Decision for dispute CAC-UDRP-101057

Case number	CAC-UDRP-101057
Time of filing	2015-09-22 12:47:16
Domain names	SBKGP.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	DORNA WSBK ORGANIZATION S.R.L.

Complainant representative

Organization	desimone & partners

Respondent

Organization	bkt

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainant states, and has provided evidence to support, that it is the owner of numerous trademark registrations worldwide for the mark SBK which predate registration of the disputed domain name (registered on 3 June 2015).

FACTUAL BACKGROUND

Complainant states, and has provided evidence to support, that it is the owner of numerous trademark registrations worldwide for the mark SBK, which is used to identify the World Superbike Championship, a motorcycle-racing program that was created in 1988. Complainant states that the World Superbike championship "has had a major impact on the development and engineering of modern sport motorcycles" and that ""[b]y the end of the 90s every main superbike manufacturer was deeply involved with SBK" (citing Honda, Kawasaki, Yamaha, Suzuki, Ducati, Benelli and Aprilia).

Complainant states that it sent, and has provided a copy of, "a warning letter" to Respondent but has not received a response thereto.

Complainant states that Respondent lost a previous decision under the UDRP, Dr. Ing. h.c. F. Porsche AG v. Takashi

Yamaguchi / Domain ID Shield Service CO., Limited, WIPO Case No. D2014-0071 (transfer of <porsche-spyder.com> and <918-spyder.com>).

Complainant states that "the disputed domain name is used as a tool to reach consumers interested in motorcycles and electronic games on motor races". However, Complainant did not provide any evidence of a website associated with the disputed domain name, and the Panel could not locate such a website. Further, the warning letter that was sent by Complainant to Respondent did not include any evidence of such a website.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

Complainant contends that the Disputed Domain Name is identical or confusingly similar to a mark in which Complainant has rights because Complainant has provided evidence of multiple trademark registrations owned by it that consist of or contain the letters "SBK" and because the letters "GP" "can stand for GRAN PRIX descriptive per se in relation to motor events but it might be taken as the abbreviation of MOTOGP Worldwide famous motor event run by the Complainant as well".

Complainant contends that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "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"; "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"; and "[w]hen Internet users connect to the disputed domain names [sic] they might be directed to other sites showing quasi identical signs for identical or similar goods".

Complainant contends that the Disputed Domain Name has been registered and is being used in bad faith because, inter alia, "when registering the disputed domain names [sic], 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 tool to reach consumers interested in motorcycles and electronic games on motor races and thus to take advantage of the reputed trademark SBK especially amongst the youths"; and Respondent did not reply to Complainant's warning letter.

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

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the SBK trademark. This is consistent with numerous previous decisions in cases filed by Complainant, including, most recently,

DORNA WSBK ORGANIZATION S.R.L. v. paginas acapulco, CAC Case No. 100379 (transfer of <sbksuperbike.com>).

As to whether the Disputed Domain Name is identical or confusingly similar to the SBK trademark, the relevant comparison to be made is with the second-level portion of the domain name only (i.e., “sbkgp”), as it is well-established that the Top-Level Domain (i.e., “.com”) may be disregarded for this purpose. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”), paragraph 1.2 (“The applicable top-level suffix in the domain name (e.g., ‘.com’) would usually be disregarded under the confusing similarity test (as it is a technical requirement of registration), except in certain cases where the applicable top-level suffix may itself form part of the relevant trademark.”).

It is obvious that the Disputed Domain Name contains both the SBK trademark in its entirety, plus the characters “gp”. Complainant has stated, and Respondent has not denied, that the letters "GP" are shorthand for "grand prix". The addition of the letters "gp" to the Disputed Domain Name “describe[] the products or services with which the trademark is ordinarily used” and, therefore, “may exacerbate or increase the likelihood of confusion”. Zions Bancorporation v. Ryan G Foo, PPA Media Services / Domain Admin, Whois Privacy Corp., WIPO Case No. D2014-2278.

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

Complainant has argued that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "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"; "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"; and "[w]hen Internet users connect to the disputed domain names [sic] they might be directed to other sites showing quasi identical signs for identical or similar goods".

Under the Policy, “a 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 burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP” WIPO Overview 2.0, paragraph 2.1.

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the Policy.

Complainant's arguments as to bad faith are not entirely supported by the record. For example, as noted above, Complainant refers to how the Disputed Domain Name is being used but provides no evidence of such use, either in the warning letter that was included as an annex or in any other annex included with the Complaint. And, the Panel was unable to identify any active website associated with the Disputed Domain Name. Further, the Panel notes that some of Complainant's arguments refer repeatedly to multiple "domain names" even though only one domain name is in dispute in this proceeding. As a result, the Panel questions whether some of Complainant's arguments are merely copied without review from previous complaints filed by Complainant.

Nevertheless, there is a well-established doctrine of "passive holding" under the UDRP that allows for a finding of bad faith even where a domain name is not actively being used. In the landmark case Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, the panel there considered the following factors in finding bad faith in a case of passive holding:

(i) the Complainant’s trademark has a strong reputation and is widely known, as evidenced by its substantial use in Australia and in other countries,

(ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name,

(iii) the Respondent has taken active steps to conceal its true identity, by operating under a name that is not a registered business name,

(iv) the Respondent has actively provided, and failed to correct, false contact details, in breach of its registration agreement, and

(v) taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

Here, based on the record, it appears that the SBK trademark has a strong reputation and is widely known in multiple countries; Respondent has provided no evidence of any actual or contemplated good faith use by it of the domain name; Respondent previously used a privacy service, which was cancelled by the Registrar only after the Complaint was filed; and certain communications to Respondent apparently were unsuccessfully delivered, indicating that Respondent may have provided false contact details.

As a result of the above, the Panel is convinced that the doctrine of passive holding merits a finding of bad faith in this case (even in the absence of such an argument by Complainant). Accordingly, the Panel finds that Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SBKGP.COM**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2015-10-29

Publish the Decision