Decision for dispute CAC-UDRP-101618

Case number	CAC-UDRP-101618
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Domain names	SBKMOTORSPORT.COM

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	DORNAWSBK ORGANIZATION S.r.l.

Complainant representative

Organization	desimone & partners

Respondent

Name	STEVE KILVINGTON

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings related to the Disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademarks (among others) for the name “SBK":

- European trademark No. 011221249 registered on April 16, 2013, in classes 3, 15, 24;
- European trademark No. 009799453 registered on March 23, 2012, in classes 6, 12, 34;
- International trademark No. 1083094 registered on March 30, 2011, in classes 4, 6, 9, 12, 14, 16, 18, 25, 28, 32, 33, 34, 36, 36, 37, 38, 39, 40, 41, 42, 43.

FACTUAL BACKGROUND

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

The Complaint was submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy), approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), approved by ICANN on October 24, 1999.

This dispute is properly within the scope of the Policy and the Administrative Panel has jurisdiction to decide the dispute.

The registration agreement, pursuant to which the Disputed domain name that is the subject of this Complaint is registered, incorporates the Policy. The Disputed domain name was registered on 7.5.2016.

FACTUAL BACKGROUND AND EVIDENCE

World Superbike, named by the Complainant's assignees SBK, has evolved exponentially since its inception in 1988 when the nascent series broke ground as a production-based motorcycle-racing program.

The commercial success was supported and protected by a good coverage of trademark rights all over the world.

SBK has nowadays become a reputed trademark designating a globally well-known motor sport event and related goods & services. This reputation is confirmed by the results of the Google searches. This event is also widely broadcast all over the world.

The Registrant seems to be a car and motorcycles enthusiast who likes to take photographs at vehicles and offers to cover meetings on behalf of Motor Clubs, Team Drivers and others.

As he represents himself as SBK in order to gain appreciation form the many motorist enthusiasts that follow SBK races, this seems a clear attempt to divert customers from the Complainant's web site to the Respondent's one.

For the above mentioned reasons, on the 21 June 2017 the Complainant sent a warning letter requesting the assignment of the contested domain name to Dorna WSBK Organization S.r.l. The letter was sent by mail. The Complainant sent the warning letter again on July 20, 2017, to the Registrant and to the Registrar, but received no reply whatsoever.

LEGAL GROUNDS

1. About confusingly similarity between the trademark and the contested domain name

As mentioned, SBK trademark and SBK formative trademarks have been extensively used in Europe and nowadays it is unequivocally associated to the Complainant and to the goods and services commercialized by them. SBK is therefore distinctive and unique for the registered good and services.

The contested domain name <SBKMOTORSPORT.COM> is almost identical to the Complainant trademark SBK, being MOTORSPORT a descriptive element indicating the same sector in which the Complainant's trademark enjoys reputation. Indeed, the most distinctive element is the prefix SBK which is identical and confusingly similar to the Complainant's trademark (Policy, Paragraph 4(a) (i); Rules, Paragraphs 3(b) (viii), (b) (ix) (1)).

The addition of merely generic, descriptive or geographical wording to a trademark in a domain name would normally be insufficient in itself to avoid a finding of confusing similarity under the first element of the UDRP. Panels have usually found the incorporated trademark to constitute the dominant or principal component of the domain name (Hoffmann-La Roche Inc. v. Wei-Chun Hsia, WIPO Case No.D2008-0923, <yourtamiflushop.com> (Transfer); BHP Billiton Innovation Pty Ltd, BMA Alliance Coal Operations Pty Ltd v. Cameron Jackson, WIPO Case No.D2008-1338, <auriasdiamonds.info> inter alia, (Transfer);TPI Holdings, Inc. v. Carmen Armengol, WIPO Case No.D2009-0361, <autotradertransactions.com> (Transfer); Nintendo of America Inc. v. Fernando Sascha Gutierrez, WIPO Case No.D2009-0434, <unlimitedwiidownloads.com>, (Transfer)).

As for the applicable top level suffixes, there is a consensus in that they are to be disregarded in the threshold assessment of risk of confusing similarity under the first element of the Policy. The addition of the gTLDs is not of legal significance from the standpoint of comparing the disputed domain names to the trademark. Such use is required of domain name registrants and do not serve to identify a specific enterprise as a source of goods or services (WIPO Case No. D2001-0602, SBC Communications v. Fred Bell aka Bell Internet).

The Respondent is trying to lead the consumers to think that the disputed domain name <SBKMOTORSPORT.COM> is an authorized site linked to SBK trademark owner, who, as mentioned, is the organizer of the famous motorcycle racing worldwide events and the owner of electronic SBK games related to racing events.

Thus, as the suffix .com only indicate that the domain name is registered under the .com gTLD and is not distinctive, the Panel should find the disputed domain name to be identical with Complainant's trademark, see the "ARCELORMITTAL" case. (WIPO Case No. D2003-0598, MADRID 2012, S.A. v Scott Martin-Madrid Man Websites). Therefore the comparison has to be made between <SBKMOTORSPORT.COM> on one side and SBK on the other.

It is self-evident that the disputed domain name <SBKMOTORSPORT.COM> and the prior trademark SBK are confusingly similar and, actually, identical in their distinctive element. Consumers would be induced to think that the Respondent is authorized by Dorna in his commercial activity.

The Complainant has also registered a series of SBK-formative domain names to which the contested domain name is similar.

2. The Respondent has no rights or legitimate interests in respect of the domain name (Policy, Paragraph 4 (a) (ii); Rules, Paragraph 3 (b) (ix) (2))

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

Preliminarily, although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, panels have recognized that this could result in the often impossible task of proving a negative proposition, requiring information that is primarily if not exclusively within the knowledge of the Respondent. Thus, the consensus view is in that paragraph 4(c) of the Policy shifts the burden to the Respondent to come forward with evidence of a right or legitimate interest in the Domain Name, once the Complainant has made a prima facie showing indicating the absence of such rights or interests (WIPO Case No. D2000-0270, Document Technologies, Inc. v. International Electronic Communications Inc.

The Respondent's use of the contested domain name can be no way considered a bona fide offering of goods and services as the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name.

The Disputed domain name is indeed used to publish under the SBK trademark formative photographs of new and used cars and motorcycles circuit racing, rallying, Classic and Race Tours, Tests and Trials. The reference SBK has been used in order to attract surfers to the site and to their products. He could achieve the same results indicating just "Cars or Motors photography" without taking advantage of third parties' trademark reputation.

Besides, the Respondent has no registered trademark rights in the word SBK. On the contrary, as herein already mentioned, the Complainant has registered several SBK and SBK formative trademarks since many decades, and also many domain names including SBK trademark and is commonly known as the owner and responsible for the SBK world motor championship.

In light of above, it is evident that the Respondent is using the Disputed domain name in order to attract to its website as many Internet users as possible, especially the SBK motorcycles enthusiasts.

This conduct is illegitimate as it is a definite diversion of potential Complainant's consumers and cannot be considered a bona fide offering of goods and services (CAC Case 100358 <arcelormittal.biz>).

Finally, 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. In similar circumstances, Panels considered that no bona fide or legitimate use of the disputed domain name could be claimed by the Respondent (WIPO Case D2000-0055, Guerlain SA v. Peikang, WIPO Case D2008-0488, BHP Billiton Innovation Pty Ltd. v. OS Domain Holdings IV LLC, WIPO Case D2009-0258, Mpire Corporation v. Michael Frey)

3. The domain name has been registered and is being used in bad faith (Policy, paragraphs 4 (a) (iii), 4(b); Rules, paragraph 3 (b) (ix) (3))

The disputed domain name has been registered and is being used by the Respondent in bad faith.

As mentioned, the Complainant has long standing rights in the trademark SBK and SBK is nowadays a reputed trademark in the file of motor events and motorbikes in general. This is also proved by the long standing Trademark Registrations on SBK wordmark as well as SBK logos that have changed over the years.

SBK Motor Events are broadcasted internationally especially in Europe.

So when registering the Disputed domain name, the Respondent was necessary 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 motor races and thus to take advantage of the reputed trademark SBK especially amongst the motorcycles lover.

Clearly, such conduct would not have been taken if the Respondent did not know the Complainant’s activities (WIPO Case D2010-1290, Meilleurtaux v. Domain Manager of Bondi Junction).

In light of the above, the Disputed 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" (WIPO Case No. D2000-0226, Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net; WIPO Case No. D2000-0163, Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., net; WIPO Case No. D2001-0781, Fortuneo v. Johann Guinebert). Furthermore the Complainant has a license photographs taken from the SBK motor racing events.

Furthermore, the Respondent was never authorized or licensed or otherwise permitted by the Complainant to use the Disputed domain name.

As mentioned, the Respondent did not reply to the Complainant's letters and also this attitude could be considered by the Panel in the finding of bad faith. Indeed, lack of reply to a soft warning letter may be also in this frame a proof of bad faith (CAC Case No. 100358 <arcelormittal.biz>).

Finally, although the UDRP does not operate on a strict doctrine of precedent, panels consider it desirable that their decisions are consistent with prior panel decisions dealing with similar fact situations. This ensures that the UDRP system operates in a fair, effective and predictable manner for all parties, while responding to the continuing evolution of the domain name system. Panels have noted in this context that the UDRP system preserves court options for parties. In such respect the Complainant had been actively defending its intellectual properties against unfair registration of domain names confusingly similar to its trademarks and has obtained many favorable decisions.

The Complainant certifies that the information contained in this Complaint is to the best of the Complainant’s knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under the Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

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

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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

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

I. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

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.

The Panel will therefore deal with each of these requirements in turn.

I. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the Disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registrations of the trademarks “SBK” in several jurisdictions.

The Panel finds that the Disputed domain name <SBKMOTORSPORT.COM> fully incorporates the Complainant’s trademark “SBK” and with the additional element “MOTORSPORT”. The Panel concludes that the addition of the element "MOTORSPORT", which defines the type of sports event that the Complainant and both parties are related to, does not eliminate the confusing similarity between the Complainant's trademarks and the Disputed domain name.

In similar UDRP cases (see, e.g., Sanofi-Aventis v. Gideon Kimbrell, WIPO Case No. D2010-1559; Turkcell Iletisim Hizmetleri A.S. v. Vural Kavak, WIPO Case No. D2010-0010; Greenbrier IA, Inc. v. Moniker Privacy Services/Jim Lyons, WIPO Case No. D2010-0017 and Zodiac Marine & Pool, Avon Inflatables Ltd and Zodiac of North America Inc. v. Mr. Tim Green, WIPO Case No. D2010-0024), the respective UDRP panels found that adding descriptive or low distinctive words does not remove the likelihood of confusion between a trademark and a domain name incorporating said trademark.

The Panel finds that the addition of the gTLD ".com" is irrelevant when determining whether the Disputed domain name is confusingly similar to the Complainant's trademark (see, PRL USA Holdings, Inc. v. Spiral Matrix, WIPO Case No. D2006-0189).

The Panel is of the opinion that the internet users will fall into false impression that the Disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the Disputed domain name is confusingly similar with the Complainant's trademarks. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

II. NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is open to a Respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to you [the Respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
(ii) you [the Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you [the Respondent] are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the Respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the Disputed domain name, the Complainant will have failed to discharge its burden of proof and the Complaint will fail.

The Complainant contends that the Respondent has made no use of, or demonstrable preparations to use, neither of the Disputed domain name in connection with a bona fide offering of goods or services, is not making a legitimate non-commercial or fair use of the Disputed domain names, and is not commonly known under the Disputed domain names.

In the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant’s trademarks in the Disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the Disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

III. BAD FAITH

The Panel notes that the Complainant must prove both that the Disputed domain name was registered in bad faith and that it is being used in bad faith. The Panel is of the opinion that due to the earlier rights of the Complainant in the trademarks “SBK”, as well as its extensive usage and worldwide notoriety in its sector, the Respondent was aware of the Complainant and its trademarks at the time of registration of the Disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107; General Electric Company v. CPIC NET and Hussain Syed, WIPO Case No. D2001 0087). The Panel believes that the awareness of the Complainant’s trademark at the time of the registration of the Disputed domain name is to be considered an inference of bad faith registration. Moreover, the Respondent's use of "SBK" trademarks and Complainant's licensed photographs in the web site, also depicts that Respondent's main purpose is to take advantage from Complainant's "SBK" trademarks' notoriety.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the Disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element under 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. **SBKMOTORSPORT.COM**: Transferred

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2017-08-22

Publish the Decision