Decision for dispute CAC-UDRP-101327

Case number	CAC-UDRP-101327
Time of filing	2016-10-27 09:30:20
Domain names	SBKBIKES.COM

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	DORNA WSBK ORGANIZATION S.R.L.

Complainant representative

Organization	desimone & partners

Respondent

Name	MADIS UUDAM

OTHER LEGAL PROCEEDINGS

N/A

IDENTIFICATION OF RIGHTS

The Complainant owns various EU trade mark registrations for the word mark SBK including EUTM 004615936 for the word mark SBK registered on 27 September 2005. It also owns numerous domain names incorporating its SBK mark, including <sbksuperbike.com>, <sbkworld.com>, <sbkgp.com>, <sbk.tv> and <sbkinfo.com>.

FACTUAL BACKGROUND

The Complainant owns and operates a production based motorcycle racing programme otherwise known as "World Superbike" or the SBK Championship. This programme has enjoyed great commercial success involving as it does all of the major superbike manufacturers. The programme has been operated by the Complainant or its predecessors for many years and since at least 2005 has become a globally televised and well known motor sport event.

The disputed domain name was registered on 27 March 2009. The disputed domain name resolves to a website for a motorcycle retailer based in Ireland named SBKBIKES.

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 Complainant has demonstrated that it owns a registered trade mark right for SBK under EUTM 004615936. The disputed domain name wholly incorporates the Complainant's trade mark together with the commonly used English word "bikes". The addition of this common or generic word in no way distinguishes the disputed domain name from the Complainant's mark and the Panel therefore finds that it the disputed domain name is confusingly similar to the Complainant's SBK mark and the Complaint succeeds under the first element of the Policy.

The Complainant has asserted that it has not authorised the Respondent's use of the disputed domain name and that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name. It maintains that the Respondent is using the disputed domain name in order to attract to its website as many Internet users as possible which is not bona fide conduct in view of the long established reputation attaching to the Complainant's SBK mark and the word wide reputation attaching to its motorcycle racing programme. The Panel finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name which has not been rebutted by the Respondent. Accordingly and also for the reasons set out below, the Complaint succeeds under the second element of the Policy.

The disputed domain name was originally registered in 2009 and the WHOIS record indicates updating in 2016. Although it is unclear how long the Respondent has owned and used the disputed domain name, even at the point of original creation of the disputed domain name in 2009 it is clear that the Complainant enjoyed considerable repute in connection with its SBK mark as a consequence, in particular, of the global television coverage of its motorcycle racing programme since at least 2005. As the Respondent is operating in exactly the same field of activity the Panel can only infer that he was well aware of the Complainant's motorcycle racing programme and SBK mark when it registered or acquired the disputed domain name. As a result the Panel infers that the disputed domain name was registered in bad faith.

The Respondent is using the disputed domain name to resolve to a website at which it is selling motorbikes and parts of many of the makes of motorbike that are involved in the Complainant's motorcycle racing programme. Under paragraph 4(b)(iv) of the Policy it is evidence of registration and use of a domain name in bad faith to attract Internet users intentionally for commercial gain to a website by creating confusion with the complainant's mark as to the source, sponsorship or affiliation of that website. This appears to be exactly what the Respondent is doing in this case by using the disputed domain name and also the SBK mark on its website aimed at motorcycle owners and purchasers. This view of the Respondent's bad faith is only reinforced by its failure to respond to the cease and desist letter sent by the Complainant's legal representatives prior to these proceedings. Accordingly the Panel finds that the disputed domain name was both registered and used in bad faith and the Complaint succeeds under 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. **SBKBIKES.COM**: Transferred

PANELLISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2016-12-21

Publish the Decision