Decision for dispute CAC-UDRP-100385

Case number	CAC-UDRP-100385
Time of filing	2012-04-26 11:04:59
Domain names	SBK-INTERN.COM

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	INFRONT MOTOR SPORTS LICENCE S.r.l.

Complainant representative

Organization	desimone & partners

Respondent

Name	VICTOR LEE

OTHER LEGAL PROCEEDINGS

Not applicable

IDENTIFICATION OF RIGHTS

The rights of the Complainant were identified through formal submission of certification of registration of marks in various jurisdictions. The Complainant submitted a copy of the certificates of Registrations for SBK trademarks obtained at the European level; International registrations extended to US and other jurisdictions. Those registrations are in the name of the actual Complainant even though they were obtained by the former proprietors FGS Licence. The Complainant has also registered SBKINTERNATIONAL.COM as shown in the Domain name list.

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 October 08, 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.1 to this Complaint.

FACTUAL BACKGROUND AND EVIDENCE

World Superbike Championship 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 SBK 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 SBK was on par with Moto GP in terms of fan loyalty and coverage. An important element embraced by SBK was an atmosphere of access to its stars. Unlike Moto GP, 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 SBK 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 SBK. Honda, Kawasaki, Yamaha, Suzuki, Ducati, Benelli, and Aprilia (and for a while Petronas) all had a major presence. A SBK 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 product 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.2) in classes 41 for sport events but also in class 25 for SBK clothing, 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 other jurisdictions (see Encl.2 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 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.4).

SBK racing events and the relevant merchandising are truly international and in fact WSBK stands for WORLD SBK championship against many national Motor Races such as AMA in USA. Therefore SBK INTERN.com has a sense in relation to our Client's trademark because the customers of its products and services are really international (Encl 5). THe Complainant has also registered SBKINTERNATIONAL.COM as shown in the Domain name list (Encl.6)

On the contrary we do not have any information on the Respondent and we have carried out searches and investigations in

order to gain more information but we have found no VICTOR LEE in Nigeria. However we know, and it is proven, that the mail address registered in the GoDaddy WHOIS is insufficient or not in existence. Likewise the Technical contact and Administrative Contact's e-mail address: lordmaX007@YAHOO.COM is also inexistent as shown by the e-mail receipts herewith enclosed (Encl.7). Furthermore if one tries to call over the phone Victor Lee at the number provided by the Registrant: +234 0141900911 the operators replies that the number does not exist and to check and redial the correct number. So also the telephne number is fake.
All of this makes us to believe that all the contact details are not true and no one is behind those inexistent addresses.

In fact on March 6 , 2012, the Complainant sent a warning letter (see Encl.8) to the Respondent which was not received for (apparently) insufficient address (Encl.8 bis) Then we tried twice by a-mail and the enclosed receipts show that the Yahoo address is inexistent (Encl.8 ter).
As stated we also tried to call him over the phone but the number “does not Exist”.

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

The contested domain name is almost identical to the trademarks in which the Complainant has rights in fact in SBK-INTERN the most distinctive element is the prefix SBK which is almost identical and certainly confusingly similar to the Complainant’s trademarks SBK word marks and all the other SBK device marks. (Policy, Paragraph 4(a) (i); Rules, Paragraphs 3(b) (viii), (b) (ix) (1)).INTERN clearly stands for International and has a descriptive meaning.
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 see the “ARCELORMITTAL” case. (WIPO Case No. D2003-0598, MADRID 2012, S.A. v Scott Martin-Madrid Man Websites).
The Complainant has also registered a series of SBK formative domain names (see Encl.2 ter)

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 not been licensed or otherwise authorized to use any of the Complainant’s SBK 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).
The domain name is not active and no justification was given to the Complainant in order to the choice of the contested domain name.
Thje Respondent is not known to act under the name SBK so there is no reason for him to register SBK-INTERN except that one to divert the SBK supporters to his own site as soon as he starts open a web site.

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 name has been registered and is being used by the Respondent in bad faith.
As to bad faith registration, 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 .

The Respondent has not been used the domain name and no access is possible for the moment. It is a clear case of "passive holding".
Wipo consensus view on this matter is clearly indicated by in its Overview which states: "The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trademark, no response to the complaint having been filed, and the registrant's concealment of its identity. Panels may draw inferences about whether the domain name was used in bad faith given the circumstances surrounding registration, and vice versa.
Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>, Transfer
Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574, <jupiterscasino.com> inter alia, Transfer
Ladbroke Group Plc v. Sonoma International LDC, WIPO Case No. D2002-0131, <ladbrokespoker.com> inter alia, Transfer
Westdev Limited v. Private Data, WIPO Case No. D2007-1903, <numberone.com>, Transfer
Malayan Banking Berhad v. Beauty, Success & Truth International, WIPO Case No. D2008-1393, <maybank.com>, Transfer
Intel Corporation v. The Pentium Group, WIPO Case No. D2009-0273, <pentiumgroup.net>, Transfer

In one of similar cases decided by WIPO Arbitration Court :the Incipio Case, Decision D2011-0418 of May 10, 2011 the Panel stated that :
"The Panel finds that the Complainant's trade marks are sufficiently well known that the Respondent, most likely, acquired and registered the disputed domain name with knowledge of the trademarks and Complainant's reputation. The Panel refers to Asian World of Martial Arts Inc. v. Texas International Property Associates, WIPO Case No. D2007-1415 where the panel stated that "[i]t defies common sense to believe that Respondent coincidentally selected [the] precise domain [name] without any knowledge of Complainant and its […] Trademarks". (See also, F. Hoffmann-La Roche AG v. MFS Holdings, WIPO Case No. D2010-0307).
Even though the Respondent has not actively used the disputed domain name, the Panel is not excluded from making a finding of bad faith. As stated in Intel Corporation v. The Pentium Group, WIPO Case No. D2009-0273, "[i]t has long been generally held…that the passive holding of a domain name that incorporates a well known trademark, without obvious use for an Internet purpose, does not necessarily circumvent a finding that the domain name is in use within the requirements of paragraph 4(a)(iii) of the Policy". (See also, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).
In the case of passive use, a panel must examine all the circumstances of the case to determine whether a respondent is acting in bad faith and may draw inferences about whether the domain name was used in bad faith in light of the surrounding circumstances. Relevant circumstances include, whether the Complainant has a well-known trademark and concealment of the Respondent's identity, in conjunction with passive holding. (See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).
Further, the Panel in Intel Corporation v. The Pentium Group, WIPO Case No. D2009-0273 went so far as to state, "[t]he incorporation of a well-known trademark into a domain name by a registrant having no plausible explanation for doing so may be, in and of itself, an indication of bad faith". (See also Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., WIPO Case No. D2000-0163; General Electric Company v. CPIC NET and Hussain Syed, WIPO Case No. D2001-0087; Microsoft Corporation v. Montrose Corporation, WIPO Case No. D2000-1568).

Applying those principle to the case at issue we may state that SBK is quite famous and it is not necessary a full trademark search but just an ordinary Google or Yahoo search to understand that SBK is a famous trademark for sport events and for several merchandising goods and therefore it had been safe to avoid the registration of the contested domain name.
If we couple this circumstances with the fact that the respondent has conceived its identity and address we may easily establishes bad faith.

In the WIPO D2006-1558 of February 7 2007 in the case “SALLIEME.COM” the Panel stated that “Respondent has apparently provided incorrect and fictitious contact information to the registrar. Respondent claimed a French-sounding address on a non-existent street in a city which to the Panel’s knowledge does not exist in the United States of America, but which Respondent located in the United States of America. Respondent accompanied that address with a telephone number located in India. (Interestingly, Complainant evidently concluded that Respondent is resident in Namibia.”
In the Wipo case D2010-2074 of 30.1.2011 on www.buy-xenical.com the conclusions were quite enlightening and applicable to the present case:
"Notably, all of those circumstances are present in this case:
(i) The Complainant’s trademark has a strong reputation and is widely known, as evidenced by its substantial use in many countries,
(ii) The Respondent failed to respond to the Complaint;
(iii) The case file submitted by the Center, in particular, the WhoIs information and the registration verification reply provided by the Registrar indicate that the postal address provided by the Respondent with the Registrar are false (in the sense that they apparently refer to non-existent locations). Therefore, it appears that the Respondent purposefully used false contact information to conceal his true identity;
(iv) …
(v) Taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be unlawful.
For all the foregoing reasons, the Panel concludes that the disputed domain name was registered and is being used in bad faith. Accordingly, the third element of paragraph 4(a) of the UDRP has been satisfied."

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)
Failing to reply and providing contact information which are inadequate and considering the contested domain name bearing a well known and largely registered trademark we believe that the domain name was registered in bad faith

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,

Avv.MASSIMO CIMOLI
DE SIMONE & Partners

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

The contested domain name is almost identical to the trademarks in which the Complainant has rights. In SBK-INTERN the most distinctive element is the prefix SBK which is almost identical and certainly confusingly similar to the Complainant's trademarks SBK word marks and all the other SBK device marks. The Respondent is not known to act under the name SBK so there is no reason for him to register SBK-INTERN except to divert persons with a genuine interest in SBK to the respondent´s web site as soon as this would be activated. There is no evidence to suggest that the Respondent has any form of genuine link with the name SBK or SBK-INTERN and the Respondent has not used the domain name and no access is possible for the moment. It would therefore appear to be a case of "passive holding". On a balance of probability the Panel finds that the Complainant's trade marks are sufficiently well known and that the Respondent, most likely, acquired and registered the disputed domain name with knowledge of the trademarks and Complainant's reputation.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Joseph Cannataci**

DATE OF PANEL DECISION 2012-06-08

Publish the Decision