

Decision for dispute CAC-UDRP-100378

Case number	CAC-UDRP-100378
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Time of filing	2012-02-15 15:02:33
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Domain names	SBK-WORLD.COM
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Case administrator

Name	Tereza Bartošková (Case admin)
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Complainant

Organization	Infront Motor Sports S.r.l.
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Complainant representative

Organization	desimone & partners
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Respondent

Organization	Transure Enterprise Ltd
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OTHER LEGAL PROCEEDINGS

There are no other legal proceedings the Panel is aware of which are pending or decided.

IDENTIFICATION OF RIGHTS

Complainant has shown, to the satisfaction of the Panel, that it is the owner of several International Registrations and Community Trademarks, validly registered and with a registration date prior to the registration date of the domain name, for SBK (word mark) WORLDSBK, WSBK and others.

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 and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the Supplemental Rules).

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 November 16, 2011. A true and correct copy of the WHOIS report and of the

domain name dispute policy that applies to the domain name in question is provided as Encl.8 to this Complaint.

Factual and Legal Grounds

(Policy, paras. 4(a), (b), (c); Rules, para. 3)

This Complaint is based on the following grounds:

FACTUAL BACKGROUND AND EVIDENCE

The contested domain name is almost identical to the trademarks in which the Complainant has rights, in fact SBK-WORLD is almost identical and certainly confusingly similar to SBK (word mark) WORLDSBK, WSBK, and all the other SBK device marks. (Policy, Paragraph 4(a) (i); Rules, Paragraphs 3(b) (viii), (b) (ix) (1)).

World Superbike (World SBK, WSBK, or just SBK) has evolved exponentially since its inception in 1988 when the nascent series broke ground as a production-based motorcycle-racing program.

We would like to describe in few words the history of our Client's motorcycle championship using a paragraph taken from a famous web site www.ultimatemotorcycling.com in its chapter "The History of World Superbike":

The appeal of WSBK was the fact that teams were running production motorcycles (highly modified, but none the less production-based). Superbike racing 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 World Superbike 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 WSBK was on par with MotoGP in terms of fan loyalty and coverage. An important element embraced by World SBK was an atmosphere of access to its stars. Unlike MotoGP, fans were able to get close to their favorite riders.

In the 22 years since its inception, the World Superbike championship has had a major impact on the development and engineering of modern sport motorcycles. As manufacturers chased the increasingly significant WSBK crown-fast becoming a vital marketing tool-it drove rapid evolution in sport bike technology, with the consumer reaping the rewards.

By the end of the 90s every many superbike manufacturer was deeply involved with World SBK. Honda, Kawasaki, Yamaha, Suzuki, Ducati, Benelli, and Aprilia (and for a while Petronas) all had a major presence. A WSBK title sold a lot of motorcycles. In response, the manufacturers poured more backing into their race teams and the Superbike series continued to grow.

In 2004 the series adopted a controlled tire rule to ensure all of the teams were on equal equipment. Pirelli won the bid to be the exclusive supplier to the series. The controversial decision has since proven itself a wise move, creating closer racing and helping Pirelli to push development of their product, which is passed along to the products they sell to the public.

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.

This commercial great success was also supported and protected by a good coverage of trademark rights all over the world. The Complainant is the owner of several SBK registrations and applications (see Encl.1) in classes 41 for sport events, 12 for vehicles, 9 video and softwares etc... In particular we have submitted copy of the certificates of Registrations for SBK trademarks obtained at the European level; International registrations extended to US and Australia and other jurisdiction and Australian national registrations (see Encl.1 bis). Those registrations are in the name of the actual Complainant even though they were obtained by the former proprietors FGS Licence.

As stated FGS Licence was the original founder of the motor events called SBK and now the owners and users are the global company Infront Motor Sports. The Complainant and before them its predecessors have been running Superbike World

Championships called SBK for few decades (see Encl.2);

This motor sport event has become the true World Championship known to everybody as SBK world motor races.(Encl.3) .

This event is widely broadcast all over the world (Encl.3 bis)

On the contrary Transure Enterprise Ltd is a company based in the British Virgin Islands. They have been running a web site under the domain name www.SBK-world.com which is a mere web parking site with a specific theme mainly related to the motor sector. In this way they have been diverting web surfers interested in the superbike events from our Client's site to their web parking site gaining of course money back from Google or other search engine firms (Encl.4)

Above.com PTY Ltd is its Registrar. Neither Transure nor Above.com have ever been authorized to register use or adopt the trademark SBK in their business or domain names or trademarks therefore adopting SBK within the contested domain name has no legal justification.

For this reason on December 21, 2011, the Complainant sent a warning letter to the Respondent (or at least to the company that on the InternicWHOIS appeared to be the Registrant: Above.com) which was received by the appearing Registrant/Registrar on January 10 , 2012 however no reply was sent back to the sender (Encl.5).

LEGAL GROUNDS

1.About confusingly similarity between trademarks and the contested domain name

As for the applicable top level suffixes, namely “.biz”, “.info” and “.org”, there is consensus in that they are to be disregarded in the threshold assessment of risk of confusing similarity under the first element of the Policy. The addition of the gTLDs “.biz”, “.info” and “.org” is not of legal significance from the standpoint of comparing the disputed domain names to the trademark. Such use is required of domain name registrants and do not serve to identify a specific enterprise as a source of goods or services (WIPO Case No. D2001-0602, SBC Communications v. Fred Bell aka Bell Internet).

Thus, as the suffixes only indicate that the domain name are registered under the respective gTLD and are not distinctive, the Panel should find Respondent's domain names to be identical with Complainant's trademark “ARCELORMITTAL” (WIPO Case No. D2003-0598, MADRID 2012, S.A. v. Scott Martin-MadridMan Websites).

Therefore the comparison has to be made between SBK-WORLD on one side and SBK, WSBK, WORLD SBK , SBK SUPERBIKEWORLD CHAMPIONSHIP on the other. It is self evident that the trademark are confusingly similar and , actually, almost identical. The Complainant has also registered a series of SBK formative domain names (see Encl.6)

The risk of confusion is also increased by the fact that the Complainant's trademarks are well and widely known in the motor racing sector

2. The Respondent has no rights or legitimate interests in respect of the domain name (Policy, Paragraph 4 (a) (ii); Rules, Paragraph 3 (b) (ix) (2))

The Complainant claims that the Respondent has no right or legitimate interests in respect of the contested domain names.

Preliminarily, although the Complainant bears the ultimate burden of establishing all three elements of 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 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 has been used the domain names for anything but parking pages website. This effectively shifts the burden to the Respondent to demonstrate rights or legitimate interests in the domain names. Furthermore the Respondent is a provider that it is known under a different trade name and has no authorization or licence to use SBK

The Respondent is using the disputed domain names for pay-per-click parking pages, attracting as many Internet users as possible to its websites. The domain names are mere doors to other websites which have paid for advertisement and which in

many cases are not connected in any manner to the Complainant. When Internet users connect to the disputed domain names they are directed to parking pages showing advertising of different products and services, some of them being related to the motor sector. This is a definite diversion of potential Complainant's consumers and partners and cannot be considered a bona fide offering of goods and services.

Cac Case 100358 www.arcelormittal.biz

Previous UDRP panels have held that Respondent's use of a domain name, which incorporates a third party's trademark in connection with an Internet web site that merely lists links to third party web sites is not a bona fide offering of services and is not a legitimate non-commercial or fair use of the disputed domain name (WIPO Case No. D2007-1499, E.J. McKernan Co. v. Texas International Property Associates , WIPO Case No. D2010-1437, Lardi Ltd v. Belize Domain WHOIS Service Lt Inc ;, WIPO Case No. D2007-1415, Asian World of Martial Arts Inc. v. Texas International Property Associates)

To sum up, Respondent's use of the domain is in no way a bona fide offering of goods and services and this only emphasizes the fact that Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

The Respondent has no registered trademark rights in the word SBK "and there is no evidence at all that the Respondent is commonly known by the disputed domain name. On the contrary, as herein already mentioned, the Complainant has registered trademarks over SBK "and is commonly known as the owner and world organizer of SBK world motor championship

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 domain names have been registered and are being used in bad faith (Policy, paragraphs 4 (a) (iii), 4(b); Rules, paragraph 3 (b) (ix) (3))

The disputed domain names have been registered and are being used by the Respondent in bad faith.

As to bad faith registration, when registering the disputed domain names, the Respondent was necessary aware of the Complainant's well-known business and widespread reputation in its SBK trademarks And this is proved by the fact that the disputed domain name is used as a web parking in relation to motorbikes and similia..

Clearly, such maneuver would not have been generated if the Respondent did not know the Complainant's activities (WIPO Case D2010-1290, Meilleurtaux v. Domain Manager of Bondi Junction

Furthermore lack of reply to a soft warning letter (Encl.5) is also in this frame may be a proof of bad faith (see CAC case 100358 www.arcelormittal.biz)

This is a clear proof of registration in bad faith and the obvious envisaged goal is to divert Superbike aficionados from the Complainant's web site to the contested web parking.

As above stated the Complainant has amongst its trademarks a trademark called WORLDSBK used and registered which expressly refer to the worldwide nature of the famous motor racing Championship . The Respondent in bad faith has found out the contested domain name that was still free at the date of its registration but that is simply very similar to other domain names (see Encl.6) and other trademarks owned by the Complainant (see Encl.1). Also in Australia SBK is very popular (see Encl.7) and the Complainant has obtained registrations for their marks (see Encl.7bis)

Thus it is clear that the disputed domain names have been registered in order to prevent the owner of the trademark from reflecting the mark in the corresponding domain names and that such pattern results form a conscious policy on the part of the Respondent.

In the case at hand Respondent has intentionally sought to use Complainant's marks in the disputed domain names to attract

Internet users to websites and other on-line locations for commercial gain by confusing consumers as to sponsorship of the website. This constitutes bad faith within the meaning of paragraph 4(b)(iv) of the Policy. (WIPO Case No. D2000-1495, America Online, Inc. v. John Zuccarini, also known as Cupcake Message, Cupcake Messenger, The Cupcake Secret, Cupcake Patrol, Cupcake City, and The Cupcake Incident)

The Respondent has accepted the Above.com Policy (Encl.8) and, as Defendant has been involved in similar cases with the same pattern (see Encl.9) In several cases the Respondent was found in bad faith such as in the case D2011-1478 www.Impresasanpaoloimi.com, in case D2010-0426 for www.SANOFI-AVENTIS.com; D2010-1648 for www.LEGO-BILLIGER.com; D2008-0422 www.roche.com; D2008-1304 Flyingblue-online.com; D2009-1174 BancoSanPaolo.com; D2009-0660 Balenciaga.com and others all with the same final result: Domain Transferred or Cancelled (see Encl.9)

The domain name is so obviously 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 - WIPO Case No. D2000-0163, Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., net - , WIPO Case No. D2001-0781, Fortuneo v. Johann Guinebert)

Thus, the Respondent knowingly and intentionally attempted to divert the traffic intended for the Complainant's website to its own websites. Consequently, the Respondent has through the use of identical domain names, created a likelihood of confusion with the Complainant's prior rights, which constitutes a misrepresentation to the public who might think that the disputed domain name belongs or is connected to the Complainant (WIPO Case D2007-0424, Alstom v. Yulei)

In the light of the above the contested domain name should be assigned to the Complainant

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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 that the assertions in this Complaint are warranted under the Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully submitted,

MASSIMO CIMOLI

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PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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 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 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

1.

The Panel finds that the disputed domain name <sbk-world.com> is confusingly similar to the Complainant's registered trade marks SBK and WORLDSBK.

2.

a) The Panel finds that the Respondent has made no use of, or demonstrable preparations to use, of the domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain names, nor is commonly known under the disputed domain names.

b) In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

3.

a) The Complainant also proved that the Respondent deliberately registered and used the domain name that is confusingly similar to Complainant's marks to attract, for commercial gain, Internet users to its web sites, by creating a likelihood of confusion with Complainant's marks as to the source, sponsorship, affiliation or endorsement of its website and the services offered at such websites.

b) The Complainant has submitted evidence showing that the Respondent has been named as Respondent in over 70 domain name disputes. In most, if not all, of the disputes, the Respondent was found to have abusively registered the domain names concerned.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	Jose Checa
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DATE OF PANEL DECISION	2012-04-02
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Publish the Decision
