

Decision for dispute CAC-UDRP-100821

Case number	CAC-UDRP-100821
Time of filing	2014-07-01 12:48:00
Domain names	SBK-RACINGSCHOOL.COM

Case administrator

Name	Lada Válková (Case admin)
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Complainant

Organization	DORNA WSBK ORGANIZATION S.r.l.
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Complainant representative

Organization	desimone & partners
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Respondent

Organization	SPORT BEZ KONICA D.O.O.
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OTHER LEGAL PROCEEDINGS

The Complainant represents that there are no related legal proceedings.

IDENTIFICATION OF RIGHTS

The Complainant has shown rights in the SBK trademark, established prior to registration of the subject domain name, including services highly related to or identical to Respondent's commercial activity at the domain name.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant contends that the disputed domain name was registered on 11 September 2013.

The Complainant asserts that World Superbike Championship has evolved exponentially since its inception in 1988 when the nascent series broke ground as a production-based motorcycle-racing program. 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.

Moreover, according to the Complainant this commercial great success was also supported and protected by trademark rights all over the world. The Complainant is the owner of several SBK registrations and applications in classes 41 for motor sport events and for all the services comprised in this class but also in class 12 for motorbikes and vehicles in general their

accessories, parts and fittings and in class 9 for electronic games. In particular, the Complainant have submitted copy of the certificates of Registrations for SBK trademarks obtained at the European level.

The Complainant has produced evidence that it runs an official Riding School together with a well known Driving School called Corsetti Federal School. In this Course there are several specializations and one of them is the SBK Racing. Therefore the Complainant besides the trademark rights in class 41 for all the services there in comprised (also Driving Schools are comprised in this class) has been using the SBK trademark also in the market with the said association with Corsetti to organize and run the so called SBK Riding School with an evident risk of confusion with the Respondent's SRS Superbike Racing School that promote themselves on the internet as SBK Racing School.

The Complainant sent a transfer demand in May, 2014, but it has not been heeded by the Respondent.

The Complainant alleges that the disputed domain name is almost identical to the trademarks in which the Complainant has rights.

Furthermore, according to the Complainant the Respondent is trying to lead the consumers to think that SBK-RACINGSCHOOL is an authorized site linked to the SBK trademark owners that are the organizers of the famous motorcycle racing Worldwide events and electronic games related to the SBK racing events.

The Complainant draws a conclusion that the risk of confusion is also increased by the fact that the Complainant's trademarks are also registered and used in relation to class 41 services in which Driving School are comprised de fault. The Complainant has also been running an SBK Riding School in which one of the options is called SBK RACING.

The Complainant claims that the Respondent has no right or legitimate interests in respect of the contested domain name. The Complainant alleges that the Respondent's web site has been used the contested domain names to offer a motor Driving School called Escuela de Conducion de Moto SRS Superbike Racing School. The Respondent is using the disputed domain name attracting, especially among motorcycle enthusiasts, as many Internet users as possible to its websites. The domain name is a mere door to the website where the Respondent offers its own services identical to those comprised in the trademark SBK to the Complainant.

Moreover, the Complainant contends that when Internet users connect to the disputed domain name they are directed to other sites showing quasi identical signs for identical or similar goods. This is a definite diversion of potential Complainant's consumers and cannot be considered a bona fide offering of goods and services.

According to the Complainant 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. In fact the Respondent is called Tridart SL.

On the contrary, as herein already mentioned, the Complainant claims that it has been registering several SBK formative trademarks for many decades and is commonly known as the owner and world responsible for the SBK world motor championship.

The Complainant states that 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.

The Complainant claims that the disputed domain name has been registered and is being used by the Respondent in bad faith.

The Complainant draws a conclusion from the Respondent's reply that the Respondent was aware of the Complainant's web site and that the fact that racing school services were covered by Dorna's trademark on SBK. Indeed class 41 covers also driving school services. In any case racing school services are quite similar to racing events and to motor racing events which are the core business of the Complainant.

The Complainant contends that when registering the disputed domain name the Respondent was necessarily 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 tool to reach consumers interested in motorcycles and motor races and thus to take advantage of the reputed trademark SBK. The Respondent did not reply to the Complainant's warning letter and this attitude is invoked as in itself showing bad faith. According to the Complainant 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".

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 the SBK trademark and service mark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

The disputed domain name is confusingly similar to the Complainant's registered trademarks since it incorporates the Complainant's "SBK" mark, merely (i) adding generic term "Racing School", and (ii) adding the generic top level domain identifier ".com" at the end. The addition of such a generic term as "Racing School" in this context does not distinguish the domain name from Complainant's mark.

NO RIGHTS OR LEGITIMATE INTERESTS

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 Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, or is making a legitimate non-commercial or fair use of the disputed domain names, or is commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent.

Therefore 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). It seems likely that the Respondent was aware of the Complainant's mark when it chose the Domain Name in 2013. It further appears that the Respondent attempts to use the goodwill in Complainant's mark to drive traffic to the Respondent's website and racing school. This violates 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 Respondent registered and uses a Domain Name that is confusingly similar to the Complainant's mark, not with any

legitimate interest in doing so, but in bad faith effort to attract people aware of the Complainant's mark to the Respondent's website and racing school.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SBK-RACINGSCHOOL.COM**: Transferred
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PANELLISTS

Name	Mike Rodenbaugh
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DATE OF PANEL DECISION **2014-07-30**

Publish the Decision
