Decision for dispute CAC-UDRP-102568

Case number	CAC-UDRP-102568
Time of filing	2019-11-20 09:50:04
Domain names	SBKRIDER.COM

Case administrator

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

Complainant

Organization	Dorna WSBK Organization

Respondent

Name	HE HU

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

Complainant is the owner of multiple trademarks including:

- International Trademark SBK nr. 1083094, date of registration 30 March 2011, also applicable in China;

- European Union Trademark SBK nr. 004615936, filing date 27 September 2005, registration date 30 April 2010.

FACTUAL BACKGROUND

According to the evidence submitted by Complainant, the word "SBK" stands for the World Superbike Championship, which has evolved exponentially since its inception in 1988, when the 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 the racetrack.

The disputed domain name <sbkrider.com> was registered on 23 March 2019. The trademark registrations of Complainant have been issued prior to the registration of the disputed domain name.

According to Complainant the disputed domain name is confusingly similar to Complainant's trademarks as it incorporates Complainant’s distinctive trademark SBK in its entirety. The disputed domain name is potentially directed to motor-bikers, indeed that is clear considering the association between the trademark SBK and its association with “riders”. In effect, the most distinctive part of the disputed domain name domain is SBK, which is placed in the beginning.

According to Complainant, Respondent has no rights or legitimate interest in the disputed domain name and Respondent is not related in any way with the business of Complainant. Respondent is not using the disputed domain name to offer any

goods or services. The disputed domain name does not resolve to any active website. The reference SBK in the disputed domain name has been used in order to attract surfers to the site. Moreover, attracting users to an inactive website is an actual risk and a serious damage as well, because it induces surfers to think that SBK has no website or even worst, that they lost it; circumstances not true given that Complainant has several domain names and an active popular website. Complainant also asserts that Respondent has no registered trademark rights in the world of motorbike-racing and, in particular, in the world of SBK. On the contrary, Complainant has registered SBK trademarks since many decades, as well many domain names including the SBK trademarks, and Complainant is widely and commonly recognized as the owner and the responsible organization for the SBK world motorbike championship.

According to Complainant the disputed domain name is registered and is being used in bad faith. Given the distinctiveness of Complainant's trademarks Complainant submits that the registration of Complainant's trademarks pre-dates the registration of the disputed domain name and that Respondent has never been authorized by Complainant to use these trademarks nor to register the disputed domain name.

Considering that Complainant's trademark is a well-known, distinctive mark worldwide, including in China where the Respondent is located, and that Respondent has been passively holding the disputed domain name Complainant therefore concludes that Respondent has been using the disputed domain name in bad faith. The fact that there is currently no use of the disputed domain name must, logically, lead to the conclusion that Respondent keeps it passively to the detriment of the legitimate holder, being aware that such passive holding prevents the rightful holder of the corresponding trademark to use it as a domain name.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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 Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

Complainant has, to the satisfaction of the Panel, shown 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

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

In the opinion of the Panel the disputed domain name is confusingly similar to Complainant's trademarks (Policy, Par. 4 (a) (i)). Many UDRP decisions have found that a disputed domain name is identical or confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark or the principal part thereof in its entirety. Complainant has established that it is the owner of trademark registrations for SBK. The disputed domain name incorporates the entirety of the well-known SBK trademark as its distinctive element. The descriptive word "rider" and the gTLD ".com" in the disputed domain name may be disregarded.

The Panel notes that Complainant's registration of its trademarks predates the creation date of the disputed domain name.

In the opinion of the Panel Complainant has made a prima facie case that Respondent lacks rights or legitimate interest in the disputed domain name. Complainant has not licensed or otherwise permitted Respondent to use its trademarks or to register the disputed domain name incorporating its marks. Respondent is not making a legitimate non-commercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks of Complainant. Respondent is not commonly known by the disputed domain name nor has it acquired trademark rights. Complainant has no relationship with Respondent.

Based on the undisputed submission and evidence provided by Complainant there is no website under the disputed domain name. Under these circumstances, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name (Policy, Par. 4 (a)(ii)).

The Panel finds that the disputed domain name has been registered and is being used in bad faith (Policy, Par. 4(a)(iii)). Complainant has rights in the SBK trademarks. Respondent knew or should have known that the disputed domain name included Complainant's well-known marks. The Panel notes that there is currently no active website at the disputed domain name. Such passive use of the disputed domain name does not prevent the Panel from finding registration and use in bad faith. The Panel further notes that the undeveloped use of the website at the disputed domain name which incorporates Complainant's trademark in its entirety indicates that Respondent possibly registered the disputed domain name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademarks of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location, which constitutes registration and use in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SBKRIDER.COM**: Transferred

PANELLISTS

Name	**Dinant T.L. Oosterbaan**

DATE OF PANEL DECISION 2019-12-26

Publish the Decision