Decision for dispute CAC-UDRP-101880

Case number	CAC-UDRP-101880
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Domain names	sbkmotorbikes.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

Name	TONY KELLY

OTHER LEGAL PROCEEDINGS

The panel is not aware of any other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

Among other SBK formative trademarks, the Complainant is the owner of the following:

- EUTM Registration No. 9799453 SBK, filed on March 10, 2011 and registered on March 23, 2012, for goods in classes 6, 12 and 34.

- EUTM Registration No. 9799354 SBK (fig), filed on March 10, 2011 and registered on August 22, 2011, for goods and services in classes 25, 35 and 41.

- International trademark 1083094 SBK, registered on March 30, 2011, for goods and services in classes 4, 6, 9, 12, 14, 16, 18, 25, 28, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42 and 43.

FACTUAL BACKGROUND

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

This complaint is hereby 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 domain name that is the subject of this Complaint is registered, incorporates the Policy. The domain name was registered on 28 August 2017.

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 production-based motorcycle-racing program. The history of SBK Championship is briefly and truly described in a paragraph of the section "The history of World Superbike" in the famous website www.ultimatemotorcycling.com.

The appeal of SBK Championship was the fact that the teams were running production motorcycles (highly modified, but none the less production-based). The 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 to 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 and 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 the MotoGP, 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 in SBK Championship. Honda, Kawasaki, Yamaha, Suzuki, Ducati, Benelli and Aprilia (and for a while Petronas) all had a major presence. In response, the manufactures poured more resources 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.

This commercial great success was also supported and protected by a good coverage of trademarks rights all over the world.

The Complainant indeed is the owner of several SBK worldwide registrations and applications in class 41 for motor sport events and for all the services comprised in this class, but also in class 12 for motorbikes and vehicle and their accessories, parts and fittings and in class 9 for electronic games. In particular the Complainant have submitted copy of the certificates of registrations for SBK trademarks obtained in United States. Those registrations are now in the name of the actual Complainant even though they were obtained by the former proprietors FGS Licence. The Complainant is also the owner of a

list of several domain names.

As stated, FGS Licence was the original founder of the motor events branded SBK and now the owners and users of such trademark is Dorna WSBK Organization S.r.l., the Italian affiliate of the Spanish global company. The Complainant and before it its predecessor have been running SBK Championship for few decades. SBK has nowadays become a reputed trademark designating a globally well-known motor sports event and related goods & services. This reputation is also confirmed by the results of Google searches. The SBK events are also widely broadcast all over the world.

The Respondent is an American company active in the field of cloud computing infrastructures. From its website no reference to the world of motorcycle racing are detectable, neither the SBK championship nor the MotoGP. This explain quite well the correct intentions of the Respondent.

The disputed domain is not in use since its registration was made, on 28 August 2017.

To protect the interests of the Complainant in not having false websites using its name and to avoid risks of confusion in the public of moto enthusiasts, on January 18, 2018 the Complainant sent a warning letter by e-mail that remained unanswered.

LEGAL GROUNDS

1. About confusing similarity between the trademark and the disputed domain name

As mentioned, SBK trademark has been extensively used in United States as well as 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 disputed domain name <SBKMOTORBIKES.COM> is potentially directed to motorbikers, indeed that is clear considering the association between the registered trademark SBK and its association with MOTORBIKES.

In effect, the most distinctive part of the disputed domain name is SBK, which is placed in the beginning as a suffix and is identical and confusingly similar to the Complainant's trademark (Policy, Paragraph 4 (a)(i); Rules, Paragraph 3(b) (viii), (b) (ix) (1)).

The Complainant believes that there is an incontrovertible confusingly similarity between its registered trademarks and the disputed domain name. The SBK trademark is indeed reproduced slavishly in the disputed domain name, thus generating the risk of confusion.

It is clear, in fact, that the signs in comparison present, about their distinctive component, the only one that is comparable when it comes to domain name, and in any case predominant, a slavish similarity, given the fact that the only negligible difference is in the use of the word "motorbike". Furthermore, the said difference makes the disputed domain name even more related and likely to be confused with the Complainant's goods and services.

The further use of the generic term "motorbikes" in fact does not consist in a differentiation between the signs, being a descriptive element of the related main category of products. The addition of a generic, descriptive or geographical indication to a trademark in a domain name is not in itself enough to exclude the likelihood of confusion from the point of view of the first element of the UDRP.

Common grounds resulting from previous decisions are based on the idea, that if the registered trademark constitutes the distinctive and principal element of a domain, there is a high risk of confusion (Hoffmann-La Roche Inc. v. Wei-Chun Hsia, WIPO Case No. D2008-0923; BHP Billiton Innovation Pty Ltd, BMA Alliance Coal Operations Pty Ltd v. Cameron Jackson, WIPO case No. D2008-1338; TPI Holdings, Inc. v Carmen Armengol, case WIPO No. D2009-0361; Nintendo of America Inc. v. Fernando Sascha Gutierrez, WIPO case No. D2009-0434).

For all the mentioned reasons, the average web-user could interchange the disputed domain with the Complainant's trademark, and consider the website identified by that domain name as authorized and/or connected to the Complainant, who, as explained before, is the organizer of the famous motorcycle racing worldwide events and the owner of the SBK games related to racing events.

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name

Preliminary, although the Complainant bears the ultimate burden of establishing all three elements of the 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 website is a passive website with no reference whatsoever.

The reference SBK in the disputed domain name has been used in order to attract surfers to the site. Moreover, attracting users to possible and inactive websites is an actual risk and a serious damage as well, because induces surfers to think that SBK has no website or even worst, that they lost it; circumstances not true given that the Complainant has several domain names and an active popular website.

Besides, the Respondent has no registered trademark rights in the world of motorbike-racing and, in particular, in the world of SBK. On the contrary, as herein already mentioned, the Complainant has registered SBK and SBK formative trademarks since many decades, as well many domain names including SBK trademark, and is widely and commonly recognized as the owner and the responsible for the SBK world motor championship.

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 disputed domain name has been registered and is being used in bad faith

The Complainant considers that the Respondent has registered and maintains the disputed domain name in bad faith.

As shown in the Complainant's allegation, the SBK trademark is a well-known and very popular among the superbike fans and those of motorbike racing in general. It has been on the market since the early '70s and has achieved over time the aforementioned public success also thanks to the widespread media and television coverage of the SBK championship.

The well-established case law of the Arbitration courts has stated that if the registered domain corresponds to a trademark which enjoys renown, the bad faith in registering can be deduced in re ipsa by the fact of having registered a domain name corresponding to a famous brand, on which it would have been easily checked the availability by third parties.

So, indeed, 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. This is also indirectly proven by the self-explanatory link between SBK and MOTORBIKES. Obviously, such conduct would not have been taken if the Respondent did not know the Complainant's activities and, in this regard, a previous arbitration proceeding (No. 101057 of 22.09.2015 in relation to SBKGP.com) the CAC Panelist expressly held that (Encl. 9): "it appears that the SBK trademark has a strong reputation and its widely known in multiple countries".

The disputed domain name is so doubtlessly 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 – Annex 36, WIPO Case No. D2000-0163, Veuve Cliquot Ponsardin, Maison Fondèe en 1772 v. The Polygenix Group Co., net – Annex 37, WIPO Case No. D2001-0781, Fortuneo v. Johann Guinebert).

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

The fact that there is currently no use of the disputed domain name must, logically, lead to the conclusion that the Respondent keep it passively to the detriment of the legitimate holder, being aware that such passive holding prevents the rightful holder of the corresponding brand to use it as domain name (WIPO case No. D2001-0631 - Laboratorios Recalcine SA v. Victor Abarca). The registration and the current lack of use by the Respondent of the disputed domain name prevent the Complainant exercise and/or the direct provision of information about their products to the Internet user in the corresponding market.

The consolidated case-law regarding "passive-holding" has pointed out, in several occasions, as the inactivity of a website should be considered as a lack of current interest and an index of interest in the domain solely for cybersquatting, and the "passive-holding of a domain name" constitutes an element from which the bad faith of the holder can be deduced.

Indeed, "a principle widely adopted by Panels shortly after the UDRP has been incepted is to examine all the surrounding circumstances in which a disputed domain name may appears to be, or is claimed to be, held passively without any evident usage or purpose" (Cleveland Browns Football Company LLC v. Andrea Denise Dinoia, WIPO Case No. D2011-0421)".

Furthermore, "previous Panels have already considered passive holding of a disputed domain name can satisfy the requirements of paragraph 4 (a)(iii) of the Policy, and that in such cases Panel must give close attention to all the circumstances of the Respondent's behavior (Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-003)".

As mentioned, the Respondent did not reply to the Complainant's warning letter and also this circumstance must be taken into account by the Panel, in the finding of the bad faith. Lack of reply to a soft warning letter, as the one sent by the Complainant, may represent in given context a proof of a bad faith (CAC case No. 100358 www.arcelormittal.biz).

Finally, although the UDRP does not operate on a strict doctrine of precedent, Panels consider it desirable that their decision are consistent with prior Panel decisions dealing with similar fact situation. This ensures that the UDRP system operates in a fair, effective and predictable manner for all parties, while responding to the continuous evolution of the domain name system. Panels have noted in this context that the UDRP systems preserves court opinions 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 the assertions in this Complaint are warranted under the Rules and under the 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

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. RIGHTS

The disputed domain name is confusingly similar to the Complainant’s registered trademarks since it reproduces the Complainant’s mark ‘SBK’, merely adding the generic expression "motorbikes"at the end. SBK Championship is precisely one of the most famous motorbike competitions.

II. NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has not submitted any response. Therefore, it has submitted no information on possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which allow it to be reasonably assumed that the Respondent has no rights or legitimate interest in the disputed domain name.

As the WIPO Arbitration and Mediation Center pointed out in UDRP case No. D2002-0856:

“As mentioned [in the decision], the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed Domain Names, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists.“ WIPO Case No. D2002-0273 <sachsenanhalt>; WIPO Case No. D2002-0521 <volvovehicles.com>.

Furthermore, apparently the Respondent did not reply to the C&D letter sent by the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

III. BAD FAITH

The Respondent has, as a result of his default, not invoked any circumstances which could invalidate the Complainant´s allegations and evidence with regard to the Respondent´s registration and use of the disputed domain name in bad faith.

Paragraph 4(b) (iiii) of the Policy provides that the following circumstances are deemed to be evidence that the Respondent has registered and is using the disputed domain name in bad faith:

(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet

users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or location or of a product or service on its website or location.

The Complainant's SBK trademark is well-known in the motorbike world, well before the registration of the disputed domain name. The Respondent's registration of the disputed domain name wholly incorporating a well-known third-party mark is, in the Panel´s view, indicative of bad faith, especially in a case like this, where the well-known trademark (SBK) is combined with the corresponding activity (motorbikes).

As mentioned in Andrey Ternovskiy dba Chatroulette v. Alexander Ochki, WIPO Case No. D2017-0334:

"It is clear in the Panel's view that in the mind of an Internet user, the disputed domain names could be directly associated with the Complainant's trademark, which is likely to be confusing to the public as suggesting either an operation of the Complainant or one associated with or endorsed by it (see AT&T Corp. v. Amjad Kausar, WIPO Case No. D2003-0327)."

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SBKMOTORBIKES.COM**: Transferred

PANELLISTS

Name	**José Ignacio San Martín**

DATE OF PANEL DECISION 2018-04-11

Publish the Decision