Decision for dispute CAC-UDRP-101619

Case number	CAC-UDRP-101619
Time of filing	2017-07-25 10:53:43
Domain names	MOTOGP-SBK.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	DORNA WSBK ORGANIZATION S.r.l.

Complainant representative

Organization	desimone & partners

Respondent

Organization	ZHOUHENG

OTHER LEGAL PROCEEDINGS

The Panel is not informed about other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several SBK trademarks related to motor sport events, and motorbikes and vehicles and their accessories, parts and fittings etc.

The Complainant is also the proprietor of several SBK domain names.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE COMPLAINANT

"SBK" stands for the World Suberbike Championship, which has evolved exponentially since its inception in 1988, when the nascent series broke ground as a production-based motorcycle-racing program. The appeal of SBK Championship was the fact that teams were running production motorcycles (highly modified, but none the less production-based). SBK fans could see the same motorcycles that were on their local dealership's floor mixing it up at speed on racetrack.

After humble beginnings the SBK Championship came under the guidance of the Italian Flammini Group (FGSports) in the early 90s. American sensation, Doug Polen, brought the series unprecedented exposure when the Texan dominated his rookie year in 1991, winning the title, and successfully defending the crown in 1992. This helped ignite a powerful Ducati presence in the series, creating an engaging competition between the Italian powerhouse and the major Japanese motorcycle manufacturers (Honda, Suzuki, Kawasaki, and Yamaha) that lasts to this day.

The Flammini Group grew the series, securing prominent venues and developing a strong television package, bringing the racing to an immense viewership. By the mid-90s SBK was on par with MotoGP in terms of fan loyalty and coverage. An important element embraced by SBK was an atmosphere of access to its stars. Unlike Moto GP, fans were able to get close to their favorite riders.

In the 22 years since its inception, the SBK Championship has had also a major impact on the development and engineering of modern sport motorcycles. By the end of the 90s every main superbike manufacturer was deeply involved with SBK Championship. Honda, Kawasaki, Yamaha, Suzuki, Ducati, Benelli, and Aprilia (and for a while Petronas) all had a major presence. In response, the manufacturers poured more backing into their race teams and the Superbike series continued to grow.

In 2008 the Flammini Group merged with Infront Motorsports. The 2009 season saw a record: seven manufacturers Ducati, Aprilia, Yamaha, Suzuki, Honda, Kawasaki, and BMW (as well as Triumph in Supersport) compete in the premiere class with 32 series' regulars lining up on grids all over the world. In March of 2013 the Spanish Group DORNA, already owner of the MOTOGP Championship, took over the SBK motor racing firm Infront. The new owner is now called DORNA WSBK Organization S.r.l.

SBK has nowadays become a reputed trademark designating a globally well-known motor sport event and related goods & services. This reputation is also confirmed by the results of the Google searches. The SBK events are also widely broadcast all over the world. The Complainant owns and runs Motogp Racing events as well as the SBK championship.

The Respondent is a Chinese organization and its web site is not active. The Registrant seems to know the trademark SBK very well and its relationship with MOTOGP, the other famous brand of motorcycle events. In fact these two trademarks belong to the same Dorna Group.

The Respondent represents itself as SBK in order to gain appreciation from the many motorist enthusiasts that follow SBK races, it seems a clear attempt to divert customers from the Complainant’s website to the Respondent’s one. The site is not active and this is a clear passive holding. The fact that is not active is not a justification of the unfair diversion of internet surfers.

On 29 May 2017 the Complainant sent a warning letter requesting the transfer of the contested domain name to Dorna WSBK Organization S.r.l. The letter was sent by fax, which occurred to be not a valid number and also by email. On June 6 2017 the Complainant received a response from the Respondent’s Registrar, in which the Registrar stated that it could not help the Complainant and in which it advised the Complainant to go ahead with ADR proceedings.

The Respondent did not reply, neither by mail nor by e-mail.

1. The Complainant contends that its SBK trademarks and the Domain Name are confusingly similar

The Complainant asserts that the Domain Name "MOTOGP-SBK.COM" comprises both trademarks SBK and MOTOGP and is therefore clearly directed to the motor enthusiasts. Indeed, the most distinctive element is the prefix SBK- which is identical and confusingly similar to the Complainant’s trademarks.

As for the applicable top level suffixes, there is a consensus in that they are to be disregarded in the threshold of risk of confusing similarity. The addition of the gTLDs is not relevant for the purpose of comparing the disputed domain names with the invoked trademarks.

The Complainant contends that the Respondent is trying to make the consumers think that MOTOGP-SBK is an authorized site linked to SBK trademarks 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. According to the Complainant, the Domain Name "MOTOGP-SBK" and the SBK trademarks are confusingly similar and, actually, identical in their distinctive element.

2. The Complainant also asserts that the Respondent has no rights or legitimate interests in respect of the Domain Name

The consensus view is that once the the Complainant has made a prima facie showing indicating the absence of rights or legitimate interests, the burden is shifted to the Respondent to come forward with evidence of a right or legitimate interest in the Domain Name.

The Complainant contends that the Respondent's use of the Domain Name cannot be considered a bona fide offering of goods and services as the Respondent is not making a legitimate non-commercial or fair use of the Domain Name.

The Respondents' website is a passive website and the wording SBK in the Domain Name is used in order to attract surfers to the site and to their products. Attracting users to an inactive website is damaging because induces surfers to think that SBK and MOTOGP have no websites or they lost them, which is not true given that the Complainant has several domain names and an active website.

Besides, the Respondent has no registered trademark rights in the word SBK.

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.

3. The Complainant contends that the Domain Name has been registered and is being used in bad faith

The Complainant asserts that it 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. Accordingly, when registering the Domain Name, the Respondent was necessarily aware of the Complainant's trademarks.

In light of the above, the Domain Name is so obviously connected with the Complainant's trademarks that its very use by someone with no connection with the Complainant suggests "opportunistic bad faith".

Furthermore, the Respondent was never authorized or licensed or otherwise permitted by the Complainant to use the Domain Name.

The Respondent does not use the Domain Name, which is currently inactive. Nevertheless, this state of inactivity does not mean that the Domain Name is used in good faith. Indeed, passive holding does not preclude a finding of bad faith. Similarly, reproducing famous trademarks in a domain name (such as SBK trademark) in order to attract Internet users to an inactive website cannot be regarded as fair use or use in good faith.

The Complainant asserts that the fact that the Respondent did not reply to the Complainant's letter could also be considered as a sign of bad faith.

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

I. The Panel finds that the Domain Name is confusingly similar to the Complainant's trademarks.

The relevant comparison to be made with the second-level domain name only (i.e. "MOTOGP-SBK"), since it is well-established that the Top Level Domain (i.e. ".com") may be disregarded for this purpose. The Domain Name contains both the SBK trademarks of the Complainant and the name MOTOGP, which refers to the products and services for which the SBK trademarks are ordinarily used and therefore may exacerbate or increase the likelihood of confusion. The Domain Name is therefore confusingly similar to the Complainant's trademarks.

II. The Panel also finds that the Complainant has shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name

The Respondent is not making a legitimate non-commercial or fair use of the Domain Name, which is only used for a passive web site. Besides, the Respondent has no registered trademark rights in the word SBK and 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.

III. Finally, the Complainant has shown that the disputed domain name has been registered and is being used in bad faith

The Complainant has shown that SBK is nowadays a reputed trademark in the file of motor events and motorbikes in general. Accordingly, when registering the Domain Name, the Respondent was necessarily aware of the Complainant’s trademarks. The Domain Name is so obviously connected with the Complainant’s trademarks that its very use by someone with no connection with the Complainant suggests "opportunistic bad faith". In addition, the Respondent was never authorized or licensed or otherwise permitted by the Complainant to use the Domain Name. The passive holding does not preclude a finding of bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MOTOGP-SBK.COM**: Transferred

PANELLISTS

Name	**Tom Joris Heremans**

DATE OF PANEL DECISION 2017-09-04

Publish the Decision