Decision for dispute CAC-UDRP-100910

Case number	CAC-UDRP-100910
Time of filing	2015-01-19 11:27:51
Domain names	IAMSBK.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	DORNA WSBK ORGANIZATION S.R.L.

Complainant representative

Organization	desimone & partners

Respondent

Name	ERIC WHITE

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered holder of, inter alia, the following trademarks:

(i) SBK (word), Community trademark (CTM), application date 27 September 2005, registration date 30 April 2010, application no. 4615936, registered for goods in the international class 4;

(ii) SBK (word), Community trademark (CTM), application date 27 September 2005, registration date 10 July 2007, application no. 5758404, registered for goods and services in the international classes 9, 14, 16, 18, 25, 28, 32, 33, 35, 36, 37, 38, 39, 40, 41, 42, and 43; and

(iii) SBK (word), Community trademark (CTM), application date 10 March 2005, registration date 10 March 2011, application and registration no. 9799453, registered for goods and services in classes 6, 12, and 34.

Moreover, the Complainant holds various domain names incorporating the “SBK” denomination under various top level domain and operates various websites under such domain names

FACTUAL BACKGROUND

FACTS ASSERTED BY COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT

The “SBK” is an acronym for “superbike” and is associated with “World Superbike Championship”

In the 22 years of its history, the World Superbike Championship has had a major impact on the development and engineering of modern sport motorcycles and become generally recognised all around the world by professionals as well as motor racing fans.

In March of 2013 the Spanish Group DORNA took over the SBK motor racing (including organisation of the World Superbike Championship) by establishing a new entity, the DORNA WSBK Organization S.r.l. which acts as a Complainant in this dispute.

The Complainant is a holder of various registered national, international (WIPO) as well as community trademarks (CTMs) that consist of the denomination SBK, the most relevant ones being described in more detail above.

The disputed domain name was registered on 25 April 2012.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

(I) COMPLAINANT:

The Complainant claims that the disputed domain name is confusingly similar to its trademarks (as listed above), since it incorporates SBK denomination which forms the dominant parts of the said trademarks. The Complainant namely asserts that inclusion of the non-distinctive part “IAM” into the disputed domain name (before the distinct element “SBK”) cannot prevent confusing similarity between the disputed domain name and the said trademarks.

On the contrary, this may lead to false impression that the disputed domain name and the website operated under it is the genuine and official website associated with SBK, World Superbike Championships.

The Complainant therefore contends that the disputed domain name alone as well as any website which may be under it creates an overall impression that they are connected to the Complainant’s trademarks and its business.

The Complainant also presents facts and evidence to show that the disputed domain name has been registered and used in bad faith and that the Respondent has no rights or legitimate interest to the disputed domain name, in particular because it used the disputed name for proposes of attracting public to its website, which was not in any way affiliated with the Complainant and its business and that it failed to respond to various requests and correspondence addressed to it in relation to the disputed domain name.

In this respect, the Complainant has presented to the Panel the following evidence, which has been assessed by the Panel:

- List of Complainant’s registered trademarks “SBK” and registration certificates thereof;

- List of Complainant’s domain names incorporating the “SBK” denomination;

- Printout of the screenshots of the website www.iamsbk.com from December 2014;

- Various evidence of reputation of SBK trademarks;

- Copy of Complainant's warning letter to Respondent, dated 16 December 2014.

(II) RESPONDENT:

The Respondent has not provided any response to the complaint.

RIGHTS

The Panel concluded that the disputed domain name is confusingly similar to trademarks in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Uniform Dispute Resolution Policy (“UDRP” or “Policy”).

For details, see "Principal Reasons for the Decision".

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).

For details, see "Principal Reasons for the Decision".

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 details, see "Principal Reasons for the Decision".

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

(I) CONFUSING SIMILARITY WITH COMPLAINANT'S RIGHTS

Since the domain name and the Complainant’s trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain name consisting of a term “SBK” accompanied by a prefix “IAM” is confusingly similar to the Complainant’s trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name. An addition of common or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual or aural comparison of the trademark with the domain name.

Applying the principles described above, the Panel contends that incorporation of the dominant “SBK” element of Complainant’s trademarks (which standalone enjoys high level of distinctiveness) into the disputed domain name constitute confusing similarity between Complainant’s trademark and such domain name. Addition of non-distinctive element - prefix “IAM” - to the “SBK” denomination cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant’s trademarks and thus the likelihood of confusion still exists.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the confusing similarity test as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is confusing similarity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the UDRP.

(II) BAD FAITH

Since there is only a remote chance that the Respondent has registered such complex domain name just by a chance and without having a knowledge about the existence of the Complainant's rights and business, the Panel contends, on the balance of probabilities, that the above discussed similarity has been established by the Respondent on purpose and in a bad faith.
In addition, the Complainant has proven that the Respondent has used (at least for some time) the dispute domain name for promotion, sale and offer of merchandise and other goods for which the Complainant's trademarks are registered, likely with intention to free-ride on reputation and goodwill of such trademarks and Complainant's business.

Thus, the Panel has taken a view that the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

(III) NO RIGHTS OR LEGITIMATE INTEREST

The Complainant's assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie illustration of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent.

The evidentiary burden therefore shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

For all the reasons as set out above, the complaint is accepted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **IAMSBK.COM**: Transferred

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2015-03-06

Publish the Decision