

Decision for dispute CAC-UDRP-105387

Case number	CAC-UDRP-105387
Time of filing	2023-04-24 08:34:49
Domain names	harleydavidsonclothes.com, apparel-harleydavidson.com

Case administrator

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

Complainant

Organization	Harley-Davidson Motor Company Inc.
--------------	------------------------------------

Complainant representative

Organization	Stobbs IP Ltd
--------------	---------------

Respondent

Name	DUC TRAN THE DELTAVN
------	----------------------

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the registered proprietor of various trademarks and other intellectual property rights worldwide. The Complainant's trademarks including but not limited to the below trademark registration:

Trade Mark	Device	Register	Registration No.	Reg. Date.	Class(es)
HARLEY-DAVIDSON		UK	UK00901797018	21 March 2002	25, 39
HARLEY-DAVIDSON		UK	UK00915739352	15 March 2017	35, 37
MOTOR HARLEY-DAVIDSON CYCLES		UK	UK00901536309	19 November 2001	3, 7, 9, 12, 14, 16, 18, 25, 26, 28, 35, 36, 39,

					41
Bar & Shield		UK	UK00001341822	05 July 1991	25

In addition, the domain name <harley-davidson.com> was registered by the Complainant on 8 November 1994.

FACTUAL BACKGROUND

The Complainant is a subsidiary company of Harley-Davidson, Inc., an international motorcycle manufacturer providing leading worldwide manufacture, distribution, and sale of motorcycles, parts, and complementary goods and services thereof. Harley-Davidson, Inc. includes the subsidiary Harley-Davidson Motor Company Inc..

The Complainant's parent company has traded on the New York Stock Exchange since 5 November 1987 and as of 18 May 2021, has a market capitalisation value of \$7.9 billion.

The Complainant owns extensive rights in the HARLEY-DAVIDSON mark.

Complainant also owns several other HARLEY-DAVIDSON domain names.

The USA is the Complainant's domestic market and accounts for a significant portion of sales, with other key markets being DACH (Germany, Austria, and Switzerland), Japan, China, Canada, France, United Kingdom, Italy, Australia, and New Zealand. The Complainant has a significant reputation and has built up a vast amount of goodwill in the sign HARLEY-DAVIDSON in the US and abroad in relation to a wide range of goods and services.

The HARLEY-DAVIDSON brand has become iconic in popular culture in part due to the intensity, geographical extent, and long-standing use made of such marks, as evidenced by the high level of awareness of the Complainant's brand amongst consumers, as indicated by the consistent inclusion of Harley-Davidson within the Interbrand's "Top 100: Best Global Brands" report.

The Complainant states, that the Disputed Domain Names include the Complainants registered trademarks as the dominant element, along with non-distinctive terms, namely "clothes" and "apparel". The inclusion of non-distinctive terms which are either descriptive, generic, or geographic do nothing to alter the overall impression in the eyes of the average Internet user. Prior panels have consistently held that the addition of other terms does not avoid a finding of confusing similarity.

The non-distinctive terms reinforce in the view of Complainant the connection and are attempts to pass off as the Complainant. The Respondent makes extensive use of the Complainant's registered trademarks, including on the Websites and by advertising and offering to sell the infringing products.

The HARLEY-DAVIDSON mark is clearly recognisable as the dominate element within the Disputed Domain Names. Prior panels have made the same conclusions regarding the addition of descriptive and/or non-distinctive terms in paragraph 4(a)(i).

The Complainant requests that the Panel omit the TLD suffix '.com' when assessing the Disputed Domain Names, as it is merely a technical requirement, used for domain name registrations.

The Complainant submits that the Respondent does not have any rights or legitimate interests in the Disputed Domain Names.

The Complainant states that based on the considerable reputation of the HARLEY-DAVIDSON brand, there is no credible, believable, or realistic reason for registration or use of the Disputed Domain Names other than to take advantage of the Complainant's rights and brand reputation. The Disputed Domain Names were registered between 30 November and 2 December 2022. By this point, the Complainant already had rights (both registered and unregistered) in HARLEY-DAVIDSON.

The Complainant submits that the Respondent is using the Disputed Domain Names to resolve to "Infringing Websites" which offer for sale and/or advertise the sale of infringing products infringing various intellectual property rights held by the Complainant, including but not limited to the registered trademarks.

In the view of Complaint infringing websites impersonate/pass off as the Complainant, claiming to be official, licensed, or at a minimum affiliated with the Complainant. The websites include a copyright notice holding themselves out to be "Harley-Davidson Merch", to perpetrate the brand impersonation.

It is clear in the view of Complainant that the Respondent does not have a legitimate interest in the Disputed Domain Names. The Respondent's use of the Disputed Domain Names is merely to impersonate/pass off as the Complainant in order to sell Infringing Products, this shows that they are not using them in relation to a bona fide offering of goods or services. Consequently, the Respondent cannot claim a defence under the Policy, Paragraph 4(c)(i).

The Complainant submits further that the Disputed Domain Names have been registered and used in bad faith in accordance with Policy, Paragraph 4(a)(iii).

The registered trademarks for HARLEY-DAVIDSON pre-dates the registration of the Disputed Domain Names and HARLEY-DAVIDSON enjoys a wide reputation. Furthermore, Complainant states that the Respondent was unequivocally aware of the

HARLEY-DAVIDSON brand given the Respondent's significant use of the registered trademarks on the infringing websites, and that the infringing websites are set up to impersonate/pass off as the Complainant in order to sell infringing products. Therefore, the Complainant submits that the Respondent had knowledge of HARLEY-DAVIDSON and that the Disputed Domain Names are registered with the sole purpose of targeting the Complainant's registered trademarks.

The Complainant further submits that the Respondent has registered the Disputed Domain Names in bad faith by intentionally attempting to attract, for commercial gain, Internet users to the infringing websites, by creating a likelihood of confusion with the Complainant's registered trademarks as to the source, sponsorship, affiliation, or endorsement of the infringing websites under Policy, Paragraph 4(b)(iv).

The Respondent has in the view of the Complainant registered the Disputed Domain Names in order to drive Internet traffic to the websites in order to impersonate/pass off as the Complainant to sell infringing products.

Furthermore, the Complainant submits based on the Respondent's use of the HARLEY-DAVIDSON mark to sell infringing products, the Respondent had actual knowledge of the Complainant's rights in the HARLEY-DAVIDSON registered trademarks at the time of registering the Disputed Domain Names.

The Complainant further submits that the Respondent disrupts the Complainant's business by diverting potential customers to the infringing websites selling infringing products and competing goods. Using a confusingly similar domain name in a manner disruptive of a Complainant's business by trading upon the goodwill of a Complainant for the commercial gain evinces bad faith under paragraph 4(b)(iii) and (v) of the Policy.

The Complainant submits that the infringing products on the Websites are counterfeit and knockoff product infringing the various intellectual property rights owned by Complainant, including but not limited to the registered trademarks.

Based on the submissions above, the Complainant maintains that the Disputed Domain Names were registered and used in bad faith and all elements of the Policy are satisfied.

PARTIES CONTENTIONS

Complainant's contentions are summarised above.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 Names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Complainant filed a complaint against two domain names and submits that this should be allowed because all Disputed Domain Names are registered by the same domain-name holder.

The Panel agrees with that argument and allows to file a complaint against both Disputed Domain Names. Both Disputed Domain Names are clearly linked to each other.

The Panel is therefore satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

1. Identical or Confusingly Similar

The Panel acknowledges that the Complainant has established rights in the HARLEY DAVIDSON trademark.

Disregarding the gTLD “.com”, the Disputed Domain Names incorporate the trademark HARLEY DAVIDSON in its entirety.

The Panel further notes that the addition of the descriptive terms “Clothes”, or “Apparel” which relate directly to one of the Complainant’s field of business (merchandise), does not prevent a finding of confusing similarity.

The Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its rights in the HARLEY DAVIDSON trademark and in demonstrating that the Disputed Domain Names are confusingly similar to its trademark.

2. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, the complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a prima facie case is made, the respondent carries the burden of producing evidence in support of its rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See WIPO Overview 3.0, section 2.1.

The Complainant asserts that it has not authorized the Respondent to use its trademark, and there is no evidence to suggest that the Respondent has used, or undertaken any demonstrable preparations to use, the Disputed Domain Names in connection with a bona fide offering of goods or services.

Thus, the Complainant has established its prima facie case with satisfactory evidence.

The Respondent did not file a formal response and has therefore failed to assert factors or put forth evidence to establish that it enjoys rights or legitimate interests in the Disputed Domain Names. As such, the Panel concludes that the Respondent has failed to rebut the Complainant’s prima facie showing of the Respondent’s lack of rights or legitimate interests in the Disputed Domain Names, and that none of the circumstances of paragraph 4(c) of the Policy is applicable in this case.

As previously noted above, the Disputed Domain Names incorporate the Complainant’s trademark in its entirety with the additional term “clothes” or “apparel”, which is associated with the Complainant’s business. Such usage carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Names pursuant to paragraph 4(a)(ii) of the Policy.

3. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances in particular but without limitation shall be considered evidence of the registration and use of a domain name in bad faith:

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

(ii) circumstances indicating that the respondent registered the domain name to prevent the owner of the trade mark 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) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the respondent is using the domain name to intentionally attempt 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 its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances in which bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trademark of another party. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230.

The Panel believes that the Respondent's conduct in this case constitutes bad faith registration and use of the Disputed Domain Names within the meaning of paragraph 4(b)(i) of the Policy.

When the Respondent registered the Disputed Domain Names in 2022, the HARLEY DAVIDSON trademarks were already widely known and directly associated with the Complainant's activities.

Given the extensive prior use and fame of these marks, in the Panel's view, the Respondent should have been aware of the Complainant's trademark when registering the Disputed Domain Names.

The Respondent has provided no evidence to justify his registration of the Disputed Domain Names. Given the foregoing, it would be unreasonable to conclude that the Respondent, at the time of the registration of the Disputed Domain Names, was unaware of the Complainant's trademark, or that the Respondent's adoption of the uncommon and distinctive trademark HARLEY DAVIDSON was a mere coincidence.

The Complainant's registered trademark rights in HARLEY DAVIDSON for its signature products predate the registration date of the Disputed Domain Names by decades. A simple online search for the term "HARLEY DAVIDSON" would have revealed that it is a world-renowned brand.

The Panel is therefore of the view that the Respondent registered the Disputed Domain Names with full knowledge of the Complainant's trademark rights.

Furthermore, the Panel agrees with Complainant that the Respondent's use of the HARLEY-DAVIDSON mark to sell infringing products clearly shows, that the Respondent had actual knowledge of the Complainant's rights in the HARLEY-DAVIDSON registered trademarks at the time of registering the Disputed Domain Names. Actual knowledge of a complainant's rights in a mark prior to registering a confusingly similar domain name evinces bad faith under paragraph 4(a)(iii) of the Policy.

The Respondent moreover disrupts the Complainant's business by diverting potential customers to his websites selling infringing products and competing goods. Using a confusingly similar domain name in a manner disruptive of a Complainant's business by trading upon the goodwill of a Complainant for the commercial gain evinces bad faith under paragraph 4(b)(iii) and (v) of the Policy. The infringing products on the websites are counterfeit and knockoff products infringing the various intellectual property rights owned by Complainant, including but not limited to the registered trademarks.

Accordingly, the Panel finds that the Disputed Domain Names were registered and are being used in bad faith pursuant to 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. **harleydavidsonclothes.com**: Transferred
2. **apparel-harleydavidson.com**: Transferred

PANELLISTS

Name	Jan Schnedler
------	---------------

DATE OF PANEL DECISION 2023-05-19

Publish the Decision
