Decision for dispute CAC-UDRP-101056

Case number	CAC-UDRP-101056
Time of filing	2015-09-10 10:38:22
Domain names	SBKKK.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	DORNA WSBK ORGANIZATION S.R.L.

Complainant representative

Organization	desimone & partners

Respondent

Organization	WAMHGJHJK

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceeding pending or decided between the same parties and relating to the disputed domain name

IDENTIFICATION OF RIGHTS

The Complainant has shown rights in the SBK trademark in the most of the countries of the world established prior to registration of the domain name in dispute, e.g. the Complainant is the owner of the CTM No. 009799354 registered on August 22, 2011 etc.

FACTUAL BACKGROUND

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

"SBK" is an acronym for "superbike" and is associated with "World Superbike Championship". World Superbike Championship has evolved exponentially since its inception in 1988. During the 27 years since its inception, the World Superbike Championship has had a major impact on the development and engineering of modern sport motorcycles. In addition, by the end of the 90s, every main superbike manufacturer, such as Honda, Kawasaki, Yamaha, Suzuki, Ducati, Benelli, and Aprilia, was deeply involved with SBK. In March 2013 the Group DORNA took over the SBK motor racing. The new owner is now called DORNA WSBK Organization S.r.l. which is the Complainant in the present proceedings.

The Complainant owns many registered national, international and community trademarks consisting of or including SBK.

The Respondent seems to be a company which trades in domain names and makes profit on web parking. The web site related to the domain name in dispute is a web parking site with links to different websites; some of these websites are related to motorcycles.

The disputed domain name was registered on June 11, 2015. On July 30, 2015, the Complainant sent a warning letter via e-mail but the address of the Respondent was in permanent error. The Complainant sent a new warning letter on September 8, 2015, but again the Respondent's address could not be reached.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANTS' CONTENTIONS:

As far as the Complainant contentions are concerned, the Complainant claims the disputed domain name to be confusingly similar to its trademarks. Furthermore, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. Finally, the Complainant states that the disputed domain name has been registered and used in bad faith.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the Domain Name, the Complainant must prove that each of the following elements is present:

(i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name has been registered and is being used in bad faith.

A) The disputed domain name includes five letters, the first three coinciding with the Complainant’s trademark "SBK" and the last two consisting of the letters -kk. According to the Panel's view, especially under a visual comparison, it cannot be said that the disputed domain name is identical to Complainant’s "SBK" trademark. In the case at hand, the issue to be analysed is whether the disputed domain name can be considered as confusingly similar with Complainant’s "SBK" trademark. In

assessing this issue, the Panel is of the view that the fame and reputation of the "SBK" mark constitute an important and relevant factor; in particular, it should be noted that Complainant's "SBK" mark is well known across the world in relation to motor racing sector which has numerous followers and therefore, due to its high degree of “recognisability”, the addition of the suffix “kk” in the domain name <sbkkk.com>, which corresponds to the mere treble repetition of the last letter included in the Complainant's mark, does not prevent a finding of confusingly similarity between the disputed domain name and the Complainant's trademark in the eyes of internet consumers. Therefore, the Panel considers that, in the present case, the additional letters do not serve to remove the confusing similarity with the Complainant’s mark. This approach is consistent with previous decisions (see for istance The Royal Bank of Scotland Group Plc v. Li Qiang, WIPO Case no. D2013-2180). Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B) The Complainant has long standing rights in the mark "SBK". The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and as the Respondent was never authorized or licensed or otherwise permitted by the Complainant to use the disputed domain name. The Respondent, in the absence of any response, has not shown any facts or elements to justify legitimate rights or interests in the disputed domain name. Therefore, on the basis of the evidences submitted and in the absence of a response the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C) The Panel is of the opinion that the disputed domain name has been registered in bad faith because the Respondent was or must have been perfectly aware of the existence of "SBK" trademark, which is distinctive and unique for the registered services, when it registered the domain name <sbkkk.com>. Furthermore the Respondent is using the disputed domain name for a parking site that diverts Internet users to websites of third parties. The above represents an action taken by the Respondent to intentionally attract, for commercial gain, Internet users by creating a likelihood of confusion with Complainant’s "SBK" mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website. Previous Panels have held that using the domain name as a parking page with links to third party websites may be evidence of bad faith when the registrant is using the domain name in this manner because of the similarity with the Complainant’s trademark in the hope and expectation that the similarity will lead to confusion on the part of Internet users and results in an increased number of Internet users being drawn to that domain name parking page (MpireCorporation v. Michael Frey, WIPO Case No. D2009-0258; Paris Hilton v. Deepak Kumar, WIPO Case No. D2010-1364 and La Fee v. Pavol Icik, WIPO Case No. D2013-0526). Therefore in the Panel's view the Respondent’s use of the domain name in dispute, which incorporates the Complainant's trademark, in connection with an Internet web page 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 domain name at issue. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SBKKK.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2015-10-21

Publish the Decision