

Decision for dispute CAC-UDRP-105638

Case number	CAC-UDRP-105638
Time of filing	2023-07-20 09:06:24
Domain names	harleydavidsonsparepartsshop.com, harleydavidsonpartsandaccessories.com

Case administrator

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

Organization	Harley-Davidson Motor Company Inc.
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Complainant representative

Organization	Stobbs IP
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Respondent

Name	Abedghafari Emma
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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 owner of several trademarks for the name HARLEY-DAVIDSON, among which the following:

- United Kingdom device mark HARLEY-DAVIDSON, with reg. no. UK00000658028, with priority date from 9 April 1947, registered in class 12; and
- United Kingdom trademark HARLEY-DAVIDSON, with reg. no. UK00900083279, with priority date from 1 April 1996, registered in classes 21, 32, 35, 37, 41.

The first disputed domain name <harleydavidsonsparepartsshop.com> was registered on 13 January 2023 and resolves to a website which features the Complainant's trademarks and offers motorcycle parts and accessories for sale.

The second disputed domain name <harleydavidsonpartsandaccessories.com> was registered on 22 February 2023 and resolves currently to unactive webpage.

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. 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 and is owner of several other HARLEY-DAVIDSON domain names.

No information is known about the Respondent, named Abedghafari Emma, who, according to the Complainant registered both disputed domain names with false identification data.

PARTIES CONTENTIONS

COMPLAINANT' CONTENTIONS:

The Complainant requests that all the disputed domain names be transferred to the Complainant based on the following grounds:

Identical or confusingly similar

The Complainant states, that the disputed domain names include the Complainants registered trademarks as the dominant element, along with non-distinctive terms, namely "spare", "parts", "shop", and "accessories" which are either descriptive or generic and do nothing to alter the overall impression in the eyes of the average Internet user.

In fact, the non-distinctive terms reinforce in the view of Complainant the connection and are attempts of the Respondent of how to pass off as the Complainant.

Furthermore, 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.

No rights or legitimate interests

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 on 13 January 2023 and 2 February 2023, respectively, significantly post-dating the establishment of the HARLEY-DAVIDSON brand in 1903 as well as the Complainant's earlier rights in HARLEY-DAVIDSON.

The Complainant submits that the Respondent is using the disputed domain names to resolve to "Infringing Websites" giving the impression that they either are the Complainant or are in some way authorised or affiliated with them. For example, <https://harleydavidsonpartsandaccessories.com> includes a contact phone number of "+1 937 971 2585" and physical location "1213 Cincinnati Ave, Xenia, OH 45385, USA", which is in fact an official Harley-Davidson store.

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 which 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).

Registered and used in bad faith

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).

According to the Complainant, the registered trademarks significantly pre-date the registration of the disputed domain names and the Respondent must have been unequivocally aware of the HARLEY-DAVIDSON rights, given their repeated use of the registered on the infringing Websites to give the impression of a connection with the Complainant. Therefore, the Complainant reiterates that the disputed domain names were 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 registering them for the purpose of preventing the Complainant from reflecting the mark in a corresponding domain and point out that a Whois search indicates that the Respondent has registered 255 domains targeting various well-known brands. The Complainant thus concludes that the Respondent's conduct is classic 'cybersquatting'.

Moreover, the Complainant reiterates that the Registrant has also not registered the disputed domain names using accurate address details, which in view of the Complainant is one of the signs of bad faith registration.

Finally, the Complainant indicates that the Respondent has registered the disputed domain names to drive internet traffic to the Infringing Websites and, thereafter, to impersonate the Complainant or claim an affiliation.

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.

RESPONDENT'S CONTENTIONS:

The Respondent did not respond to the Complaint.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to trademarks 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 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 of the Rules states that the Panel decides a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law deemed applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under the Rules, the Panel draws such inferences therefrom as appropriate.

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant.

The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidence provided in support of them.

1. 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 "spare", "parts", "shop", and "accessories" which relate directly to one of the Complainant's fields of business, 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. 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.

In the present case, 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 respond to the complaint 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.

Furthermore, as previously noted above, the disputed domain names incorporate the Complainant's trademark in its entirety with the additional term "spare", "parts", "shop", and "accessories", 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. As to the bad faith registration and use of the disputed trademarks, the Panel finds 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 early in 2023, 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, and taking into consideration that registration of the disputed domain names was made with false data of the Respondent, 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 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.

With regard to the first disputed domain name <harleydavidsonsparepartsshop.com>, the Panel considers that the Respondent disrupts the Complainant's business by diverting potential customers to his websites selling 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.

With regard to the second disputed domain name <harleydavidsonpartsandaccessories.com> that resolves to unactive webpage, the Panel concludes that the non-use of such disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding considering the totality of the circumstances as described above.

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. **harleydavidsonsparepartsshop.com**: Transferred
2. **harleydavidsonpartsandaccessories.com**: Transferred

PANELLISTS

Name	Hana Císlarová
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DATE OF PANEL DECISION	2023-08-14
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Publish the Decision
