

Decision for dispute CAC-UDRP-104982

Case number CAC-UDRP-104982

Time of filing 2022-11-16 16:30:16

Domain names SBKAPPAREL.COM

Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization Dorna WSBK Organization Srl

Complainant representative

Organization De Simone & Partners Srl

Respondent

Organization Contact Privacy Inc. Customer 0163809162

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following SBK registrations:

- CANADA Reg. TMA891149 for SBK (word) in classes 09, 14, 25, and 41 active from 20/05/11
- EUROPEAN UNION Reg. 005758404 for SBK (word) in classes 09, 14, 16, 18, 25, 28, 32, 33, 35, 36, 37, 38, 39, 40, 41, 42, and 43 active from May 27, 2005
- UNITED STATES 3476636 for SBK (word) in class 41 active from January 25, 2006
- EUROPEAN UNION Reg. 017993084 for SBK (word) in classes 09, 12, 14, 16, 1,8 21, 24, 2,5 26, 35, and 41 active from November 28, 2018
- INTERNATIONAL REGISTRATION 1006900 for SBK (word) in classes 09, 25, and 41 active from April 30, 2009
- EUROPEAN UNION Reg. 018214330 for SBK (word) in classes 03, 04, 09, 12, 14, 16, 18 21 24 25 28 32 33 34 35 36 41 active from March 24, 2020
- INTERNATIONAL REGISTRATION 1083094 for SBK (word) in classes 04 06 09 12 14 16, 25, 28, 32, 33, 34, 3,5 38, 40, and 41 active from March 30, 2011

FACTUAL BACKGROUND

The Complainant, Dorna WSBK Organization Srl, is the owner of the trademark SBK and has a worldwide presence. It states that SBK

is famous not only for the sport events associated with the trademark, consisting primarily of the worldwide motor racing event, but above all for its T-shirts, hats, jackets, glove, helmet glasses and many other products in relation to which Dorna has carried out strong merchandising projects.

The Complainant states that SBK has evolved exponentially since its inception in 1988 when the nascent sports series broke ground as production-based motorcycle-racing program. The appeal of the SBK Championship was the fact that the teams were running production motorcycles (highly modified, but none the less production-based). The SBK 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 SBK 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 event 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.

In the 22 years since its inception, the SBK Championship has also had a major impact on the development and engineering of modern sport motorcycles. By the end of the 90s every main superbike manufacturer was deeply involved with SBK Championship. Honda, Kawasaki, Yamaha, Suzuki, Ducati, Benelli and Aprilia (and for a while Petronas) all of whom had a major presence. In response, the manufactures poured more financial backing into their race teams and the Superbike series continued to grow.

In March of 2013 the Spanish Group DORNA, already owner of the MotoGP Championship, took over the SBK motor racing firm Infront. The new owner, the Complainant in this UDRP proceeding, is now called DORNA WSBK Organization S.r.l. In response, the manufactures poured more backing into their race teams and the Superbike series continued to grow.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant states that Respondent registered the disputed domain name <SBKAPPAREL.COM> on February 23, 2022 (the "Disputed Domain Name") and used it to offer SBK branded sport apparel. The Complainant states that more recently the web site linked to the Disputed Domain Name has become inactive.

The Complainant states that it is more than obvious that the domain name at issue is identical, or – at least – confusingly similar, to the Complainant's trademark SBK. It bases this on the fact that SBKAPPAREL.COM exactly reproduces its well-known trademark SBK. This is reinforced by the mere addition of the term "APPAREL", with obvious references to clothing and apparel products as offered by the Complainant to its customers. Just a simple search as SBK apparel leads to many pages and products of the Complainant.

RESPONDENT

The Respondent has not appeared or submitted a response in this proceeding. The Complainant also notes that Respondent is hiding its identity. The contact information is not correct and the Respondent appears to be hiding its identity behind a proxy.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed 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 Disputed 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 Disputed 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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (i) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- (ii) respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw from the record such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See *Talk City, Inc. v. Robertson*, D2000-0009 (WIPO February 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint."); *Vertical Solutions Mgmt., Inc. v. web net-marketing, inc.*, FA0006000095095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true).

Identical and/or Confusingly Similar

The Complainant claims rights in SBK as identified above in Section "Identification of Rights" in which it has provided the Panel with the evidence of such trademark registrations. The Panel notes that a national or as demonstrated here international trademark registrations are sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established its rights in the word mark SBK. See *Liberty Global Logistics, LLC v. damilola emmanuel / tovary services limited*, FA1707001738536 (Forum August 4, 2017) (stating, "Registration of a mark with the USPTO sufficiently establishes the required rights in the mark for purposes of the Policy.").

The Complainant must further demonstrate that the Disputed Domain Name is identical or confusingly similar to the mark in which it has a right. It contends that the Disputed Domain Name is confusingly similar to its mark by reason of the fact that it differs only in the addition of the word "apparel." As the addition merely spells out the nature of the goods Complainant offers to consumers it reinforces rather than detracts from the Complainant's rights.

The addition of a generic or descriptive term and a gTLD does not sufficiently distinguish a domain name from a mark under Policy 4(a)(i). See *Lacoste Alligator S.A. v. Priscilla, Ranessa, Angel, Jane, Victor, Olivier, Carl, Darren, Angela, Jonathan, Michell, Oiu, Matthew, Pamela, Selima, Angela, John, Sally, Susanna*, D2010-0988 (WIPO August 11, 2010) (<cheaperlacoste.com>).

Accordingly, the Complainant has demonstrated that the Disputed Domain Name is confusingly similar to a mark in which it has a right and thus it succeeds on the Paragraph 4(a)(i) element of the Policy.

Rights or legitimate interests

Having demonstrated its rights, Complainant must now demonstrate that Respondent lacks rights or legitimate interests in the Disputed Domain Name. Complainant has demonstrated that it did not authorize Respondent to register the Disputed Domain Name, that Respondent is not commonly known by the Disputed Domain Name, and that there is no demonstrated use of the Dispute Domain Name for noncommercial or fair use, indeed the opposite has been demonstrated.

The Panel accepts that Complainant's proof is prima facie evidence that Respondent lacks rights or legitimate interests in the Disputed Domain Name. Accordingly, the burden of production shifts to Respondent to show it does have rights or legitimate interests. See *Croatia Airlines d. d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455 (the 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 Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP). See also *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (Forum November 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii)).

Respondent has the opportunity to rebut this presumption that it lacks rights or legitimate interests in the Disputed Domain Name by demonstrating that it does. See *Deutsche Telekom AG v. Britt Cordon*, D2004-0487 (WIPO September 13, 2004) ("[O]nce a complainant establishes a prima facie case that none of the three circumstances establishing legitimate interests or rights applies, the burden of production on this factor shifts to the Respondent. The UDRP provides in Para. 4(c) three circumstances that if any one of which is present.").

These are

- (i) before any notice to you [respondent] of the dispute, your 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) you [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) you [respondent] are 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 Respondent has not appeared and there is no evidence to the contrary that rebuts the Complainant's prima facie case. Accordingly, the Panel concludes that the Complainant has succeeded on the Paragraph 4(a)(ii) element of the Policy.

Registration and Use in Bad faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

- (i) circumstances indicating that the respondent has registered or 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 the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

As with other cases targeting retailers, the Panel concludes that paragraphs 4(b)(ii), (iii) and (iv) of the Policy is made out. It bases this conclusion on the totality of evidence the Complainant has adduced to demonstrate the intention of Respondent to take advantage of the goodwill and reputation associated with the Complainant and its mark. The Complainant contends that registration of a domain name that is identical or confusingly similar to a famous or well-known mark resolving to a website purporting to offer goods in the name of the Complainant supports the conclusion that Respondent had actual knowledge of the Complainant: on its face it could not be otherwise. The Panel concurs also with the inference of actual notice due to the notoriety of the Complainant's mark and the manner of use of the disputed domain name and thus the Panel finds the bad faith registration of the disputed domain names.

The Complainant further argues that it is no coincidence that this speculation has involved a big sport event player. It also points out that the Complainant has already been party in other WIPO Cases where the Panelists ordered the transfer or the cancellation of the disputed domain names, detecting bad faith in the registrations. The Panel has reviewed these other cases and concurs with the Complainant's observations and the Panels decisions therein.

The Complainant further states that a) the trademark SBK is famous in the sport and casual clothing field; b) the Registrant has concealed its identity behind a Privacy Organisation; c) It did not reply to the Complainant's letter; d) the Registrant is not known under the name SBK or SBKAPPAREL.

In the light of the above, the second, third and final factors necessary for finding that the Respondent has engaged in abusive domain name registration and use have been established.

In regard to this proof, the Panel finds further that for the period the website was active the Respondent sought to pass itself off as the Complainant. Use of a disputed domain name to pass off as a complainant and offer competing or counterfeit versions of its products may be evidence of bad faith per Policy paragraph 4(b)(iii) and (iv). See *Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund*, FA1806001790949 (Forum July 9, 2018) (finding bad faith per Policy paragraphs 4(b)(iii) and (iv) where the respondent used the disputed domain name to resolve to a website upon which the respondent passes off as the complainant and offers online cryptocurrency services in direct competition with the complainant's business); see also *Guess? IP Holder L.P. and Guess?, Inc. v. LI FANGLIN*, FA1503001610067 (Forum April 25, 2015) (finding respondent registered and used the domain name in bad faith per Policy paragraph 4(b)(iii) because the respondent used the resolving website to sell the complainant's products, using images copied directly from the complainant's website); see also *Bittrex, Inc. v. Wuxi Yilian LLC*, FA1711001760517 (Forum December 27, 2017) (finding bad faith per Policy paragraph 4(b)(iv) where "Respondent registered and uses the <lbtirex.com> domain name in bad faith by directing Internet users to a website that mimics Complainant's own website in order to confuse users into believing that Respondent is Complainant, or is otherwise affiliated or associated with Complainant.").

In the light of the above, the second, third and final factors necessary for finding that the Respondent has engaged in abusive domain name registration and use have been established.

For all the reasons set forth above, the Panel concludes that the Respondent registered and used the Disputed Domain Name in bad

faith per Paragraph 4(b)(iii) and (iv) of the Policy. Accordingly, the Complainant succeeds on Paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SBKAPPAREL.COM**: Transferred
-

PANELLISTS

Name	Gerald Levine Ph.D, Esq.
------	---------------------------------

DATE OF PANEL DECISION **2022-12-21**

Publish the Decision
