Decision for dispute CAC-UDRP-106275

Case number	CAC-UDRP-106275
Time of filing	2024-02-22 09:45:02
Domain names	harleysaleoutlets.com, harley-davidsonsale-us.com, harley-davidsonsales-us.com, harleydavidsonsales.vip, harleydavidsonsale.shop, harleydavidsonsa.shop, harleydavidsonuss.shop, harleydavidsonsus.shop, harleydavidsonsaus.shop, harleydavidsonsales.shop, harleydavidsonusale.vip, harleydavidsonss.shop, harleydavidsonu.shop, harleydavidsonusa.shop, harleydavidsonstores.shop, harley-davidson-sale.shop, harley-davidson-save.shop, harleystores.shop, harleydavidsonspeedshop.com, harleydvsstore.com, harley-davidson-shop.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Harley-Davidson Motor Company Inc

Complainant representative

Organization	Stobbs IP

Respondents

Name	Liu Peng
Name	zhou sheng qiang
Name	hua jun qing
Name	Martin Parker
Name	tara waldvogel
Organization	Domain Name Privacy Inc.
Name	Tonia Bruno

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 owner of the well-known trademark HARLEY-DAVIDSON around the world, inter alia, United States Patent and Trademark Office trademark Reg. No. 0507163 registered on March 1, 1949 in class 25; and United Kingdom IPO trademark Reg. No. UK00000658028 registered on April 9, 1947.

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 November 5, 1987 and as of November 6, 2023, has a market capitalization value of $4.10 billion.

The Complainant owns very extensive rights in the HARLEY-DAVIDSON mark including but not limited to the trade mark registrations as identified in section "Identification of Right" above. In addition, the domain name <harley-davidson.com> was registered by the Complainant on November 8, 1994. The Complainant also owns a considerable portfolio of 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 mark 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 extremely high level of awareness of the Complainant's brand amongst consumers. The Complainant has an active online presence at its official website, which has been live since at least as early as December 19, 1996. The Complainant is also active on social media and has generated a significant level of endorsement.

All of the twenty-one disputed domain names were registered between May 7, 2023 and February 19, 2024. The contents of the disputed domain names' resolving websites are identical and/or highly similar to each other including website UI and look and feel. Some of the disputed domain names' resolving websites which do not currently resolve to infringing content have historically been used in an identical and/or highly similar manner as to that of the infringing websites active as of the date of this Complaint. Prima facie counterfeit products are offered for sale at the disputed domain names' resolving websites. The disputed domain names are redirecting to one another, namely **<harleydavidsonsales.vip>**, **<harleydavidsonsale.shop>**, **<harleydavidsonsa.shop>**, and **<harleydavidsonuss.shop>** redirect to **<harleydavidsonsus.shop>**. The Complainant was alerted to at least 11 of the 21 disputed domain names via Facebook Ads advertising counterfeit goods relating to the Complainant diverting Internet users to the disputed domain names' resolving websites via hidden links.

PARTIES CONTENTIONS

COMPLAINANT:

i) The Complainant has rights in the HARLEY-DAVIDSON mark as identified in section "Identification of rights" above. The disputed domain names are confusingly similar to the Complainant's HARLEY-DAVIDSON mark because they incorporate the Complainant's mark in their entirety and add non-distinctive elements and/or omit a hyphen.

ii) The Respondents have no rights or legitimate interests in respect of the disputed domain names. The Respondent is not commonly known by the disputed domain names. The Respondents have not provided a bona fide offering of goods or services in connection with the disputed domain names. The disputed domain names have been redirected by the Respondent to websites where the Complainant's trademark HARLEY-DAVIDSON is displayed, and prima facie counterfeit products are offered for sale.

iii) The Respondents have registered and is using the disputed domain names in bad faith. The use of the disputed domain names in connection with commercial websites where the Complainant's trademark is misappropriated and prima facie counterfeit HARLEY-DAVIDSON branded products are offered for sale, clearly indicates that the Respondent's purpose for registering the disputed domain names was to capitalize on the reputation of the Complainant's trademark. The Respondents have been engaged in a pattern of conduct preventing the Complainant from reflecting the marks in the disputed domain names. The Respondents had knowledge of the Complainant's rights in the HARLEY-DAVIDSON mark before registering the disputed domain names, which constitutes bad faith registration.

RESPONDENT:

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

PRELIMINARY ISSUE 1: Multiple Respondents

The Complainant has alleged that it is likely that the disputed domain names are under the control of a single entity and consolidation is appropriate in this matter. Paragraph 3(c) of the Rules (the "Rules") for the Uniform Domain Name Dispute Resolution Policy (the "UDRP" or "Policy") provides that a "complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder." The Complainant contends that the disputed domain names are subject to an evident common control, thus making the consolidation of the dispute equitable and procedurally efficient. The disputed domain names were registered by the same domain-name holder or under the control of a common operator, based on commonalities between the disputed domain names and the websites to which they resolve given that:

(i) The disputed domain names all use a privacy protection service to mask the registrant;

(ii) The contents of the disputed domain names' resolving websites are identical and/or highly similar to each other including website UI and look and feel;

(iii) The disputed domain names are redirecting to one another, namely **<harleydavidsonsales.vip>**, **<harleydavidsonsale.shop>**, **<harleydavidsonsa.shop>**, and **<harleydavidsonuss.shop>** redirect to **<harleydavidsonsus.shop>**;

(iv) The Complainant was alerted to at least 11 of the 21 disputed domain names via Facebook Ads advertising counterfeit goods relating to the Complainant diverting Internet users to the disputed domain names' resolving websites via hidden links; and

(v) The similarity of the disputed domain names' anatomy to one another (each including a generic term, alongside the Complainant's well-known HARLEY-DAVIDSON or HARLEY mark).

In light of all the information related above and the relationships between the use of the disputed domain names, the Complainant believes that the present one is a clear case where the disputed domain names are under the actual control of a single individual or entity or, at least, reflective of a group of individuals acting in concert.

The Complainant provides exhibits showing the circumstances as listed above including "network analysis map evidencing commonalities of all of the disputed domain names." The Panel finds that the circumstances indicated above are concrete and sufficient to prove that the disputed domain names are subject to a common control by a single entity. The Panel agrees and finds that the disputed domain names are commonly owned/controlled by a single Respondent who is using multiple aliases. Throughout the decision, the Respondents will be collectively referred to as "Respondent."

PRELIMINARY ISSUE 2: Language of the Proceedings

The Panel notes that the Registration Agreement is written in Chinese, thereby making the language of the proceedings in Chinese. The Complainant has requested that the proceeding should be conducted in English. The Panel has the discretion under UDRP Rule 11(a) to determine the appropriate language of the proceedings taking the particular circumstances of the administrative proceeding into consideration. See Section 4.5, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition; see also Lovehoney Group Limited v yan zhang, CAC 103917 (CAC August 17, 2021) (finding it appropriate to conduct the proceeding in English under Rule 11, despite Japanese being designated as the required language in the registration agreement).

The Complainant contends that (i) the website content of the disputed domain names is written entirely in English, and thus it is reasonable to infer that the Respondent must have a good grasp of the English language such that they would be able to understand the language of the Complaint; (ii) the suffixes used within the domain names include common English words, specifically: "speed," "shop," "store(s)," "sale(s)," "save," and "outlets"; and (iii) translating this Complaint into Chinese will lead to undue delay and substantial expense incurred by the Complainant, who already bears the burden for filing this Complaint.

Pursuant to UDRP Rule 11(a), the Panel finds that persuasive argument has been adduced by the Complainant. After considering the

circumstance of the present case, in the absence of the Response and no objection to the Complainant's request for the language of proceeding, the Panel decides that the proceeding should be in English.

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 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 the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

(2) the respondent has no rights or legitimate interests in respect of the domain name; and

(3) 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 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 Vertical Solutions Mgmt., Inc. v. webnetmarketing, inc., FA 95095 (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); see also Talk City, Inc. v. Robertson, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Rights and Confusing Similarity

The Complainant claims rights in the HARLEY-DAVIDSON mark as identified in section 'Identification of Rights' above. The Panel notes that national trademark registrations are sufficient to establish rights in those marks. Since the Complainant provides evidence of the trademark registrations with the USPTO and the UK IPO above, the Panel finds that the Complainant has established rights in the mark HARLEY-DAVIDSON. The Complainant contends that the disputed domain names are confusingly similar to the Complainant's mark because the disputed domain names incorporate the Complainant's mark HARLEY-DAVIDSON in their entirety with the addition of non-distinctive elements and the omission of a hyphen.

The Panel notes that all of the disputed domain names incorporate the HARLEY-DAVIDSON mark or the prominent portion HARLEY in their entirety and merely add non-distinctive generic, descriptive and/or geographical terms such as "speed," "shop," "store(s)," "sale(s)," "save," "outlets," "US," and USA"; non-distinctive letter(s) such as "sa," "uss," "sus," "usale," "ss," "u," and "dvs"; and the ".com," ".vip," or ".shop" gTLDs and/or omit a hyphen from the HARLEY-DAVIDSON mark. Adding a generic, descriptive or geographical term or non-distintive letters and a gTLD to a mark fails to sufficiently distinguish a disputed domain name from a mark per Policy paragraph 4(a)(i). See MONCLER S.P.A. v. Qiu Xiaofeng, Agayeva SEVINC , Petrosyan YELENA, Birzu GALINA, Karapetyan IRINA, CAC-UDRP-105522 (CAC July 18, 2023) ("Adding a generic term and a gTLD to a mark fails to sufficiently distinguish a disputed domain name from a mark per Policy paragraph 4(a)(i)."); see also Dell Inc. v. pushpender chauhan, FA 1784548 (Forum June 11, 2018) ("Respondent merely adds the term 'supports' and a '.org' gTLD to the DELL mark. Thus, the Panel finds Respondent's disputed domain name is confusingly similar to Complainant's DELL mark per Policy paragraph 4(a)(i)."). Therefore, the Panel finds the disputed domain names are confusingly similar to the Complainant's HARLEY-DAVIDSON mark per Policy paragraph 4(a)(i).

No rights or legitimate interests

The Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names under Policy paragraph 4(a)(ii), then the burden shifts to the 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 Policy). See also Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that the Respondent has never legitimately been known by the name HARLEY-DAVIDSON or HARLEY at any point in time. When a response is lacking, WHOIS information may be used to determine whether a respondent is commonly known by the disputed domain names under Policy paragraph 4(c)(ii). See H-D U.S.A., LLC, v. ilyas Aslan / uok / Domain Admin

ContactID 5645550 / FBS INC / Whoisprotection biz, FA 1785313 (Forum June 25, 2018) ("The publicly available WHOIS information identifies Respondent as 'Ilyas Aslan' and so there is no prima facie evidence that Respondent might be commonly known by either of the [and] domain names."). Additionally, lack of authorization to use a complainant's mark may indicate that the respondent is not commonly known by the disputed domain names. See Google LLC v. Bhawana Chandel / Admission Virus, FA 1799694 (Forum Sep. 4, 2018) (concluding that Respondent was not commonly known by the disputed domain name where "the WHOIS of record identifies the Respondent as "Bhawana Chandel," and no information in the record shows that Respondent was authorized to use Complainant's mark in any way."). The Panel notes that the WHOIS information for the disputed domain names lists the registrants as "Liu Peng," "zhou sheng qiang," "hua jun qing," "Martin Parker," "tara waldvogel," "Domain Name Privacy Inc.," and "Tonia Bruno." Nothing in the record suggests that the Respondent was authorized to use the HARLEY-DAVIDSON mark. Therefore, the Panel finds that the Respondent is not commonly known by the disputed domain names per Policy paragraph 4(c)(ii).

The Complainant also contends that the Respondent has not provided any evidence of the use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services before any notice of the dispute. The disputed domain names have been redirected by the Respondent to websites where the Complainant's trademark HARLEY-DAVIDSON is displayed, and prim facie counterfeit products are offered for sale.

Where a respondent uses a domain to pass itself off as affiliated with a complainant and redirect users to sell counterfeit goods, the Panel may find the respondent fails to make a bona fide offering of goods or services or a legitimate noncommercial or fair use per Policy paragraph 4(c)(i) or (iii). See Wolverine World Wide, Inc. v. Fergus Knox, FA 1627751 (Forum Aug. 19, 2015) (finding no bona fide offering of goods or legitimate noncommercial or fair use existed where Respondent used the resolving website to sell products branded with Complainant's MERRELL mark, and were either counterfeit products or legitimate products of Complainant being resold without authorization); see also Dell Inc. v. Devesh Tyagi, FA 1785301 (Forum June 2, 2018) ("Respondent replicates Complainant's website and displays Complainant's products. The Panel finds that this use is not a bona fide offering of goods or services under Policy paragraph 4(c)(i) & (iii)."). The Complainant provides evidence of the disputed domain names resolving to webpages displaying Complainant's mark and product photos, as well as offering for sale prima facie counterfeit versions of Complainant's goods. Therefore, the Panel finds that the Respondent fails to use the disputed domain names for a bona fide offering of goods or services or legitimate noncommercial or fair use under Policy paragraph 4(c)(i) or (iii).

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

Bad faith

The Complainant contends that the Respondent registered and uses the disputed domain names in bad faith. The use of the disputed domain names in connection with commercial websites where the Complainant's trademark is misappropriated and prima facie counterfeit HARLEY-DAVIDSON branded products are offered for sale, clearly indicates that the Respondent's purpose for registering the disputed domain names was to capitalize on the reputation of the Complainant's trademark by diverting Internet users seeking the Complainant's products to their websites for financial gain according to paragraph 4(b)(iv) of the Policy. The Complainant specifically points out that the Respondent's advertisement and sale of counterfeit goods at the disputed domain names' resolving websites make them a "competitor" within the meaning of 4(b)(iii) of the Policy; that the advertisement and sale of counterfeit goods, for which the Complainant holds a significant reputation, seek to confuse customers of the Complainant; and that the actions of the Respondent are argued to fall squarely within the meaning of "primarily for the purpose of disrupting the Complainant's business."

The Panel recalls that the disputed domain names have been redirected by the Respondent to websites where the Complainant's HARLEY-DAVIDSON mark is displayed and prima facie counterfeit HARLEY-DAVIDSON branded products are offered for sale. The Panel also recalls that the Complainant provides screenshots of the disputed domain names' resolving websites which prominently display the HARLEY-DAVIDSON mark. The Panel observes that use of a disputed domain name to pass off as a complainant and offer competing or counterfeited goods may be evidence of bad faith per Policy paragraph 4(b)(iii) and (iv). See Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund, FA 1790949 (Forum July 9, 2018) (finding bad faith per Policy Paragraph 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, FA 1610067 (Forum Apr. 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, FA 1760517 (Forum Dec. 27, 2017) (finding bad faith per Policy Paragraph 4(b)(iv) where "Respondent registered and uses the 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."). Therefore, the Panel concludes that the Respondent registered and uses the disputed domain names in bad faith per Policy paragraph 4(b)(iii) and (iv).

Next, the Complainant contends that the Respondent has been engaged in a pattern of conduct, by way of registering twenty-one domain names, confusingly similar to the Complainant's HARLEY-DAVIDSON mark, preventing the Complainant from reflecting the mark in the disputed domain names. The Panel observes that a pattern of conduct as required in paragraph 4(b)(ii) of the Policy may involve multiple domain names directed against a single complainant. The Panel finds that the Respondent has registered as many as twenty-one domain names containing the Complainant's trademark. The Panel finds that the Respondent's registration of the disputed domain names thus indicates a pattern of bad faith registration and use pursuant to Policy paragraph 4(a)(ii). See Ditec

International AB / Global Preservation Systems, LLC v. ADAM FARRAR / HOSTGATOR / FRITS VERGOOSSEN / DITEC INTERNATIONAL CORPORATION / Christopher Alison, FA 1763998 (Forum Feb. 1, 2018) ("Here, Respondent registered six domain names that all include Complainant's DITEC mark. Therefore, the Panel finds that Respondent's multiple registrations using the DITEC mark indicates bad faith registration and use per Policy paragraph 4(b)(ii).").

The Complainant further contends that the Respondent was fully aware of the reputation of the Complainant's HARLEY-DAVIDSON mark given the circumstances that the registration of its mark substantially pre-dates the registration of the disputed domain names; and that its HARLEY-DAVIDSON mark enjoys a wide and considerable reputation. Furthermore, the Respondent was unequivocally aware of the HARLEY-DAVIDSON brand given the Respondent's significant use of the HARLEY-DAVIDSON on the disputed domain names' resolving websites, within the social media advertisements, and that the resolving websites exist solely to impersonate/pass off as the Complainant in order to advertise for sale counterfeit goods targeting the Complainant's brands. Some of the disputed domain names' resolving websites which do not currently resolve to infringing content have historically been used in an identical and/or highly similar manner as to that of the infringing websites active as of the date of this Complaint.

The Panel infers, due to the notoriety of the Complainant's mark; the manner of use of the disputed domain names; and the registration of twenty-one domain names incorporating the Complainant's mark that the Respondent had knowledge of Complainant's rights in the HARLEY-DAVIDSON mark before registering the disputed domain names, which constitutes bad faith registration per Policy 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. **harleysaleoutlets.com**: Transferred
2. **harley-davidsonsale-us.com**: Transferred
3. **harley-davidsonsales-us.com**: Transferred
4. **harleydavidsonsales.vip**: Transferred
5. **harleydavidsonsale.shop**: Transferred
6. **harleydavidsonsa.shop**: Transferred
7. **harleydavidsonuss.shop**: Transferred
8. **harleydavidsonsus.shop**: Transferred
9. **harleydavidsonsaus.shop**: Transferred
10. **harleydavidsonsales.shop**: Transferred
11. **harleydavidsonusale.vip**: Transferred
12. **harleydavidsonss.shop**: Transferred
13. **harleydavidsonu.shop**: Transferred
14. **harleydavidsonusa.shop**: Transferred
15. **harleydavidsonstores.shop**: Transferred
16. **harley-davidson-sale.shop**: Transferred
17. **harley-davidson-save.shop**: Transferred
18. **harleystores.shop**: Transferred
19. **harleydavidsonspeedshop.com**: Transferred
20. **harleydvsstore.com**: Transferred
21. **harley-davidson-shop.com**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm Esq.**

DATE OF PANEL DECISION 2024-03-27

Publish the Decision