Decision for dispute CAC-UDRP-100379

Case number	CAC-UDRP-100379
Time of filing	2015-09-08 13:49:39
Domain names	SBKSUPERBIKE.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	DORNA WSBK ORGANIZATION S.R.L.

Complainant representative

Organization	desimone & partners

Respondent

Organization	paginas acapulco

OTHER LEGAL PROCEEDINGS

The panel is not aware of any other legal proceedings related to the disputed domain name, which would be pending or decided.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several SBK trademarks and trademarks composed with "SBK", protected in class 41 for motor sport events and for all the services comprised in this class and also in class 12 for motorbikes and vehicles in general their accessories, parts and fittings. In particular it has submitted copy of the certificates of Registrations for SBK trademarks obtained in the USA and in other jurisdictions, including the international registration SBK No. 1285595, filed on January 2, 2012 in class 9 and protected in Mexico.

The Complainant is also the registrant of several domain names composed with “SBK”.

FACTUAL BACKGROUND

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

The Complainant organizes the World Superbike World Championship, called SBK, which is a production-based motorcycle-racing program created in 1988. It has evolved exponentially since its creation.

In the 22 years since its inception, the Superbike World championship has had a major impact on the development and engineering of modern sport motorcycles.

This commercial great success was also supported and protected by a good coverage of trademark rights all over the world. 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. This event is widely broadcast all over the world.

The disputed domain name <sbksuperbike.com> was registered on April 27, 2015. The Respondent seems to be a company that sells motorcycles and offers related repair services. The web site related to the domain name at issue is a web site in which the Respondent sells its goods and offers its services, all related to motorcycles.

On September 3, 2015, the Complainant sent a warning letter to the Respondent. The Respondent never replied.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

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

The Complainant asserts that the disputed domain name <sbksuperbike.com> is almost identical to the trademarks in which the Complainant has rights. The only distinctive element of the disputed domain name “SBKSUPERBIKE.COM” is the prefix “SBK” which is identical and certainly confusingly similar to the Complainant’s SBK word marks and all the other SBK device marks and to the Complainant’s domain names (Policy, Paragraph 4(a) (i); Rules, Paragraphs 3(b) (viii), (b) (ix) (1)).

The Complainant has also registered the trademark SBK SUPERBIKE WORLD CHAMPIONSHIP in USA and in the European Union.

The Complainant contends that the Respondent is trying to lead the consumers to think that SBKSUPERBIKE is an authorized site linked to the SBK trademark owners that are the organizators of the famous motorcycle racing Worldwide events and electronic games related to the SBK racing events.

The Complainant asserts that the suffix “.com” is not distinctive.

Therefore, the comparison has to be made between “SBKSUPERBIKE” on one side and the SBK, WSBK, WORLDSBK, SBK SUPERBIKE WORLD CHAMPIONSHIP trademarks on the other side. The Complainant contends that it is self-evident that the trademarks are confusingly similar and, actually, almost identical to the disputed domain name <sbksuperbike.com>.

The Complainant contends that the risk of confusion is also increased by the fact that the Complainant’s trademarks are registered and used in relation to electronic games concerning motorcycles.

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.

The Complainant considers 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, according to the Complainant, 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 disputed 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 Complainant contends that the Respondent's website at the disputed domain names is intended to diverse SBK supporters from the Complainant's website to this website in order to provide and sell their own goods and services connected to the motorcycle world.

According to the Complainant, the domain names are mere doors to the website where the Respondent offers other links to issues related to the same sectors in which the Complainant is famous and which are in competition to those of the Complainant and in any case, that can be easily linked to the famous SBK racing events.

The Complainant contends that this is a definite diversion of potential Complainant's consumers and cannot be considered a bona fide offering of goods and services.

The Complainant reminds that 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 – Annex 24, WIPO Case No. D2010-1437, Lardi Ltd v. Belize Domain WHOIS Service Lt Inc – Annex 25, WIPO Case No. D2007-1415, Asian World of Martial Arts Inc. v. Texas International Property Associates).

To sum up, the Complainant asserts that the Respondent's use of the disputed domain name <sbksuperbike.com> 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 <sbksuperbike.com>.

The Complainant asserts 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 <sbksuperbike.com>.

The Complainant reminds that on the contrary, as herein already mentioned, the Complainant has registered trademarks over SBK and is commonly known as the owner and world organizator of SBK world motor championship.

The Complainant contends 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 relies on previously decisions to affirm that, in similar circumstances, Panels considered that no bona fide or legitimate use of the disputed domain name could be claimed by the Respondent (notably the decision WIPO Case D2000-0055, Guerlain SA v. Peikang).

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 <sbksuperbike.com> was registered and is being used by the Respondent in bad faith.

The Complainant contends that 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 in the motor racing business and this is proved by the fact that the disputed domain name is used as a tool to reach consumers interested in motorcycles and thus to take advantage of the reputed trademark SBK especially amongst the young people.

According to the Complainant, 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).

The Complainant relies on several prior UDRP decisions concerning domain names composed with SBK that adjudicated a transfer of a disputed domain name.

The Complainant asserts that the Respondent did not respond to the Complainant's letter and also this attitude could be considered by the Panel in the finding of bad faith.

The disputed 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 - Annex 36, WIPO Case No. D2000-0163, Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., net - Annex 37, WIPO Case No. D2001-0781, Fortuneo v. Johann Guinebert).

RIGHTS

Many UDRP decisions have found that a disputed domain name is identical or confusingly similar to a complainant's trademark where the disputed domain name incorporates a complainant's trademark in its entirety.

The addition of the descriptive word "superbike" does not change this conclusion. 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 and confusing similarity tests as it is a necessary technical requirement of registration.

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

As set forth by Paragraph 4 (c) of the Policy, any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate the Respondent's rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to the Respondent of the dispute, its use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the Respondent, (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The trademarks of the Complainant predate by several years the registration date of the disputed domain name. In the opinion of the Panel, Complainant has made a prima facie case that the Respondent lacks rights or legitimate interest in the disputed domain name. The Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register the disputed domain name incorporating its marks. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark of the Complainant. The Respondent is not commonly known by the domain name nor has it acquired trademark rights. The Complainant has no relationship with the Respondent.

The Respondent did not reply to the warning letter sent by the Complainant. The Respondent did not submit any response and therefore did not contest the Complainant's position on his lack of any legitimate right or interest in the disputed domain name.

Under these circumstances, the Panel finds that the Complainant has shown that the Respondent has no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by an Administrative Panel to be evidence of the bad faith registration and use of a domain name. It provides that:

"For the purposes of Paragraph 4(a) (iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

The position of the Complainant on the market is well established. The Respondent must have been perfectly aware of the rights on the prior SBK trademarks when registering the disputed domain names.
The Panel finds that the disputed domain name has been registered and is being used in bad faith.

The Panel notes that there is an active website at the disputed domain name, promoting competing goods and services, without reproducing the SBK trademark in the content of the website.

The Respondent registered and used the disputed domain name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademarks of the Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, as per paragraph 4(b)(iv) of the Policy.

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 domain name is composed of the Complainant's trademark with the mere adjunction of a generic term in relation with the protection and the use of the Complaint's trademark. Therefore it is confusingly similar with the trademarks in which the

Complainant has rights.

The Respondent did not reply either to the warning letter, or to the complaint. It registered the disputed domain name to use it in order to divert the internet users to its own website and to profit from the traffic related to the Complainant's trademarks.

Therefore the Panel finds that the disputed domain name was registered without right or legitimate interests and was registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SBKSUPERBIKE.COM**: Transferred

PANELLISTS

Name	**Marie Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2015-10-23

Publish the Decision