Decision for dispute CAC-UDRP-101461

Case number	CAC-UDRP-101461
Time of filing	2017-02-28 13:11:03
Domain names	SBKACCESSORIES.COM

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	DORNA WSBK ORGANIZATION S.R.L.

Complainant representative

Organization	desimone & partners

Respondent

Organization	SAWEBS INTERNET SOLUTION

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

The Complainant states and provides evidentiary documentation that is the owner of a number of trade marks containing or consisting of the word SBK. For example:

EU Registration No. 000291427 SBK SUPERBIKE WORLD CHAMPIONSHIP logo filed in 1996 for various goods and services in classes 25, 28, 38 and 41 including "sporting articles" and "sporting and cultural activities".

South African Registration No. 2009/08376 SBK filed in 2009 for various services in class 41 including "sporting and cultural activities".

FACTUAL BACKGROUND

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

The Complainant is the owner of trade marks containing or consisting of SBK in a number of jurisdictions, including the home jurisdiction of the Respondent, being South Africa.

SBK and SBK Championship has been used by the Complainant and its predecessors in title relation to an international motor sport event since 1988. The Complainant asserts, and the panel accepts, it has a global reputation and is broadcast all over the world.

The Registrant of the disputed domain name is Sawebs Internet Solutions. According to a WHOIS extract provided by the Complainant the Registrant's address is in South Africa and the disputed domain name was first registered on 1 May 2010.

The disputed domain name resolved to a website which offered for sale accessories relating to motorcycles and motor sport. In the banner at the top of the page was an image of what appeared to be a motorcyclist on a road motorcycle in racing attire.

In the CONTACT US section of website it stated:

"sbkaccessories" is currently owned and operated by myself (i.e. Brett Van Laun), Mark, with the assistance of my wife Chantal and was established in the beginning of 2010. We are based in the Durban area of South Africa but distribute across South Africa and internationally from time to time. Bikes have been my main passion and hobby for as long as I can remember (…). I started sbkaccessories with the intention of making a second income doing something that i'm really passionate about and god willing (…). From sbkaccessories you will be able to purchase top name brands such as Puig, Powerbronze, Skidmarx, Two-Brothers, Arai, Renthal and so on as well as proudly South African manufactured accessories and our own "sbk" accessories (…). I operate the business online from home and keep minimal stock on hand due to space constraints and also to keep overheads to a minimum".

On the 28 September 2016 the Complainant, through their lawyers, sent a warning letter requesting the assignment of the contested domain name. The letter was sent by fax, mail and email. The facsimile did not appear to be received as the number was invalid. However no such issue was known to be apparent in relation to the mail and email.

The Registrant did not reply to either the mail or email version of the letter.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed 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 disputed 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 disputed 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 Complainant has demonstrated to the satisfaction of the Panel that it has registered rights in the trade mark SBK that

predates the registration of the disputed domain name by the Respondent.

Reliance on registered rights in a single jurisdiction is sufficient for the purposes of establishing rights referred to in paragraph 4(a)(i) of the UDRP (Koninklijke KPN N.V. v. Telepathy, Inc., WIPO Case No. D2001-0217; see also WIPO Case Nos. D2012-0141 and D2011-1436).

It is further noted that the Complainant has established a global reputation in SBK. In Case Record Connect, Inc v. Chung Kit Lam / La-Fame Corporation, FA1609001693876 (Forum, 3 November 2016) the learned Panelist stated:

"To have common law rights, a complainant must demonstrate that a mark has acquired secondary meaning. Relevant evidence of secondary meaning can include sales figures, length of use of a mark, and expenditures in maintaining the mark."

The length of use in this case is notable. Namely, use in relation to an international motor sport event since 1988. Sales and expenditure were not provided. However from the undistributed facts described above and the evidence provided, including extracts from the Complainant's website located at www.worldsbk.com, the Panel was satisfied a global reputation and secondary meaning in SBK has been achieved.

The addition of the suffix "accessories" does nothing to alleviate the likelihood of confusion. The Panel finds it would clearly be understood as a reference to the goods provided on the Respondent's website.

In relation to the Respondent the Panel finds it has no rights or interest in the disputed domain name. The Panel further finds the Respondent has registered and used the disputed domain name in bad faith.

The Panel must however stress this is not a finding of dishonesty on the part of the Registrant. Interestingly, the Registrant does not seem hide its clear efforts to associate itself with the Complainant's sporting event. The ABOUT US page on the website seems to indicate the officers or employees of the Registrant may even be fans of professional motorcycle racing and hence possibly fans of the Complainant's SBK Championship event.

However the actual subjective motive of the Respondent is impossible to assess. There is no response filed. The Panel cannot, and will not, speculate on such a matter. Further, to make a finding of registration and use in bad faith the Panel is not required to do so.

There are decisions in which learned panelists have deemed bad faith through the act of offering a domain name for sale (Educational Testing Service v. TOEFL WIPO Case No. D2000-0044), there are decisions where constructive knowledge has been applied to deem bad faith where the registrant lives in a jurisdiction that supports such a principle (The Sportsmans Guide Inc v. Modern Limited, Cayman Islands WIPO Case No. D2003-0305) and there are decisions where 'willful blindness' has sufficed to establish bad faith (mVisible Technologies Inc. v. Navigation Catalyst Systems Inc WIPO Case No. D2007-1141).

The task of assessing if a Respondent has registered and used a domain name in bad faith is most certainly one which must observe the particular circumstances of the Respondent but it is also still an objective one. In the Panel's view what ought to asked is whether an objective and reasonable person in the position of the Respondent acting with proper and honest motive would refrain from registering and using the disputed domain name in the manner that the Respondent did.

In the present case an objective and reasonable South African resident acting with proper and honest motive would not seek to register the disputed domain name and use it in the profit making manner that the Respondent did. The likelihood of confusion for consumers is apparent and foreseeable. They are likely to assume the goods sold are associated with or sponsored by the Complainant. Clearly, they are not.

The Respondent may truthfully see itself as an innocent fan associating itself with a name for an event it respects. It may have further viewed the Complainant's lawyer’s letter with scepticism. However such views would be ignorant of the basic

rights of the trade mark owner and would not be the views of the objective and reasonable South African.

The disputed domain name was registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SBKACCESSORIES.COM**: Transferred

PANELLISTS

Name	**Mr Andrew Norman Sykes**

DATE OF PANEL DECISION 2017-04-05

Publish the Decision