Decision for dispute CAC-UDRP-106547

Case number	CAC-UDRP-106547
Time of filing	2024-05-21 09:12:46
Domain names	harleydavid.shop, harleydavids.shop, harleydavidso.shop, harley-davidsons.club, harleygear.shop, harleydavidsonsunglasseshub.shop, harley-davidsonus.xyz, harleyofficial.shop, harleydavidsonusales.shop, harleydavidsons-us.shop, harleytestrider7.shop, hdharleydavidson.shop, shopharley-davidson.shop, store-harley-davidson.com, harley-davidsonoutlet.com, harleydavidsonoutlet.shop, harleydavidsonoutlets.shop, harleydavidsonbuy.shop, harley-davidson-eu.com, harleyonline.shop

Case administrator

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

Complainant

Organization	Harley-Davidson Motor Company, Inc.

Complainant representative

Organization	Stobbs IP

Respondents

Organization	Chen Yi Jie
Name	Zhu Yun Shan
Name	Mike Simon
Name	Registrant Registrant
Name	Roy Quezada
Name	zhou sheng qiang
Name	chen xiao xia
Name	chi na
Name	
Name	Zhi Xu
Organization	e-fielders
Name	Leon Ray

Name	li na
Name	Vernon S Mercado
Name	Katri Hei
Name	jgh lkj

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 include but are not limited to the below trademark registrations:

The Complainant is the owner of several different trademarks, registered worldwide, including but not limited to the followings:

- United Kingdom trademark HARLEYDAVIDSON No. UK00901797018 registered on 21 March 2002;
- United Kingdom trademark HARLEY No. UK00002121230 registered on 11 September 1998;
- United Kingdom trademark Bar & Shield No. UK00001341822 registered on 05 July 1991;
- United Kingdom trademark MOTOR HARLEYDAVIDSON CYCLES No. UK00901536309 registered on 19 November 2001.

The terms covered by the Complainant's trademarks include, but are not limited to, coverage for 'outerclothing, sweaters, suspenders, scarves, bandannas, jackets, coats, vests, gloves, jeans, chaps, shirts, shorts, caps, hats, headgear for wear, belts, wristbands, coveralls, hosiery, halter tops, neckties, night shirts, nightgowns, pyjamas, trousers, pants, rain suits, rain coats, shirts, sweatshirts, sweat pants, tank tops, t-shirts, underwear, head bands, leg warmers, aprons, mittens, lingerie, leather clothing, swimsuits, skirts, bibs; footwear, namely, shoes and boots, and parts of footwear, namely boot tips, sole plates, heel guards.', in Class 25, UK00901797018.

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 6 November 2023, has a market capitalisation value of $4.10 billion.

The Complainant owns very extensive rights in the HARLEY-DAVIDSON mark including but not limited to the trademark registrations enclosed within this Complaint. In addition, 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.

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 HARLEYDAVIDSON 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 via its official website at https://www.harley-davidson.com/, which has been live since at least as early as 19 December 1996.

The Respondent appears to be individuals based in multiple locations in accordance with the WHOIS information of the disputed domain names.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names should be transferred to it.
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).

The Complainant claims rights in the HARLEYDAVIDSON and HARLEY trademarks (hereinafter "HARLEYDAVIDSON") through its international trademark registrations. By virtue of its trademark registrations, the Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12).

The Complainant further contents that the disputed domain names are identical or confusingly similar to its HARLEYDAVIDSON trademark and the additional geographical terms, generic terms, characters as well as the hyphen do nothing to alter the overall impression in the eyes of average internet users. The Complainant also requests that the Panel omits the TLDs when assessing confusing similarity.

By doing side-by-side comparisons, the Panel accepts that the disputed domain names are visually similar to Complainant's HARLEYDAVIDSON trademark and the additional terms/letters/punctuation do not affect the distinctiveness of the marks. See paragraph 1.7 of the WIPO Overview 3.0.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, 102378, (CAC 2019-03-08) ("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 name.").

The Complainant claims that the Respondents are using the disputed domain names to redirect or resolve to infringing websites which impersonate/pass off as the Complainant, or at a minimum suggest that they are affiliated with the Complainant. For the avoidance of doubt, the Respondents are not in fact connected to or affiliated with the Complainant. In an attempt to pass off as the Complainant in order to sell counterfeit goods/merchandise, the infringing websites mimic distinctive elements of the Complainant's official website, including but not limited to the logo, typeface, fonts, images and colour scheme.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain names. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain names. However, the Respondent has not submitted any response to rebut the assertions within the required period of time.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

The Complainant reiterates that the registered HARLEYDAVIDSON trademarks substantially pre-date the registration of the disputed domain names and that the HARLEYDAVIDSON trademarks enjoy a wide and considerable reputation. Furthermore, the Respondents were unequivocally aware of the HARLEY-DAVIDSON brand given the Respondents' significant use of the HARLEYDAVIDSON trademarks on the infringing websites, within the social media advertisements, and that the resolving infringing websites exist solely to impersonate/pass off as the Complainant in order to advertise for sale counterfeit goods targeting the Complainant's brands. Therefore, the Complainant submits that the Respondent undoubtedly had actual knowledge of the HARLEY-DAVIDSON brand and that the disputed domain names were registered with the sole purpose of targeting the Complainant's HARLEYDAVIDSON trademarks.

The Complainant further alleges that the Respondent has used the disputed domain names to resolve to the infringing websites

containing unauthorised use of the HARLEY-DAVIDSON trademarks, alongside the sale of counterfeit goods.

Having reviewed the website content resolved by the disputed domain names, the Panel is of the view that the Respondent does have actual knowledge of Complainant's HARLEY-DAVIDSON trademarks during the registration of the disputed domain names. At the meantime, the Panel also accepts that the Respondent's act of deliberately impersonating the Complainant for commercial gain constitutes bad faith. See Esselunga S.p.A. vs. xuxu, 105785 (CAC 2023-11-13) ("the Panel is persuaded that the Domain Name comprising the Complainant's fanciful trade mark and the ordinary word "shop", inherently impersonates the Complainant. By reason of the nature of the Domain Name and the size and reputation of the Complainant's business under the ESSULUNGA mark the Panel is also persuaded that this impersonation is deliberate on the part of the Respondent.") See also Harley-Davidson Motor Company Inc. v. Hamza Ali, 105981 (CAC 2023-12-20).

For the foregoing reasons, the Panel finds the Complainant has satisfied 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.

PRELIMINARY FINDINGS - CONSOLIDATION:

Pursuant to Paragraph 10(c) of the Rules that a Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules. The Rules further state that Respondent means the holder of a domain name registration against which a complaint is initiated. The Complainant submitted a request for consolidation that all the disputed domain names were registered or under common control the Respondent considering that all of the disputed domain names are being used to sell counterfeit products of the Complainant. The disputed domain names are further divided into 3 groups:

- Counterfeit webstores are the disputed domain names which currently point to an active website offering for sale counterfeit HARLEY-DAVIDSON goods, or there is historical evidence the website has been used to point to an active website offering for sale counterfeit HARLEY-DAVIDSON goods. The disputed domain names in this group are all identical or highly similar and offer for the sale the same counterfeit HARLEY-DAVIDSON goods.
- Seemingly unrelated websites are the disputed domain names which point to an active website which does not appear to be offering counterfeit HARLEY-DAVIDSON goods. The Complainant reiterates the submissions made regarding use of such websites in relation to hidden links. Of the 6 disputed domain names in this group, 5 out of the 6 use the .SHOP top-level domain. The disputed domain names on the .CLUB TLD has or had an identical homepage as another disputed domain name in the group, both of which utilise the hidden links method of obtaining traffic in order to make sales of counterfeit goods. All 6 of the disputed domain names in the group were registered within a 2-month period.
- No website or history of having a website relates to disputed domain names in that there is no evidence the disputed domain name has been used in relation to an active website. The Complainant notes that a lack of historical evidence is not definitive proof the disputed domain name has not been used for such purpose. Some of the disputed domain names have been used within Facebook Ads, which is high evidence that the domain pointed to an active website and follows the same pattern as 10 other disputed domain names in this complaint. The remaining disputed domain name <harleydavidsonusales.shop> has the same, or highly similar, registrant details as to disputed domain name <harleydavidsons-us.shop>. Despite the availability of screen captures of the disputed domain names being used for active websites the Complainant submits there is high evidence both disputed domain names in this group are subject to common control within the greater infringement network targeting the Complainant and its HARLEY-DAVIDSON brand.

The Panel is of the view that for those disputed domain names within the group of counterfeit webstores and/or linked to Facebook Ads, they all share some sort of similarity in design, products, sales tactics, logo, etc. Also taking into account that the WHOIS information of some of the disputed domain names is obviously fake so more likely than not they are be under common control by the Respondent.

As to the group of disputed domain names solely fall within seemingly unrelated websites, the Panel believes that to facilitate the use of hidden links for selling counterfeit products, an external listing will be needed to link up the generic products for sale and the counterfeit products to be delivered. (Reference: Breaking the Rules on Counterfeit Sales: The Use of Hidden Links at https://circleid.com/posts/20220510-breaking-the-rules-on-counterfeit-sales-the-use-of-hidden-links) Despite the Complainant claims that the use of the websites is related to hidden links, there is no evidence provided by the Complainant to support the use of hidden links on those websites.

As to the rest of the disputed domain names, there is no evidence to support that they are under common control.

The Respondent did not submit a timely Response within the required period of time.

On the balance of probabilities and in the absence of response submitted by the Respondent, the Panel finds that the following 14 disputed domain names were registered by the Respondent or under common control:

- harley-davidson-eu.com
- harleydavidsonoutlet.shop
- hdharleydavidson.shop

- harleyofficial.shop
- harleydavids.shop
- harleydavidso.shop
- harleyonline.shop
- harley-davidsonoutlet.com
- harleydavidsonoutlets.shop
- harley-davidsonus.xyz
- harleydavid.shop
- harley-davidsons.club
- shopharley-davidson.shop
- harleydavidsonbuy.shop

Considering there is no persuasive evidence provided by the Complainant that the following domain names are also under common control alongside the 14 disputed domain names. Therefore, the Panel hereby decides to dismiss the consolidation request related to the following 6 domain names without prejudice to the Complainant to re-file new complaints in separate administrative proceedings:

- store-harley-davidson.com
- harleydavidsons-us.shop
- harleygear.shop
- harleydavidsonusales.shop
- harleydavidsonsunglasseshub.shop
- harleytestrider7.shop

See MONCLER S.P.A. v. Rebecca Stokes, Burn Burn, Michael Watson, Phoebe Walton, Client Care and Zhang Fei, 106497 (CAC 2024-06-16) ("Accordingly, the minimal arguments submitted by the Complainant for consolidation of these four domain names with the other thirty-five domain names are not persuasive. The fact that all four of these disputed domain names share the use of a Complainant's logo within the website associated with such domain names is not, without more, sufficient to show common control. Typically, in consolidation requests, there are several factors are present pointing to consolidation, and the panel must weigh up the persuasiveness of each factor. The Panel, in accordance with its articulated powers under paragraphs 10 and 12 of the UDRP Rules, considered it useful to undertake limited additional research to assess the merits of the consolidation request. For this purpose, the Panel checked publicly available information concerning the IP Address and IP Location of these four disputed domain names. According to such publicly available information, there was no commonality regarding the IP Addresses and IP Locations of these four domain names and the other 35 domain names which are to be consolidated in this proceeding. Further, commonality in the use of the Complainant's logo on the websites is afforded low weight and does not, without more, warrant consolidation.").

See also Björn Knaup (Deichmann SE) v. Han Chao, stephen wilson, sadsxcsda sfafsafd, chen xiao, lin jie, Tony Oconner, Daniel Chambers, Web Commerce Communications Limited, Colin Derby, 106185 (CAC 2024-03-14) ("The Panel does not find commonalities or links conducive to a finding of common control among the above registrants. There is no common connection among the registrant names, registrar, or naming patterns, nor do they share technical/administrative contacts, e-mail addresses or nameservers. The Panel is furthermore unpersuaded by the Complainant's argument that the respondents' default would be indicative of a common control of the Domain Names.")

On this basis, the Panel partially accepts the consolidation request in accordance with Paragraph 10(e) of the Rules and Paragraph 4.11.2 of the WIPO Overview 3.0.

PRELIMINARY FINDINGS - LANGUAGE OF PROCEEDING:

The Panel notes that the language of the Registration Agreements is English and Chinese as confirmed by the Registrars. The official Complaint was submitted in English and the Respondents did not submit an official response. Pursuant to paragraph 11 of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complainant requests to use English as the language of proceeding, with the arguments that the website content of the disputed domain names is written entirely in English and the suffixes used within the disputed domain names include common English words. In addition, the Complainant submits that translating this Complaint into any other language will lead to undue delay and substantial expense incurred by the Complainant, who already bears the burden for filing this Complaint. Any further costs incurred would go against the spirit of the Policy.

The Panel is bilingual and is well equipped to deal with the proceeding in both Chinese and English. Having considered the circumstances, Panel believes that it would be fair to both parties to use English as the language of proceeding and it can also uphold the principle of UDRP being a swift dispute resolution process. On this basis, the Panel determines that the language requirement has been satisfied and decides that the language of proceeding to be English.

PRINCIPAL REASONS FOR THE DECISION

Having established all three elements required under the UDRP Policy, the Panel concludes that the following 16 disputed domain

names should be transferred to the Complainant:

- harley-davidson-eu.com
- harleydavidsonoutlet.shop
- hdharleydavidson.shop
- harleyofficial.shop
- harleydavids.shop
- harleydavidso.shop
- harleyonline.shop
- harley-davidsonoutlet.com
- harleydavidsonoutlets.shop
- harley-davidsonus.xyz
- harleydavid.shop
- harley-davidsons.club
- shopharley-davidson.shop
- harleydavidsonbuy.shop

The consolidation request of the dispute related to the following 6 domain names is hereby rejected and the dispute may be refiled and decided in separate proceedings:

- store-harley-davidson.com
- harleydavidsons-us.shop
- harleygear.shop
- harleydavidsonusales.shop
- harleydavidsonsunglasseshub.shop
- harleytestrider7.shop

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Partially Accepted/Partially Rejected

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

1. **harleydavid.shop**: Transferred
2. **harleydavids.shop**: Transferred
3. **harleydavidso.shop**: Transferred
4. **harley-davidsons.club**: Transferred
5. **harleygear.shop**: Terminated (consolidation not granted)
6. **harleydavidsonsunglasseshub.shop**: Terminated (consolidation not granted)
7. **harley-davidsonus.xyz**: Transferred
8. **harleyofficial.shop**: Transferred
9. **harleydavidsonusales.shop**: Terminated (consolidation not granted)
10. **harleydavidsons-us.shop**: Terminated (consolidation not granted)
11. **harleytestrider7.shop**: Terminated (consolidation not granted)
12. **hdharleydavidson.shop**: Transferred
13. **shopharley-davidson.shop**: Transferred
14. **store-harley-davidson.com**: Terminated (consolidation not granted)
15. **harley-davidsonoutlet.com**: Transferred
16. **harleydavidsonoutlet.shop**: Transferred
17. **harleydavidsonoutlets.shop**: Transferred

18. **harleydavidsonbuy.shop**: Transferred
19. **harley-davidson-eu.com**: Transferred
20. **harleyonline.shop**: Transferred

PANELLISTS

Name	**Mr Paddy TAM**

DATE OF PANEL DECISION 2024-07-02

Publish the Decision