

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG v. Amrit Singh, Il mio negozio Case No. D2023-3831

1. The Parties

The Complainant is Bayerische Motoren Werke AG, Germany, represented by Kelly IP, LLP, United States of America (“U.S.”).

The Respondent is Amrit Singh, Il mio negozio, Italy.

2. The Domain Name and Registrar

The disputed domain name, <bmwm.store> (the “Domain Name”) is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 13, 2023. On September 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 14, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Contact Privacy Inc. Customer 0167703463) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 18, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on September 18, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 12, 2023. The Respondent sent informal communications and the Center sent a Possible Settlement email to the Parties on October 2, 2023. However, no formal Response was received from the Respondent. On October 18, 2023, the Center notified the Parties that it would proceed to panel appointment.

The Center appointed Wolter Wefers Bettink as the sole panelist in this matter on October 27, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant manufactures, sells, and distributes automobiles and motorcycles, and provides services, including maintenance and repair services and financing. The Complainant's headquarters are located in Germany, and it has additional locations in a number of countries around the world. The Complainant's products and components are manufactured at 31 sites in countries around the world, and the Complainant has more than 149,000 employees worldwide. The Complainant has a network of authorized dealers to market both new and certified pre-owned BMW vehicles and has more than 3,600 authorized BMW dealers in locations throughout the world. In each year from 2018 through 2022, the Complainant sold more than 2,028,000 automobiles and more than 162,000 motorcycles under its trade marks, which include, *inter alia* (hereafter together referred to as the "Trade Marks" or individually as a "Trade Mark"):

| Mark | Reg. No. | Registration date |
|-----------------------|----------|-------------------|
| Germany Registrations | | |
| BMW word mark | 410579 | November 15, 1929 |
| BMW device mark | 221388 | December 10, 1917 |
| U.S. Registrations | | |
| BMW word mark | 0611710 | September 6, 1955 |
| BMW device mark | 0613465 | October 4, 1955 |
| BMW word mark | 1164922 | August 11, 1981 |
| BMW M word mark | 4541350 | June 3, 2014 |

The Complainant developed its M model vehicles in 1972, which prominently display the BMW M Trade Mark, including, but not limited to, on the automobile's engine, exterior, and interior.

In use since 1917, the Trade Marks enjoy fame as a result of the extensive and long use and advertising, and favorable public acceptance and recognition worldwide, of the same. The Trade Marks have ranked in recognized lists of the world's top 100 of well-known and most valuable brands for at least the past 15 years.

The Domain Name was registered on June 29, 2023 and resolves to a website that purports to provide online retail store services selling various products, including T-shirts featuring the BMW M and other Trade Marks and various third party products.

5. Parties' Contentions

A. Complainant

In support of its demand for transfer of the Domain Name, the Complainant has made the submissions and statements set out in this section.

The Domain Name is confusingly similar to the well-known Trade Marks as it prominently features the Trade Marks and, in particular, the BMW M Trade Mark and merely adds the generic Top-Level Domain ("gTLD") ".store", which is insufficient to distinguish the Domain Name from the Trade Marks.

The Respondent has no rights or legitimate interests in the Domain Name as the Respondent listed in the WHOIS - Amrit Singh, Il mio negozio - is not commonly known by the Domain Name or any derivations thereof. In addition, the Complainant has not authorized the Respondent, or any associated person or entity, to use or register the Trade Marks in any manner, nor is the Respondent or any other associated person or

entity a current or former licensee of the Complainant and the Trade Marks. Furthermore, the Domain Name resolves to a webpage that purports to provide online retail store services selling various products, including T-shirts featuring the BMW M and other Trade marks without the Complainant's authorization, and various third party products. Such use of the Domain Name and the Trade Marks does not amount to a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use under the paragraphs 4(c)(i) and (iii) of the Policy.

With respect to bad faith registration, the evidence and totality of circumstances surrounding the Domain Name undoubtedly establish that the Respondent had actual knowledge of the Complainant and the Trade Marks prior to registering and using the Domain Name. The Complainant has continuously and exclusively used the Trade Marks around the world since at least 1917. Considering that the Domain Name contains the BMW M Trade Mark and was registered by the Respondent many years after the Complainant's first use thereof it is inconceivable that the Respondent did not have actual knowledge of the Complainant and the Trade Marks when registering the Domain Name. This is further established given that the Domain Name resolves to a website that purports to provide online retail store services selling *inter alia* t-shirts featuring the BMW M Trade Mark.

With respect to bad faith use, the evidence shows that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website located at the Domain Name, by creating a likelihood of confusion with the Trade Marks as to the source, sponsorship, affiliation, or endorsement of the Domain Name, the associated website, and/or the Respondent's activities. The Respondent uses the Domain Name, which is confusingly similar to the Trade Marks, to operate the webpage described above to pass itself off as the Complainant, or as affiliated with Complainant. This is likely to cause confusion in the marketplace, amounts to infringement of the Complainant's intellectual property rights, disrupts the Complainant's and its authorized dealers' businesses, and thereby indicates the Respondent's bad faith registration and use of the Domain Name under paragraphs 4(b)(iii) and (iv) of the Policy.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has shown that it has registered rights in the Trade Marks. The Domain Name is confusingly similar to the Trade Marks as it incorporates BMW, of which the Trade Marks consist, in its entirety. In addition, the Domain name is identical to the BMW M Trade Mark. The gTLD ".store" is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11). Therefore, the Panel finds that the Domain Name is confusingly similar to the Trade Marks in which the Complainant has rights.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, the second element a complainant has to prove is that a respondent lacks rights or legitimate interests in a domain name. This may result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge or control of the respondent. In order to satisfy the second element, the Complainant has to make out a *prima facie* case that the Respondent does not have rights or legitimate interests in the Domain Name. If the Complainant succeeds in doing so, the burden of production on this element shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Domain Name. If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element (see [WIPO Overview 3.0](#), section 2.1).

Based on the evidence and the undisputed submissions of the Complainant, the Panel concludes that the Respondent has not received the Complainant's consent to use the Trade Marks as part of the Domain Name and has not acquired trade mark rights in the Domain Name. In assessing whether the Respondent has rights or legitimate interests in the Domain Name, it should also be taken into account that (i) since the Domain Name incorporates the BMW M Trade Mark in its entirety, it carries a high risk of implied affiliation ([WIPO Overview 3.0](#), section 2.5.1); and (ii) the Respondent has not provided any evidence, nor is there any indication in the record of this case, that the Respondent is commonly known by the Domain Name. The Domain Name resolves to a website on which the BMW M Trade Mark is used and on which products are offered for sale. Therefore, the Respondent cannot (and in fact does not) show that it is making a legitimate noncommercial or fair use of the Domain Name (paragraph 4(c)(iii) of the Policy). Since, furthermore, the website offers for sale products purported to originate in the Complainant as well as products of third parties, there is no case of a *bona fide* offering of goods or services.

In view of the above, the Panel concludes that the Complainant has established that the Respondent has no rights or legitimate interests in the Domain Name.

C. Registered and Used in Bad Faith

Based on the information and the evidence provided by the Complainant, the Panel finds that at the time of registration of the Domain Name the Respondent was or should have been aware of the Trade Marks, since:

- the Respondent's registration of the Domain Name occurred 106 years after the registration of the earliest of the Trade Marks;
- the Trade Marks, through long and extensive use, have a worldwide reputation;
- the BMW Trade Mark has been in the top 100 of the most recognized brands worldwide for the past 15 years;
- a simple trade mark registration search, or even an Internet search, prior to registration of the Domain Name would have informed the Respondent of the existence of the Trade Marks.

With regard to bad faith use, the use of the Domain Name for a website which offers for sale products purported to originate in the Complainant as well as products of third parties, indicates that the Respondent intentionally attempts to attract, for commercial gain, Internet users to the website located at the Domain Name, by creating a likelihood of confusion with the Trade Marks as to the source, sponsorship, affiliation, or endorsement of the Domain Name, the associated website, and/or the Respondent's activities.

Furthermore, the Panel finds that the following circumstances taken together add to a finding of bad faith use of the Domain Name:

- the Respondent was more likely than not aware of the Complainant's rights in the Trade Marks;
- the use of a privacy shield upon the initial registration of the Domain Name;
- the lack of a formal Response of the Respondent.

Therefore, the Panel concludes that the Domain Name has been registered and is being used in bad faith.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <bmwm.store> be transferred to the Complainant.

/Wolter Wefers Bettink/

Wolter Wefers Bettink

Sole Panelist

Date: November 10, 2023