Decision for dispute CAC-UDRP-103042

Case number	**CAC-UDRP-103042**
Time of filing	**2020-06-05 09:08:00**
Domain names	**vwidtalk.com, passatworld.com, clubtouareg.com**

Case administrator

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

Complainant

Organization	**Volkswagen AG**

Complainant representative

Organization	**Lubberger Lehment Rechtsanwälte Partnerschaft mbB**

Respondent

Organization	**Legal Department**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceeding related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademarks:

- TOUAREG (word), European trademark registration No. 1984152, claiming a priority date of 4 December 2000, covering goods and services in classes 12, 28 and 37;

- VW (word), European trademark registration No. 1354216, claiming a priority date of 20 October 1999, covering goods and services in classes 4, 7, 9, 12, 14, 16, 18, 25, 28, 35, 36, 37, 38, 39, 40, 41 and 42;

- ID (word), International registration No. 1441120, claiming a priority date of 7 May 2018, covering goods and services in classes 9,12, 28 and 35, and 37;

- I.D. (word). European trademark registration No. 15612104, claiming a priority date of 1 July 2016, covering goods and services in classes 12, 28, 35 and 37;

- PASSAT (word), European trademark registration No. 700740, claiming a priority date of 11 December 1997, covering

goods and services in classes 4, 5, 6, 7, 8, 9, 12, 14, 16, 18, 25, 27, 28, 34, 36, 37, 39 and 41.

FACTUAL BACKGROUND

The Complainant is a renowned car producer. Among its most famous car models are "VW Passat" and "VW Touareg". The Passat model is produced and sold worldwide since 1973. The Touareg model is produced and sold worldwide since 2002 and has won several awards during the years. ID is the name of a new series of fully electric vehicles that was first presented at the 2016 Paris Motor Show.

The Respondent describes itself as an integrated multi-platform media company. Its social networks and websites work as audience aggregation places addressed to engaged subject-matter experts, enthusiasts and businesses alike. The Respondent owns more than 800 websites and establishes or acquires online discussion forums and social media communities in different fields, including the automotive field.

The disputed domain names are <vwidtalk.com>, registered on 18 October 2019; <passatworld.com>, registered on 4 October 2004; and <clubtouareg.com>, registered on 6 December 2003. These domain names give access to websites containing discussion forums where businesses can advertise their own goods and services.

On 3 March 2020, the Complainant sent a cease and desist letter to the Respondent, requesting, inter alia, to delete the disputed domain names. The Respondent declined the Complainant's request based on the fact that it had not infringed the Complainant’s rights, that the disputed domain names were registered and used in good faith as there was no suggested affiliation, sponsorship or endorsement by the Complainant. The Respondent also informed that a non-affiliation disclaimer was included on the websites.

PARTIES CONTENTIONS

The Parties’ contentions are the following.

1. The Complainant's contentions

a) Identity or confusing similarity of the disputed domain names to the Complainant's trademarks

The Complainant asserts that the disputed domain names are confusingly similar to its trademarks, because they reproduce the Complainant's trademarks with the addition of a generic term, which is irrelevant for the purpose of assessing confusing similarity under Para. 4(a)(i) of the Policy.

b) Lack of rights or legitimate interests

The Complainant further asserts that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent is not making a legitimate non-commercial or fair use of the disputed domain names. Rather, it is using the said domain names to provide marketing/advertising opportunities to its business clients. The fact that the websites operated under the disputed domain names are designed as customer forums or enthusiast pages is irrelevant and this set up is the core part of the Respondent's business strategy. The suffixes "talk", "world" or "club" do not indicate that the sites are devoted to a noncommercial fan platform. It is well-established that a domain name holder has no legitimate interest in cases where commercial activities are the primary driver of alleged fan sites. Moreover, even if the domain names were used for true fan sites, it is not legitimate to register a domain name that is identical to a third party's trademark. The same principle should apply when the domain name consists of the Complainant’s trademark with the addition of a generic term that is not descriptive for a fan site or an enthusiast forum. Thus, the Respondent is using the disputed domain name to create confusion among Internet users who may think that there is a connection between the Complainant and the Respondent.

c) Registration and use in bad faith

Regarding bad faith, the Complainant alleges that by registering and using the disputed domain names for its business activities as a marketing company, the Respondent intentionally attempted to attract, for commercial gain, Internet users to its websites. The sole purpose for registering and using the disputed domain names is to allow the Respondent's customers to directly approach consumers and to place advertising on the websites. Therefore, the Respondent takes unfair advantage of the Complainant's well-known trademarks. In relation to the disclaimers that the Respondent added to the websites, the Complainant points out that these disclaimers are not suitable to exclude the confusion, and in any case, should not be taken into account as they were added to the websites only after having received the Complainant's warning letter.

2. The Respondent's contentions

Preliminarily, the Respondent objects to the Complainant's allegation that the Respondent is a mere "marketing company". The Respondent maintains that its business essentially consists of a media and social network business where clients may also place their advertisements. Through its more than 800 websites and 125 million visitors per month, the Respondent has created communities of consumers that offer a unique opportunity to major corporations to spread their product message to the vast audience that come to the websites, to be with like-minded people in a way that is not different from any other social media platform. The Respondent's global reputation lies in its having created a family of forum websites for people to meet and share their interests in many areas, such as automobiles, home goods, sports equipment, electronics, outdoor and health related products, etc.

The forum websites offer to visitors and members Internet spaces to have a virtual "club", where they can meet to "talk" about products in a "world" community. This is the reason why these three words mentioned above were added to the Complainant's trademarks TOUAREG, PASSAT and VWID. The Respondent incorporated these trademarks in its domain names to describe the content of the websites. Thus, the Respondent has registered and is using the disputed domain names legitimately as nominative fair use under Para. 4(c)(iii) of the Policy .

The Respondent further contends that the Complaint should be considered outside the scope of the UDRP as it is essentially a claim for trademark and copyright infringement.

a) Identity or confusing similarity of the disputed domain names to the Complainant's trademarks

The Respondent does not contend that the Complainant has good standing in this proceeding under Para. 4(a) (i) of the Policy.

b) Lack of rights or legitimate interests

The Complainant failed to meet its burden of proof under Para. 4(a)(ii) of the Policy as it merely filed a perfunctory complaint that the Respondent lacks rights or legitimate interests because it provides marketing/advertising opportunities to its business clients.

The Respondent admits that it is also providing marketing opportunities to its business clients, but stresses that its business resolves around offering pinpointed fora for visitors to meet, compare notes, and talk to like-minded consumers about their products. The Respondent operates through a business model of creating a social network of forum websites. The Complainant has not offered prima facie showing that this business model is unlawful, targets or invades the Complainant's rights.

The Respondent is using the disputed domain names in connection with a bona fide offering of services as the Complainant's trademarks were incorporated in the disputed domain names only as descriptive identifiers. The addition of the generic words "club", "world" and "talk" functionally identify the domain names as social platforms distinct from the trademarks distinct names that visitors identify exclusively with the Respondent.

The Respondent began offering its services since many years before notice of any dispute and the Complainant was well-

aware of the Respondent's activity as it purchased advertisements from the disputed websites, without ever questioning the Respondent's lawful rights to the registration of the domain names and its business model. Thus, according to the Respondent, the Complainant should be deemed to have abandoned its claim under the doctrine of laches.

c) Registration and use in bad faith

The Respondent points out that the Complainant does not identify which of the four factual circumstances under Para. 4(b) of the Policy supports a claim of registration and use in bad faith. According to the Respondent, this is due to the fact that the Complainant is confusing trademark infringement with cybersquatting.

In the absence of any clarification from the Complainant, the Respondent presumes that the Complainant is asserting bad faith registration and use of the disputed domain names under Para. 4(b)(iv) of the Policy. In this instance, the Respondent stresses that the Complainant failed to prove the existence of "a likelihood of confusion with the complainant's mark[s] as to the source, sponsorship, affiliation or endorsement of [Respondent's] website[s]". The visitors of the relevant websites are not deceived or misled into believing that these are official websites of the Complainant. The activity performed through these websites is unlike any activity performed by the Complainant and there is no proof that the domain names were registered and are being used in bad faith. The Complainant only made generic bad faith assertions, which, by themselves, are insufficient to conclude registration and use of the disputed domain names in bad faith.

The inclusion of the Complainant's trademarks in the disputed domain names and use of them to direct visitors to the relevant forum websites amounts to a nominative fair use, according to the main UDRP jurisprudence deriving from the Kittinger and Oki Data cases. Both these cases and the many others stemming therefrom, stand for the proposition that incorporating trademarks in a domain name is not prima facie evidence of bad faith. Several panels have held that the truthful, nominative, fair use of a trademark in connection with the sale of goods and services that are properly identified by the trademark does not constitute bad faith. The same consideration should apply to the Respondent's fora, where the incorporation of the Complainant's trademarks is legitimate as the Respondent is truthful in identifying, and therefore describing, the services it provides.

As a further defence, the Respondent submits that the Complainant acquiesced to the registration and use of the disputed domain names, and that the Complainant's assertion that it only recently became aware of the disputed domain names is false. Indeed, the Complainant failed to disclose that at least since 2013, it purchased advertising from the relevant websites and most likely had knowledge of the Respondent's business model since before that year. Under these circumstances, the Complainant's failure to take any action in relation of the disputed domain names should be considered a consent to their registration and use giving a rise of rights or legitimate interests, and rejection of the claim of registration and use in bad faith.

As to the disclaimer, the Respondent points out that it decided to include it after receiving the Respondent's warning letter, although it thought that it was not necessary. In fact, there has never been any issue of confusion among consumers as to the “source, sponsorship, affiliation, or endorsement” of the Respondent's websites. The Complainant's ownership information is clearly displayed as a recurring footer on the bottom of each webpage of the domain names at issue, as well as in the “About us”, "Terms of Use", "Privacy Policy", "Help" and "Contact Us" sections located on the footer of each page of the domain names at issue. The Respondent has never received, and does not expect to receive any complaints or comments from users that associate the Complainant with the Respondent's online communities. The Respondent is aware of the fact that disclaimers cannot by themselves cure bad faith, when bad faith has been established by other factors, but disclaimers have sometimes been found to support other factors indicating good faith and legitimate interest, especially if they are sufficiently clear and prominent.

d) Reverse Domain Name Hijacking

The Respondent asks the Panel to declare that the subject Complaint has been brought in bad faith and therefore to sanction the Complainant under Para. 15(e) of the Rules. In this regard, the Respondent argues that the Complainant essentially filed a perfunctory complaint without establishing the Respondent's lack of rights or legitimate interests in the

disputed domain names, or that the domain names were registered and have been used in bad faith. The Complainant did not object to the registration and use of the disputed domain names for more than two decades but acquiesced to the Respondent's activities through its continuing business relations. Only now, a Complaint has been filed, but it falls outside the scope of the UDRP, as it not based on a cybersquatting, but on a trademark/copyright infringement claim. In the Respondent's view, the real purpose that is behind the filing of the UDRP is that the Complainant has an interest in using the disputed domain names for its own activities. This belief is further supported by a statement to that effect contained in the Complaint. Therefore, the Respondent maintains that the Complainant is using the Policy to wrest the disputed domain names despite being aware of the fact that it is not entitled to these names.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to trademarks or service marks 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 names (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 names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

Both the Complainant and the Respondent have submitted unsolicited supplemental filings. Para. 10 of the Rules vests the Panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition. Para. 12 of the Rules provides that it is for the Panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case. Accordingly, unsolicited supplemental filings are usually discouraged unless in exceptional circumstances, and when their contents are material to the decision of the case.

The Panel notes that the Complainant’s supplemental filing is only a reply to the Respondent's statements. However, under the Rules, each Party has the right to submit only one single pleading. Most of the statements included in the supplemental filing could have been addressed already in the Complaint. With respect to the reverse domain name hijacking claim, it is up to the Panel to decide based on the elements at hand without need for the Complainant to reply to the Respondent’s statements. In relation to the fact that the Complainant was not aware of the existence of the disputed domain names before the dispute arose, and to the consequent fact that the Complainant did not acquiesced to the registration and use of the disputed domain names, the Panel is of the opinion that this additional clarification is not essential to take a decision on this case, for the reasons further discussed below.

In view of the foregoing, the Panel decides to disregard the Complainant supplemental filing.

Also the Respondent’s supplemental filing is merely a reply to the Complainant’s late submissions. Therefore, for the same reasons mentioned above and in line with its duty to ensure that the parties are treated with equality, the Complainant will also not take into account the Respondent’s supplemental filing.

In addition to the above, the Panel noted that the remedy sought for the disputed domain names was revocation. As revocation is not among the available remedies under a UDRP proceeding, the Panel issued a procedural order requesting the Complainant to indicate, for each of the disputed domain names, what was the required remedy. The Complainant clarified that it was seeking the cancellation of all the disputed domain names.

PRINCIPAL REASONS FOR THE DECISION

The Respondent has raised several issues that the Panel must evaluate before discussing the three conditions set forth by

Para. 4(a) of the Policy.

1. Termination of proceeding

The first order of business is to address Respondent's argument that this Panel should dismiss the case on the basis of the fact that the Complainant's claim falls outside the scope of this UDRP as it is essentially a claim for trademark and copyright infringement rather than for cybersquatting.

The Panel does not find appropriate to terminate the proceeding. In registering the disputed domain names, the Respondent is bound by the Policy and the Rules. Para. 4(a) of the Policy requires a respondent to submit to the present proceeding each time a complainant asserts to the applicable Provider that a domain name (i) 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. Para. 18(a) of the Rules provides that "[i]n the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision".

In the instant case, the Complainant has asserted the existence of the three conditions set forth by Para. 4(a) of the Policy and, to the best of the Panel's knowledge, none of the parties has initiated a legal proceeding in respect of the disputed domain names. Thus, there are no reasons under both the Policy and the Rules to dismiss the case without evaluating its merits.

2. Acquiescence

A further argument of the Respondent is the fact that the Complainant has acquiesced to the registration and use of the disputed domain names, being aware of their existence since at least 2013, when the Complainant started purchasing advertisements from the Respondent. As the Respondent uses the Complainant's lack of action as a further defence in support of its legitimate use and good faith in the disputed domain names, the Panel feels appropriate to examine this issue in advance to the evaluation of the single requirements set forth by Para. 4(a) of the Policy.

First of all, the Panel notes that the disputed domain name <vwtalk.com> was registered on 18 October 2019, thus a little bit more than 1.5 years before the filing of the Complaint (and less than 1 year and three months before the Complainant's cease and desist letter dated 3 March 2020). In the Panel's view, the period that has incurred from the registration of the domain name <vwtalk.com> to the Complainant's objection is too short to maintain that the Complainant has tolerated its registration and use.

With respect to the domain names <passatworld.com> and <clubtouareg.com> for which a longer period has passed, Para. 4.17 of the WIPO Jurisprudential Overview 3.0 states that "[p]anels have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits. Panels have noted that the UDRP remedy is injunctive rather than compensatory, and that a principal concern is to halt ongoing or avoid future abuse/damage, not to provide equitable relief". The Panel sees no reason here to deviate from those cases.

The evidence provided does not appear univocally clear and sufficient to conclude that the Complainant was undoubtedly aware of the existence and use of the disputed domain name since at least 2013 and refrained from taking any action. The documents provided by the Respondent are internal documents elaborated by the Respondent and not corroborated by third parties' evidence. The majority of the Respondent's evidence consists in spreadsheets showing the amount of online advertising expenditures allegedly made by the Complainant. However, most of, if not all, the advertisement expenditures were not made directly by the Complainant, but through its dealers or advertising agencies. Furthermore, the expenditures for advertisements made on the disputed domain names <passatworld.com> and <clubtouareg.com> are very limited, and none is mentioned in connection with the disputed domain name <vwtalk.com>.

The evidence provided is difficult to read and understand and the scope of the UDRP proceeding does not extend to the evaluation of principles of trademark law “that require full analysis of the underlying facts” (Forum Decision No. FA0012000096318, Turbonetics, Inc. v Performance Techniques in relation to the domain name <turbonetics.com>).

It is therefore the Panel’s view that the determination of the possible effects of the Complainant’s alleged tolerance of the registration and use of the disputed domain name should be left exclusively to the Court (see WIPO Case No. D2009-1273, Richard “Cheech” Marin, Tommy Chong v. Traced, Inc. for the domain name <cheechandchong.com> and further decisions cited therein).

Having set out the above, the Panel will therefore proceed to make its determination.

3. Confusing similarity between the disputed domain names and the Complainant's trademarks

The Panel finds that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights. The Respondent has successfully proved to own registered trademark rights over the distinctive signs TOUAREG, PASSAT, VW, and ID. The domain names <passatworld.com> and <clubtouareg.com> incorporate the respective trademarks PASSAT and TOUAREG, while the domain name <vwidtalk.com> incorporates both trademarks VW and ID. All the domain names are followed by a generic term, such as "world", "club" and "talk". It is a generally accepted principle that whenever domain names incorporate the Complainant's trademark(s) entirely, confusing similarity should be deemed to exist. The generic terms added to the Complainant's trademarks cannot impair the confusing similarity of the disputed domain names with the Complainant's trademarks as they do not add any specification as to a different source of origin of the domain names.

Thus, the Panel is satisfied that the first condition under the Policy is met.

4. Rights and legitimate interests

According to Para. 4(c) of the Policy, a respondent can demonstrate its rights to or legitimate interests in a disputed domain name if:
- before receiving any notice of the dispute, the respondent was using the disputed domain name in connection with a bona fide offering of goods or services; or
- the respondent has been commonly known by the disputed domain name; or
- the respondent is making legitimate noncommercial or fair use of the domain name, without intention for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (see Para. 2.1. of the WIPO Jurisprudential Overview 3.0).

The Complainant argues that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names but uses them for its business activities. According to the Complainant, the Respondent's real scope behind the registration and use of the disputed domain names is to provide marketing opportunities to its business customers. Furthermore, the Complainant argues that the generic names added to the Complainant's trademarks to form the disputed domain names are not descriptive of a fan site or enthusiast forum and therefore the registration of the disputed domain names is illegitimate.

On the other side, the Respondent has provided evidence that the disputed domain names were in active use in connection with forum websites before there was any notice of the dispute. These websites allow people to meet and share their interests in the topics corresponding to the disputed domain names. Hence, the domain name <passatworld.com> leads to a forum website discussing the Complainant's Passat car model, the website associated with the domain name <clubtouareg.com> is aimed at discussing matters and exchanging views in relation to the Touareg car model, and the

domain name <vwidtalk.com> is used in connection with the new Complainant's ID electric vehicle car model. The generic terms added to the trademarks functionally identify the disputed domain names as social platforms distinct from the Complainant's official websites; they create descriptive and distinct names that visitors identify exclusively with the Respondent.

Although the Respondent does not deny that it also provides marketing and advertising opportunities for its business clients, it points out that its business resolves around making available for visitors specific forums to discuss about particular matters and products.

Notwithstanding the relevant domain names are not used in connection with a fan site, the Panel believes that there is little difference as to the way the use of domain names for forum websites should be treated when assessing the Respondent's rights or legitimate interests in a UDRP proceeding.

Para. 2.7 of the WIPO Jurisprudential Overview 3.0 addresses the question of when a fan site can be held to support respondent's rights or legitimate interests in a domain name. In particular, for purposes of assessing fair use under UDRP paragraph 4(c)(iii), "a respondent's fan site must be active, genuinely noncommercial, and clearly distinct from any official complainant site. Where, [like in the instant case], the domain name is not identical to the complainant's trademark, i.e., it comprises the mark plus an additional, typically descriptive or laudatory term, panels tend to find that the respondent has a legitimate interest in using the mark as part of the domain name if such use is considered to be fair in all of the circumstances of the case. Where such a site is noncommercial in nature, this would tend to support a finding that the use is a fair one. However, some panels have found in such cases that a limited degree of incidental commercial activity may be permissible in certain circumstances (e.g., to offset registration or hosting costs associated with the domain name and website)".

Bearing in mind the above, it is first necessary to evaluate whether the Respondent's websites are clearly distinct from any official Complainant's site. In this respect, it is worth clarifying that the Panel does not believe that the use of the disputed domain names is such as to prove that the Respondent is impersonating the Complainant, if "impersonation" is intended as the Respondent's fraudulent intent to appear as the Complainant before the relevant users. However, upon reviewing the website contents, the Panel cannot exclude that a visitor might believe that the disputed domain names lead to websites associated with the Complainant, or at least endorsed by the Complainant, for a number of reason:

- although the disputed domain names do not consist of the Complainant's trademarks alone (which is generally considered unacceptable), the generic terms added to the Complainant's trademarks do not unequivocally convey the idea that the domain names do not belong to the Complainant. Indeed, the terms "talk", "world" and "club" could very well be associated with one of the Complainant's official websites. The selection of these terms instead of others (such as "fan", "fanatic", "independent", "unofficial", "forum", or others more clearly manifesting the independent character of the relevant website from the trademark owner) could have better served the purpose (for a similar reasoning see WIPO Case No. D2007-0979, Xuxa Promoções Produções LTDA. vs. BlessHost Internet for the domain name <clickxuxa.com>);

- the trademarks PASSAT, TOUAREG and ID are displayed prominently on the top of the homepage next to a depiction of the relevant models of cars displaying the well-known "W" logo in the foreground. Even more so, in order to make sure that the ID trademark is the one referring to the Complainant and not to any other, the Respondent has found appropriate to also add the two letters "VW" to the trademark, univocally associated to the Complainant, being the acronym of "Volks" "Wagen" besides one of the Complainant's trademarks;

- the right side of the top home page of the relevant websites reads as follows: for <passatworld.com>: "Volkswagen Passat Forum Since 2000! Passatworld is a forum dedicated to Volkswagen Passat enthusiasts to discuss mods, Quattro, Turbo Diesel, reviews and more!"; for <clubtouareg.com>: "Club Touareg Forum Since 2000. We're the online community for Volkswagen Touareg owners to share knowledge about their VW Touareg Sport Utility Vehicles and more!"; for <vwid.com>: "Volkswagen ID Forum Since 2019. VWIDTalk.com – Release Date, Pricing and Reviews on the ID.4 and ID.3. Join the Volkswagen ID Series Forum, Community And Owner's Club". None of these statements appears sufficiently clear to exclude that the relevant websites are not associated with, or at least endorsed by, the Complainant;

- it is not until one scrolls down to the very end of the home page that the name of the Respondent finally appears, along with the disclaimer. Thus, the disclaimer is not prominently displayed, rather, it is written in small dimensions. Further information about the Respondent are included in the “About us”, Terms of Use”, “Privacy Policy” and “Contact Us”, but the links to these sections are also placed at the bottom of the home page and Internet visitors might decide not to open them. The Respondent added the disclaimer only after receiving the Complainant's warning letter, thus many years after the registration and beginning of use of the disputed domain names. Thus, the Panel considers it likely that the Respondent would not have added a disclaimer to the websites if the Complainant had not sent its warning letter. By way of confirmation, the website associated with the domain name <e46fanatics.com> belonging to the Respondent and used for a forum website on E46 BMW car model does not contain any disclaimer at the bottom of the page. Thus, the addition of the disclaimer in small dimensions and at the bottom of the home page of each of the three Respondent’s websites, although an appreciable effort to clarify to the Internet users the lack of association of these websites with the Complainant, cannot avoid an initial confusion of the disputed domain names with the Complainant’s trademarks.

In view of the foregoing, the Panel considers that the Respondent’s websites do not avoid at least an initial confusion on the part of the Internet users.

The second point for the Panel to ascertain is whether the Respondent's use of the disputed domain names is noncommercial in nature. The Respondent has admitted that the disputed domain names generate profits from the advertisements placed on the corresponding websites by its business customers. However, the Respondent maintains that this activity and consequent revenues are ancillary to the main purpose of the websites. The Complainant supports the opposite view.

The Panel has no access to the amount of income that the Respondent generated throughout the years by renting advertising spaces on its three websites. Nonetheless, from the attachments to the Response it clearly appears that advertising is an important source of income for the Respondent. The Respondent is actively promoting its advertising services on its official website at www.verticalscope.com through claims such as (referring to its outdoor sites): “Now you can reach one of the largest online outdoor audiences on one platform. Our flagship All outdoor content site and over 200 community sites are home to passionate outdoor enthusiasts who share their experiences, discuss gear and research product purchases on everything from fishing, to hunting to camping and more. Advertising in our unique family-oriented social environment delivers better results for manufacturers, retailers and regional-based sponsors than any other medium. Our expert marketing consultants will help you create deeper relationships with customers by building new levels of engagement and loyalty”.

In reviewing the Respondent’s websites, the Panel has noticed that while the participation in the forum is generally free of charge, the Respondent also offers premium membership upon payment of a subscription fee (see the FAQ sections of the websites). More details on the premium membership price and services offered is not available unless by registering on the website. Previous Panels have found that websites that offer both free and paid memberships are to be considered “commercial” (see WIPO Case No. D2015-0589, Bayerische Motoren Werke Aktiengesellschaft, Rolls-Royce Motor Cars Limited v. Mr David Redshaw, Auto Crowd, Auto Crowd Group / MEDIAGROUP24/ WhoisGuard Protected / WhoisGuard, Inc. for the domain name <bmwenthusiastsclub.com>, <bmwmotorcycle.club>, <bmwowners.club>, <minienthusiastsclub.com>, <miniowners.club>, <miniownersclub.net>, <rollsroyceenthusiastsclub.com>, <rollsroyceowners.club>) stating the following: “In the Panel’s view, the commercial activity on the Websites is more than “incidental”. First, some of the Websites offer paid as well as free membership; in the Panel’s view that renders those sites “commercial” and it makes no difference that those sites also allow more limited free access or that only a relatively small proportion of the members of those sites are paid subscribers”.

Finally, the Panel has also noticed that the websites contain Google sponsored advertisements. Most probably, the Respondent generates an income from any click on these advertisements through the Google AdSense service. The Panel is aware of the fact that previous UDRP decisions have often stated that the placement of Google advertisements on a fan site does not affect the legitimate use of a complainant’s trademark (see among others WIPO Case No. D2013-0578, Samsung Electronics Co., Ltd. v. Kunal Gangar, in relation to the domain name <samsunghub.com>). However, in the instant case, the

Respondent's income arising from the websites associated with the disputed domain names is not limited to the Google sponsored advertisements, but includes the rental of advertisement spaces to any interested third party (potentially including Complainant's competitors; see the bad faith section below), and the payment of a fee to become a premium member of the website community. This commercial use of the disputed domain names cannot be considered limited in nature and auxiliary to the primary nature of the Respondent's websites.

In light of the foregoing, the Panel finds that the Complainant has succeeded in proving at least a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names and the Respondent has not been able to rebut the Complainant's allegations.

5. Bad faith

Under Para. 4(a)(iii) of the Policy, the Complainant must prove that the Respondent registered and used the disputed domain names in bad faith.

There is no question that at the time of the registration of the disputed domain names, the Respondent was well aware of the Complainant's trademarks. The Respondent registered domain names containing the Complainant's trademarks precisely because they were attractive and served their business, which is, as mentioned in the Respondent's website, to "build highly targeted, successful online communities and websites", through irreplaceable "domain names to attract hundreds of thousands of enthusiasts arriving at the [Respondent's] network every month through direct navigation".
The Respondent maintains that the registration of the disputed domain names is legitimate as it amounts to nominative fair use. The inclusion of the Complainant's trademarks within the disputed domain names was necessary to convey to the Internet users information about the contents of the websites.

As mentioned under the rights and legitimate interest section above, fair use of a third party's trademark is excluded when, like in the instant case, Internet users can be misled as to the origin of the Respondent's websites, or their possible endorsement or sponsorship by the Complainant. A disclaimer may serve to exclude a likelihood of confusion, but in the instant case, because it is placed at the very bottom of the home page and in small characters, it cannot offset at least an initial risk of confusion.

Furthermore, the disclaimer was added to the websites only after the Respondent received the Complainant's cease and desist letter. It may be presumed that the many other Respondent's websites do not contain disclaimers as well. This fact should also be considered when assessing bad faith (see WIPO Case No. D2009-1273, Richard "Cheech" Marin, Tommy Chong v. Traced, Inc., for the domain name <cheechandchong.com>).

Furthermore, in the case of forum websites, likewise in the case of fan sites, fair use is also excluded when domain names are used for a commercial purpose that is not merely ancillary to the fan/forum of discussion purpose (see among others WIPO Case No. D2007-0979, cited above). In the instant case, the Panel has found that the disputed domain names are used for a commercial purpose that cannot be considered minimal, as the Respondent earns income from three different sources, third parties' advertisements, Google sponsored ads and subscription fees from premium members. Lastly, Annex 14 to the Response shows that even competitors can advertise their products on websites referring to other car manufacturers. In particular, the Complainant has published an advertisement on a Respondent's website relating to a BMW's car model. The Panel infers that the same could happen (or might have already happened) for the websites corresponding to the disputed domain names. This assumption is supported by the fact that it does not seem that the advertisement services offered by the Respondent for the three websites corresponding to the disputed domain names are only addressed to the relevant car manufacturer, namely the Complainant. The use of a domain name in the context of a fan site to also advertise competing goods has been considered by other Panels to be in bad faith (see WIPO Case No. D2010-0262, General Motors LLC v. Pedro Cachinho, for the domain name <chevroletportugal.com>.

For all the reasons set forth above, the Panel concludes that the disputed domain names were registered and used in bad faith, under Para. 4(b)(iv) of the Policy.

6. Reverse Domain Name Hijacking

The Respondent has asked the Panel to declare that the Complaint was filed in bad faith and constitutes an abuse of the UDRP proceeding under Para. 15(e) of the Policy. As the Complainant is the successful party of this proceeding, there is obviously no ground to consider that the Complaint was brought in bad faith. Thus, the Respondent's request is rejected.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **VWIDTALK.COM**:
2. **PASSATWORLD.COM**:
3. **CLUBTOUAREG.COM**:

PANELLISTS

Name	**Angelica Lodigiani, Nathalie Dreyfus, Douglas M. Isenberg**

DATE OF PANEL DECISION 2020-08-12

Publish the Decision