Decision for dispute CAC-UDRP-106758

Case number	CAC-UDRP-106758
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Domain names	harley.vip, harleyy.vip

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Harley-Davidson Motor Company, Inc.

Complainant representative

Organization	Stobbs IP

Respondent

Organization	lina

OTHER LEGAL PROCEEDINGS

The Panel is aware of proceeding No. 106559 initiated by the Complainant for the recovery of the domain names <harley.vip>, <harleyy.vip> & <harley-davidson.vip> concluded with a rejection order. The rejection in question is based on procedural/formal grounds regarding the lack of sufficient evidence from the Complaint to demonstrate the consolidation of the three domains into one Complaint.

Following this decision, the Complainant filed a new Complaint concerning two of the three domains involved in the first Complaint; i.e. <harley.vip> & <harleyy.vip>.

The Panel does not consider that there are any reasons to prevent the examination of the current Complaint since Case No. 106559 was decided on the basis of procedural/formal grounds without any examination of the merits of the case.

In fact, the Panel closed the case No. 106559 using the following statement:

“For the sake of clarity, this Panel has not made any finding or decision on any matter of substance such as would prejudice either Party in the event that any of the disputed domain names might be the subject of a future complaint”.

Based on the above, the Panel would review this new case based on evidence provided by the Complainant.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks consisting of the term “HARLEY®” & “HARLEY DAVISON®” such as:

- UK Registration no. UK00901797018 “HARLEY-DAVISON®” in classes 25 & 39 registered on March 21, 2002;
- UK Registration no. UK00002121230 “HARLEY®” in class 25 registered on September 11, 1998;

- UK Registration no. UK 00901536309 “HARLEY- DAVIDSON CYCLES®” in classes 16, 18, 25, 26, 28, 35, 36, 39 & 41 registered on November 19, 2001;

The Complainant is the owner of the domain name <harley-davidson.com> registered on June 15, 2005.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

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 trade mark rights in HARLEY-DAVIDSON and HARLEY.

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 and HARLEY 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 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 https://www.harley-davidson.com/, which has been live since at least as early as 19 December 1996. The Complainant is also active on social media and has generated a significant level of endorsement.

The disputed domain names were registered as follows:

<harley.vip> with creation date April 15, 2024

<harleyy.vip> with creation date April 18, 2024

(hereinafter, the “Disputed Domain Names”).

The Complainant indicates that the Disputed Domain Names resolve as follows:

<harley.vip> infringing website advertising crypto assets using the HARLEY-DAVIDSON and HARLEY branding;

<harleyy.vip> inactive website.

According to Complainant’s non-contested allegations, the Respondent has no rights or legitimate interest in respect of the Disputed Domain Names and the Complainant is not related in any way to the Complainant’s business.

For the purpose of this case, the Registrar confirmed that the Respondent is the current registrant of the Disputed Domain Names and that the language of the registration agreement is English.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

COMPLAINANT:

First element: Similarity

The Complainant states that the Disputed Domain Name incorporate in their entirety its trademarks “HARLEY DAVISON®“ & “HARLEY®”.

The Complainant asserts the following:

<harley.vip> incorporates the HARLEY mark verbatim.

<harleyy.vip> incorporates the HARLEY trade mark in its entirety as the dominant and distinctive element, with the addition of the letter ‘y’, which does not alter the overall impression in the eyes of the average internet use.

The TLD “.vip” is to be ignored for the purpose of assessing the identity, because it only plays a technical function.

Second element: Rights or legitimate interest

The Complainant contends that no authorization has been given to anyone to make any use or apply for registration of the Disputed Domain Names and have no affiliation at all with the Respondent.

In particular, the Respondent is not making a legitimate non-commercial or fair use of the Disputed Domain Names. In this regard, the Complainant submits that the Respondent is not using the Disputed Domain Names in relation to a bona fide offering of goods or services. Specifically, the domain name <harley.vip> resolves to the Infringing Website. The Infringing Website impersonate/pass off as the Complainant, or suggest that they are affiliated with the Complainant. Specifically, the Infringing Website advertises crypto assets using the HARLEY-DAVIDSON and HARLEY branding (e.g., the logo, typeface, fonts, and images). This is further exemplified by the Respondent’s use of Facebook and YouTube videos which target the HARLEY brand in the video content, video description, and/or video title to divert internet users to the Disputed Domain Names.

The second Disputed Domain Name <harleyy.vip> does not currently show a live website, but the Complainant believes that the Disputed Domain Name will resolve to a website similar to the website connected to <harley.vip> for the same purpose of offering crypto assets.

The Complainant has not licensed or otherwise permitted the Respondent to use its trademark. There is no relationship between the Complainant and the Respondent.

The Respondent’s use of the Disputed Domain Names is designed to impersonate or pass itself off as the Complainant or to be somehow affiliated, in order to advertise the Respondent’s own crypto assets.

Third element: Bad faith

The Complainant 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 their trade mark in a corresponding domain name and that the Respondent has engaged in a pattern of bad faith conduct.

The Respondent has registered two (2) domain names containing the HARLEY trade mark which evidences a pattern of bad faith conduct under Policy. Furthermore, the Respondent has registered other ‘.VIP’ domains incorporating other distinctive and reputable brands in the domain name, which is a behaviour commonly referred to as ‘cyber-squatting’.

The Complainant submits that the Respondent has registered the Disputed Domain Names in bad faith by intentionally attempting to attract, for commercial gain, internet users to the Infringing Website, by creating a likelihood of confusion with the Complainant's Registered Trade Marks as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Names under Policy. Moreover, the Respondent has registered the Disputed Domain Names, first to drive internet traffic to the Infringing Website and, thereafter, to impersonate the Complainant or claim an affiliation. Using a trade mark to divert traffic to a respondent’s own website(s) has been consistently held by panellists to amount to bad faith registration and use under the Policy

The Complainant submits that, based on the Respondent’s use of the HARLEY-DAVIDSON® and HARLEY® brands to advertise crypto assets, the Respondent had actual knowledge of Complainant’s Registered Trade Marks and is clearly aware of the Complainant’s reputation. Actual knowledge of a complainant’s rights in a mark prior to registering a confusingly similar domain name is strong evidence of bad faith under the Uniform Domain-Name Dispute-Resolution Policy.

Furthermore, the Complainant asserts that there is the additional risk that the Infringing Website intends to harvest personal and/or financial information from the Complainant’s customers. The Infringing Website, and the social media posts connected with the infringing website, advertises the sale of crypto assets falsely endorsed by the Complainant. The behaviour of the Respondent is commonly known as “phishing”.

RESPONDENT

Respondent did not reply 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 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

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

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that a domain name should be transferred or cancelled:

(i) the 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 domain name; and

(iii) the domain name has been registered and are being used in bad faith.

The Panel has reviewed in detail the evidence available to it and has come to the following conclusions concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in the proceeding:

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAMES TO THE COMPLAINANT'S RIGHTS.

Paragraph 4(a)(i) of the Policy establishes the obligation of the Complainant to demonstrate that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant presented as evidence a long list describing its trademarks rights in different countries, including the following:

- UK Registration no. UK00901797018 "HARLEY-DAVISON®" in classes 25 & 39 registered on March 21, 2002;
- UK Registration no. UK00002121230 "HARLEY®" in class 25 registered on September 11, 1998;
- UK Registration no. UK 00901536309 "HARLEY- DAVIDSON CYCLES® and design" in classes 16, 18, 25, 26, 28, 35, 36, 39 & 41 registered on November 19, 2001;

No copies of trademarks certificates were added to the Complaint. However and based on the minimal evidence submitted by the Complainant, the Panel has decided to use its general powers articulated in paragraphs 10 and 12 of the UDRP Rules to conduct a limited online search regarding the ownership of the three above trademarks and it was able to confirm that they are valid.

The Complainant's trademarks were registered prior to April 2024, the year of the creation date of the Disputed Domain Names.

In the current case, both Disputed Domain Name fully incorporates the trademark HARLEY®. In assessing confusing similarity, the Panel finds the Disputed Domain Name <harley.vip> is indeed identical to the Complainant's trademark "HARLEY®". As to the domain name <harleyy.vip>, the inclusion of the letter "y" does not prevent to find confusion with respect to Complainant's trademarks "HARLEY DAVISON®" & "HARLEY®".

In this vein, UDRP past panels agree that where the relevant trademark is recognizable within the Disputed Domain Name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See paragraph 1.8. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 3.0 ("WIPO Jurisprudential Overview 3.0.).

UDRP panels agree that the TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant's trademark as it is technical requirement of registration. See paragraph 1.11.1 of WIPO Jurisprudential Overview 3.0.

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the Disputed Domain Names are as follows:

harley.vip: identical;

harleyy.vip: confusingly similar to Complainant's "HARLEY DAVISON®" & "HARLEY» trademarks.

(B) RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAMES.

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the Disputed Domain Names. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it with relevant evidence demonstrating rights or legitimate interests in the disputed domain name; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

In this regard, Paragraph 4 (c) provides with circumstances which could prove rights or legitimate interest in the Disputed Domain Name on behalf of the Respondent such as:

(i) before any notice to Respondent of the dispute, Respondent is using or provides with demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) The Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or

(iii) The Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent did not reply to the Complaint despite the efforts made by this Center to notify the Respondent about the Complaint. In this regard, the Complainant has confirmed in the Complaint that the Disputed Domain Names are not connected with or authorized by the Complainant in any way.

From the information provided by the Complainant, there is no evidence or reason to believe that the Respondent (as individual, business or other organization) has been commonly known by the Disputed Domain Name.

The Respondent's name "Lina Tule" is all what it links the Disputed Domain Names with the Respondent. Absent of any other evidence such as a personal name, nickname or corporate identifier, the Panel is of the opinion that the Respondent is not commonly known by the Disputed Domain Name.

The Complainant indicates that they have not granted authorization to the Respondent to use their "HARLEY DAVISON®" & "HARLEY®» trademarks. Furthermore, the Complainant asserts that the Respondent is not affiliated with him nor authorized in any way to use the trademarks "HARLEY DAVISON®" & "HARLEY®".

The Complainant established that the Disputed Domain Names resolve as follows:

<harley.vip> active website advertising crypto assets using the "HARLEY DAVISON®" & "HARLEY®» trademarks.

Past panels have agreed that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. See paragraph 2.13 of the WIPO Jurisprudential Overview 3.0.

<harleyy.vip> inactive website

For the second Disputed Domain Name <harleyy.vip>, the Complainant did not provide with the relevant evidence showing that the website is inactive. In fact, the Complainant argued that Disputed Domain Name might resolve to a website similar to the website connected to <harley.vip> for the same purpose of offering crypto assets mainly because the Respondent has already posted videos linking <harleyy.vip> to the same or similar content as <harley.vip>. Based on this minimal evidence, the Panel has decided to use its general powers articulated in paragraphs 10 and 12 of the UDRP Rules to conduct a limited online search regarding the use of the Disputed Domain Name <harleyy.vip>, and it was able to confirm that the Disputed Domain Name <harleyy.vip> is indeed inactive.

Different panels have confirmed that the lack of content at the Disputed Domain Name can be considered as a finding that Respondent does not have bona fide offering of goods and services (see, for example, Forum Case No. FA 1773444, Ashley Furniture Industries, Inc v. Joannet Macket/JM Consultants).

In light of the reasons above mentioned and absent of Respondent's reply, the Panel concludes that the Complainant has satisfied the second element of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES.

Paragraph 4(a)(iii) of the Policy indicates that the Complainant must assert that the Respondent registered and is using the Disputed Domain Name in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four circumstances which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- circumstances indicating that the Respondent has registered or acquired the Disputed Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the Respondent's

documented out-of-pocket costs directly related to the domain name; or

- The Respondent has registered the Disputed Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding Disputed Domain Name, provided that Respondent has engaged in a pattern of such conduct; or
- The Respondent has registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or
- by using the Disputed Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

In accordance with the evidence provided by the Complainant, the Disputed Domain Name are used as follows:

<harley.vip> active website advertising crypto assets using the "HARLEY DAVISON®" & "HARLEY®» trademarks.

The Complainant did not provide with any authorization to the Respondent for the use of their trademarks.

Past panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution.

See paragraph 3.4 of the WIPO Jurisprudential Overview 3.0.

<harleyy.vip> inactive website. It is well established at different UDRP panel resolutions that the lack of use of a Disputed Domain Name does not prevent from finding bad faith (e.g. Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. 2000-0003).

In this vein, WIPO Jurisprudential Overview at paragraph 3.3. provides some factors that have been considered relevant in applying the passive holding doctrine such as: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

For the current case, the evidence at hand confirms that Complainant's "HARLEY DAVISON®" & "HARLEY®" trademarks are distinctive and the Complainant has a strong reputation in the motorcycle industry. Furthermore, the Complainant has provided evidence that the Respondent should have found information over the internet about Complainant's trademarks rights over its trademark rights before registering the Disputed Domain Names.

In addition to the above described and from the Panel perspective, the following circumstances also confirm Respondent's bad faith in the registration of the Disputed Domain Names:

(a) By conducting a search over the Internet, the Respondent should have been made aware of Complainant's trademarks "HARLEY DAVISON®" & "HARLEY®" trademarks as well as their reputation in the motorcycle industry;

(b) The Disputed Domain Name fully incorporates the trademarks "HARLEY DAVISON®" & "HARLEY®" which are only associated with the Complainant

(c) The Complainant's trademark rights over "HARLEY DAVISON®" & "HARLEY®" predate the date of registration of the Disputed Domain Names;

(d) The website associated with the Disputed Domain Names harleyy.vip is inactive;

These factors make the Panel believe that the Disputed Domain Names were registered with the intention to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

One additional argument presented by the Complaint relates to the fact that Respondent registered different domain names .VIP, incorporating well-known brands such as nestle.vip, teslausdt.vip, etc. While the evidence presented by the Complainant does not allow to confirm in its entirety that the owner of those domains is indeed the Respondent, the fact that those domains show "Lina" as the Registrant Contact - same name as Respondent – it gives an indication about the ownership of Respondent over those domains.

In this sense, past panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration. This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner. A pattern of abuse has also been found where the respondent registers, simultaneously or otherwise, multiple trademark-abusive domain names corresponding to the distinct marks of individual brand owners.

See paragraph 3.1.2 of the WIPO Jurisprudential Overview 3.0.

In light of the evidence presented to the Panel, including: a) the likelihood of confusion between the Disputed Domain Names and the Complainant's "HARLEY DAVISON®" & "HARLEY®" trademarks, b) the lack of reply to this Complaint by Respondent, c) the fact

that the Disputed Domain Name <harley.vip> is used to advertise crypto assets using the “HARLEY DAVISON®“ & “HARLEY®» trademarks, d) the fact that the Disputed Domain Name <harleyy.vip> is being passively held, d) the fact that the Respondent registered additional domains .VIP with well-known brands, the Panel draws the inference that the Disputed Domain Names were registered and are being used in bad faith.

Therefore, the Panel concludes that Respondent registered and is using the Disputed Domain Names in bad faith and thus has satisfied the requirement under 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. **harley.vip**: Transferred
2. **harleyy.vip**: Transferred

PANELLISTS

Name	**Victor Garcia Padilla**

DATE OF PANEL DECISION 2024-09-04

Publish the Decision