

## Decision for dispute CAC-UDRP-104015

Case number CAC-UDRP-104015

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Time of filing 2021-09-16 11:43:37

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Domain names SBKRACING.COM

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### Case administrator

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

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### Complainant

Organization DORNA WSBK ORGANIZATION Srl

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### Complainant representative

Organization De Simone & Partners Srl

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### Respondent

Name Chien Lung Lee

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#### OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

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#### IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks including the term "SBK" registered in the EU, Taiwan and United States, such as EU trademarks no. 4615936, 5758404, 10341915, 10391977, 10392033, 10392074, 10392141, 10441624, 11220977, 11221249, 17993084, Taiwanese trademarks no. 01605640, 01862881 and US trademarks 3476636, 3856880, 4212017, 4273907, 4290640, 4290649, 4329886, 4838976 ("Complainant's Trademarks").

The disputed domain name <sbkracing.com> was registered on 30 October 2020.

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#### FACTUAL BACKGROUND

As the Respondent did not file any response to the Complaint, the Panel took into account the following facts asserted by the Complainant (and supported by the documentary evidence submitted by the Complainant) and unchallenged by the Respondent:

(a) The Complainant is the organizer of world famous motorcycle racing events known as Superbike World Championship or SBK which are advertised under the domain name <worldsbk.com>. Under such domain name, motorcycle clothing and

accessories branded by the SBK logo with the characteristic chevron are also sold.

(b) The Complainant is the owner of Complainant's Trademarks.

(c) The Respondent is using the disputed domain name to sell motorbike accessories and clothing. Such products are marked by a sign very similar to the Complainant's SBK logo with the characteristic chevron, without authorization of the Complainant.

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#### PARTIES CONTENTIONS

##### PARTIES' CONTENTIONS:

##### COMPLAINANT:

In addition to the above factual assertions, the Complainant also contends the following:

(a) The disputed domain name is confusingly similar to Complainant's Trademarks as it contains the distinctive element "SBK" with adding a descriptive term "racing" which is not sufficient to exclude the likelihood of confusion between the disputed domain name and Complainant's Trademarks.

(b) The Respondent has not been authorized or licensed to use Complainant's Trademarks neither it is known by the name SBK Racing or SBK. Therefore, the Respondent has no legitimate interest in the disputed domain name.

(c) When registering the disputed domain name, the Respondent must have been aware of the Complainant's well-known business and reputation of Complainant's Trademarks. At the Respondent web site there are motorbikes, moto clothing with sponsors known in the SBK Superbike Motor Championship and there are products sold under the imitation of SBK brand for which the Respondent has no authorization. Therefore, the Respondent registered and has been using the disputed domain name in bad faith.

##### RESPONDENT:

The Respondent did not provide any response to the complaint.

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#### RIGHTS

The Panel concluded that the disputed domain name is confusingly similar to Complainant's Trademark within the meaning of paragraph 4(a)(i) of the Uniform Domain Name Dispute Resolution Policy ("UDRP" or "Policy").

For details, please see "Principal Reasons for the Decision".

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#### 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.

For details, please see "Principal Reasons for the Decision".

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#### 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.

For details, please see "Principal Reasons for the Decision".

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#### PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under the Policy were met and there is no other reason why it would be inappropriate to provide a decision.

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#### PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy requires that the complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or revoked:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in these proceedings.

#### RIGHTS

The disputed domain name is confusingly similar to Complainant's Trademarks as it includes the distinctive element of such trademarks (i.e. the denomination "SBK"). Addition of the descriptive term "racing" is not sufficient to diminish such confusing similarity.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the identity / confusing similarity test as it is a necessary technical requirement of registration.

Therefore, the Panel concludes that the Complainant satisfied the requirement under paragraph 4(a)(i) of the Policy.

#### NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (for example, WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

As asserted by the Complainant (and unchallenged by the Respondent), the Respondent is not commonly known by the disputed domain name. Neither is the Respondent in any way related to the Complainant. The Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

The Respondent is using the disputed domain name for sale of motorcycle clothing and accessories marked by logo which imitates Complainant's Trademarks. Such conduct constitutes prima facie trademark infringement, which in the opinion of the Panel excludes legitimate interest of the Respondent to the disputed domain name.

Therefore, the Panel concludes that the Respondent did not establish any right or legitimate interest to the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

#### BAD FAITH

The Panel fully agrees with the Complainant that the Respondent must have been aware of Complainant's Trademark and their reputation when registering the disputed domain name. It is clear that the intention of the Respondent is to parasitize on the reputation of Complainant's renowned SBK brand by selling motorcycle clothing and accessories marked by logo which

imitates Complainant's Trademarks without Complainant's authorization. Such conduct not only constitutes clear trademark infringement but also bad faith upon registration and use of the disputed domain name.

Therefore the Panel is convinced that 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.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SBKRACING.COM**: Transferred

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## PANELLISTS

Name	<b>Michal Matějka</b>
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DATE OF PANEL DECISION **2021-10-22**

Publish the Decision

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