

Decision for dispute CAC-UDRP-105987

Case number	CAC-UDRP-105987
Time of filing	2023-11-22 10:15:09
Domain names	harleymenshop.com, harleystyle.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Harley-Davidson Motor Company Inc.
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Complainant representative

Organization	Stobbs IP (Stobbs IP)
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Respondents

Name	Lenny DeMild
Name	James Weathers

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:

- (i) European word trademark "HARLEY", reg. no. 000083931, registered on 3 February 1999 for goods and services in classes 9, 12, 14, 25 and 26;
- (ii) Australian word trademark "HARLEY", reg. no. 869395, registered on 15 March 2001 for goods and services in classes 14 and 25;
- (iii) UK word trademark "HARLEY", reg. no. UK00002121230, registered on 11 September 1998 for goods and services in class 25;
- (iv) UK word trademark "HARLEY", reg. no. UK00900083931, registered on 3 February 1999 for goods and services in classes 9, 12, 14, 25 and 26; and
- (v) UK word trademark "HARLEY-DAVIDSON", reg. no. UK00901797018, registered on 21 March 2002 for goods and services in classes 25 and 39.

("Complainant's Trademarks").

The disputed domain name <harleymenshop.com> was registered on 27 February 2023 and the disputed domain name

<harleystyle.com> was registered on 6 March 2023.

FACTUAL BACKGROUND

As the Respondent did not file any response to the complaint, the Panel took into account the following facts asserted by the Complainant (and supported by the documentary evidence submitted by the Complainant) and unchallenged by the Respondent:

(a) 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. 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 extremely high level of awareness of the Complainant's brand amongst consumers.

(b) The Complainant owns very extensive rights in the HARLEY and HARLEY-DAVIDSON trade marks, including Complainant's Trademarks.

(c) The domain name <harley-davidson.com> was registered by the Complainant on 8 November 1994. The Complainant also owns a considerable portfolio of HARLEY-DAVIDSON domain names.

(d) There is no active website directly under the disputed domain names, however, there are active subdomains. Through the website under the subdomain <harle.harleystyle.com> the Respondent sells counterfeit products marked by the Complainant's Trademarks without authorization from the Complainant. In order to facilitate such sales, the Respondent uses the concept of the so-called "hidden links" which means that the Respondent advertises such counterfeit products bearing Complainant's Trademarks by sponsored posts on social media which contain link to the website under the subdomain <harle.harleystyle.com> through which the transaction can be completed and paid, although such website itself contains no offer of advertisement of products bearing Complainant's Trademarks. Such website, although located under the subdomain <harle.harleystyle.com>, is branded by "Harleymenshop" name.

PARTIES CONTENTIONS

THE COMPLAINANT:

In addition to the above factual assertions, the Complainant also contends the following:

(i) Disputed domain names are confusingly similar to the Complainant's Trademarks as they include the word HARLEY as the dominant element of the domain name, followed by non-distinctive terms, namely "menshop" and "style", respectively. Inclusion of non-distinctive terms which are either descriptive or generic do not alter the overall impression in the eyes of the average internet user and thus cannot diminish confusing similarity between disputed domain names and Complainant's Trademarks.

(ii) Both disputed domain names are used in furtherance of a counterfeiting scheme, which excludes any rights or legitimate interest of the Respondent in respect of the disputed domain names and also it is a clear evidence of bad faith of the Respondent in registration and use of the disputed domain names.

THE RESPONDENT:

The Respondent did not provide any response to the complaint.

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 Uniform Domain Name Dispute Resolution Policy ("UDRP" or "Policy")).

For details, please see "Principal Reasons for the Decision".

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).

For details, please see "Principal Reasons for the Decision".

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).

For details, please see "Principal Reasons for the Decision".

PROCEDURAL FACTORS

The Panel notes that the case at hand concerns two disputed domain names held by (allegedly) two different Respondents. The Complainant filed a Consolidation Request arguing that (a) based on commonalities between the disputed domain names and the websites to which they resolve their overall use demonstrates that these are interconnected as part of an organised infringement network and (b) the registrant details are suspected to be false. As a result the Complainant submits that it is fair and equitable to consolidate the disputed domain names into a single consolidated complaint.

The Panel agrees with the Complainant that there are some commonalities in circumstances surrounding both disputed domain names (such the name of the registrar, same city of residence of both Respondents, same subdomain "harle") and that names of the Respondents are most likely false. Most importantly, the social media posts provided by the Complainant show that the users are asked to click on a link which brings them to the website under the subdomain <harle.harleystyle.com> where they can complete the order of counterfeit products advertised in the social media post and pay the transaction, however, such website is branded "Harleymenshop". This is a clear evidence that both disputed domain names are used in furtherance of a counterfeiting scheme by the same person (or network of persons). Therefore the Panel grants the Consolidation Request as requested by the Complainant. Both Respondents are referred to as "the Respondent" in this decision.

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

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy requires that the Complainant proves each of the following three elements to obtain an order that the disputed domain name shall be transferred or revoked:

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

The Panel will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in this proceeding.

RIGHTS

The disputed domain names are confusingly similar with the Complainant's Trademarks. The Panel fully agrees with the Complainant that an addition of non-distinctive terms, namely "menshop" and "style", does not alter the overall impression in the eyes of the average internet user and thus cannot diminish confusing similarity between disputed domain names and Complainant's Trademarks.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the identity / confusing similarity test as it is a necessary technical requirement of registration.

Therefore, the Panel concludes that the Complainant satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

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 Policy (please see, for example, WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

As asserted by the Complainant (and unchallenged by the Respondent), the Respondent is not commonly known by the disputed domain names. Neither is the Respondent in any way related to the Complainant. The Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy). Furthermore, the disputed domain names are used in furtherance of a counterfeiting scheme, which excludes any rights or legitimate interest of the Respondent in respect of the disputed domain names.

Therefore, the Panel concludes that the Complainant has 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

As stated above, the disputed domain names are used by the Respondent in furtherance of a counterfeiting scheme. Such conduct amounts to trademark infringement, is apparently illegal and constitutes a criminal offense in many jurisdictions. As such, it is also a clear example of bad faith of the Respondent in registration and use of the disputed domain names.

As a result, the Panel found that the disputed domain names have been registered and are being used by the Respondent in bad faith (within the meaning of 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. **harleymenshop.com**: Transferred
- 2. **harleystyle.com**: Transferred

PANELLISTS

Name	Michal Matějka
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DATE OF PANEL DECISION 2023-12-20

Publish the Decision