respondent then clearly indicates that the purpose of the site is to deviate web traffic to other sites connected with similar activities to those of the Complainant, thereby exploiting the Complainant's brand notoriety to the Complainant's disadvantage. Bad faith, because it connotes wrongful intent, cannot be merely assumed mechanically. But the combination of surreptitious registration with clear evidence of an intention to deviate web traffic through use of the SBK brand is sufficient to draw the inference that bad faith exists in the present case. All of the elements required under the Policy are thus fulfilled to justify the Complaint and to find for the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SBKTHEGAME.COM**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2014-07-25

Publish the Decision