

Decision for dispute CAC-UDRP-105981

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| Case number | CAC-UDRP-105981 |
| Time of filing | 2023-11-21 10:30:28 |
| Domain names | harleydavidsonjackets.com |

Case administrator

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| Name | Olga Dvořáková (Case admin) |
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Complainant

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| Organization | Harley-Davidson Motor Company Inc. |
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Complainant representative

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| Organization | Stobbs IP |
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Respondent

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| Name | Hamza Ali |
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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 name.

IDENTIFICATION OF RIGHTS

The Complainant has evidenced to be the owner of numerous trademark registrations relating to its brand HARLEY-DAVIDSON, including, but not limited, to the following:

- Word mark HARLEY-DAVIDSON., United Kingdom Intellectual Property Office (UKIPO), registration No.: UK00000658028, registration date: April 9, 1947, status: active;
- Word mark HARLEY-DAVIDSON, UKIPO, registration No.: UK00001271222, registration date: September 30, 1988, status: active.

Also, the Complainant has substantiated to enjoy since 1994 rights in the domain name <harley-davidson.com> which resolves to the Complainant's main website at "www.harley-davidson.com", used to promote the Complainant's motorcycles and related goods and services internationally.

PARTIES CONTENTIONS

Complainant:

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred

to it.

Respondent:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

First, the Panel finds that the disputed domain name <harleydavidsonjackets.com>, which was created on March 19, 2021, is confusingly similar to the Complainant's HARLEY-DAVIDSON trademark, as it incorporates the latter in its entirety, simply added by the term "jackets". Numerous UDRP panels have recognized that incorporating a trademark in its entirety can be sufficient to establish that the disputed domain name is at least confusingly similar to a registered trademark. Moreover, it has also been held in many UDRP decisions and has meanwhile become a consensus view among UDRP panels that the mere addition of descriptive or other terms, such as e.g. the term "jackets", is not capable to dispel the confusing similarity arising from such entire incorporation of the Complainant's HARLEY-DAVIDSON trademark in the disputed domain name.

Therefore, the Complainant has established the first element under the Policy as set forth by paragraph 4(a)(i).

Second, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent has neither made use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services, nor is the Respondent commonly known under the disputed domain name, nor is the Respondent making a legitimate non-commercial or fair use of the disputed domain name without intent for commercial gain. On the contrary, the disputed domain name resolves to a website at "https://harleydavidsonjackets.com/", which offers motorcycle jackets for online sale, thereby prominently displaying the Complainant's HARLEY-DAVIDSON trademark and official logo without any authorization to do so; also, according to the Complainant's undisputed contentions, the offered jackets are counterfeit goods. UDRP panels, however, agree that using a domain name for illegal activity (e.g. the sale of counterfeit goods) cannot confer any rights or legitimate interests on the Respondent in the disputed domain name.

Accordingly, the Panel finds that the Complainant has also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

Third, the Panel holds that the disputed domain name was registered and is being used by the Respondent in bad faith. It is obvious from the circumstances to this case that the Respondent was well aware of the Complainant's rights in the HARLEY-DAVIDSON trademark when registering the disputed domain name, and that the latter is directly targeting such trademark. Moreover, carrying out illegal activities under the disputed domain name, which is confusingly similar to the Complainant's HARLEY-DAVIDSON trademark, by displaying on the Internet the Complainant's official HARLEY-DAVIDSON logo in the context of offering motorcycle jackets for online sale with no authorization by the Complainant to do so and which on top seem to be counterfeit products, leaves no doubts that the Respondent, by registering and making use of this disputed domain name, had the intention to unjustifiably profit from the undisputed reputation attached to the Complainant's HARLEY-DAVIDSON trademark, and that the Respondent intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with the Complainant's HARLEY-DAVIDSON

trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website. Such circumstances are evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

Therefore, the Complainant has also satisfied the third element under the Policy as set forth by paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **harleydavidsonjackets.com**: Transferred

PANELLISTS

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| Name | Stephanie Hartung |
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DATE OF PANEL DECISION 2023-12-20

Publish the Decision