

ADMINISTRATIVE PANEL DECISION

Dr. Ing. h.c. F. Porsche AG v. PERFECT PRIVACY, LLC / Sunset Honda
Case No. D2022-1583

1. The Parties

The Complainant is Dr. Ing. h.c. F. Porsche AG, Germany, represented by UNIT4 IP Rechtsanwälte, Stolz Stelzenmüller Weiser Grohmann Partnerschaft mbB Rechtsanwälte, Germany.

The Respondent is PERFECT PRIVACY, LLC, United States of America (“United States”) / Sunset Honda, United States.

2. The Domain Names and Registrar

The disputed domain names <porschesanluisobispo.com> and <porscheslo.com> are registered with Network Solutions, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 2, 2022. On May 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 5, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 12, 2022, 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 amendment to the Complaint on May 16, 2022.

The Center verified that the Complaint together with the amendment to the 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 sent notification to the Respondent of the Complaint, and the proceedings commenced on June 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 3, 2022. The Respondent did not submit any response. Accordingly, the Center sent notification of the Respondent’s default on July 5, 2022.

The Center appointed Petra Pecar as the sole panelist in this matter on July 18, 2022. 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 is a world-famous manufacturer of sports cars for more than 70 years, using the trademark PORSCHE for its products.

The Complainant has protected the trademark PORSCHE by national and international trademark registrations worldwide, including the following:

- European Union Trade Mark No. 000073098 for PORSCHE, registered on December 12, 2000 in Classes 3, 8, 9, 12, 14, 16, 18, 21, 24, 25, 28, 34, 35, 36, 37, 39 and 42;
- International trademark registration No. 562572 for PORSCHE, registered on October 27, 1990 in Classes 12 and 42;
- International trademark registration No. 639048 for PORSCHE, registered on March 13, 1995 in Classes 3, 8, 9, 14, 16, 18, 21, 24, 25, 28, 33 and 34;
- International trademark registration No. 640976 for PORSCHE, registered on July 13, 1995 in Classes 36, 37, 39 and 42;
- International trademark registration No. 657048 for PORSCHE, registered on January 27, 1996 in Classes 36, 39 and 42;
- United States registration No. 618933 for PORSCHE, registered on January 10, 1956 in Class 12;
- United States registration No. 2112920 for PORSCHE, registered on November 11, 1997 in Class 14; and
- United States registration No. 2200107 for PORSCHE, registered on October 27, 1998 in Classes 39 and 42.

The Complainant also owns many domain names that incorporate its PORSCHE trademark, including <porsche.com>, registered in 1996, which resolves to the Complainant's official website with special sections devoted to national or regional audiences all over the world, including the United States and Germany. The Complainant owns many other domain names reflecting its PORSCHE trademark, some of which consist of its PORSCHE trademark and the name of the city, which are used by the local Porsche dealers, such as <porschedallas.com>. Complainant-produced cars are distributed through a network of Porsche Centers which include, *inter alia*, the city of San Luis Obispo, California.

The disputed domain names <porschesanluisobispo.com> and <porscheslo.com> were both registered on January 19, 2021 by the same registrant. According to the evidence provided by the Complainant, at the time of the submission of the Complaint, both disputed domain names resolved to parking pages with sponsored links ("Pay-Per-Click" or "PPC").

5. Parties' Contentions

A. Complainant

The Complainant asserts that it has prior rights in the PORSCHE trademark registrations and that the disputed domain names consist of the Complainant's world-famous name and trademark PORSCHE to

which is appended the name and common abbreviation of the city San Luis Obispo (“SLO”), which are geographical terms that refer to the location of the Porsche dealer. The Complainant claims that the disputed domain names are confusingly similar to its well-known trademark in which the Complainant has rights, and indicates earlier UDRP Panel decisions which determined that the addition of the name of a city or location to the trademark in a disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and trademark.

The Complainant asserts that the Respondent has no right or legitimate interests in respect of the disputed domain names, since the Complainant has never licensed or otherwise permitted the Respondent to use PORSCHE trademarks and/or the Porsche name. The Complainant also states that there has never been a business relationship between the Parties, that the Respondent is not commonly known by the disputed domain names, and that there is no evidence to suggest that the Respondent has used, or undertaken any demonstrable preparations to use, the disputed domain names in connection with a *bona fide* offering of goods or services. The Complainant also states that the disputed domain names resolve to parking pages with sponsored links/ads (PPC). These links are related to cars and to the Complainant’s well-known name and trademarks and redirect to further parking pages that also display ads/links to third parties’ commercial websites, which does not constitute a legitimate interest in the disputed domain names.

The Complainant claims that the Respondent registered and has been using the disputed domain names in bad faith, since the Respondent must have known of the Complainant and its trademarks, which have enjoyed an outstanding reputation worldwide for more than 70 years. The Complainant highlights its presence in the United States, where the Respondent allegedly resides, and its United States registration No. 618933 for PORSCHE which dates from January 10, 1956 and also indicates that the Respondent must have been aware of the Complainant and its trademarks. The Complainant further asserts that the disputed domain names are intentionally misleading the public because the public expect that the disputed domain names are associated with the Complainant, which is not the case, and that also supports the determination of bad faith.

It is also stated in the Complaint that the registration of the disputed domain names prevents the Complainant from registering or using the disputed domain names for its business and local dealerships in the area of San Luis Obispo. The Complainant also underlines that the Respondent concealed its true identity by using a “privacy service” which shows that the Respondent is acting in bad faith.

B. Respondent

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

6. Discussion and Findings

The Complaint relates to two disputed domain names, which the Complainant wishes to have dealt with in a single administrative proceeding. Paragraph 3(c) of the Rules states that the complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

In the present case, the Panel is satisfied that the disputed domain names are registered by the same domain-name holder in accordance with Paragraph 3(c) of the Rules.

Even if the Respondent did not file a Response to the Complainant’s contentions, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant. “A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”, as indicated in paragraph 15(a) of the Rules.

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- (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 by the Respondent in bad faith.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must, firstly, establish rights in a trademark or service mark and, secondly, establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"). The Panel finds that the Complainant has provided evidence of ownership of registrations for the PORSCHE trademarks, demonstrating that it has rights in the PORSCHE trademarks, through registrations and use, which significantly predate the registration date of the disputed domain names.

The Panel finds that the disputed domain names incorporate the PORSCHE trademark in its entirety. Besides the trademark, the disputed domain names consist also of a geographic term, "sanluisobispo" or its common abbreviation "slo", and the generic Top-Level domain (gTLD) ".com". Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) do not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademarks, in accordance with section 1.8 of the [WIPO Overview 3.0](#).

Finally, it is well accepted practice of UDRP panels that an applicable gTLD, such as ".com", is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark (see section 1.11.1 of the [WIPO Overview 3.0](#)). Accordingly, the Panel shall not take the applicable gTLD ".com" into account for the purposes of assessment of confusing similarity.

In accordance with the above, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and in demonstrating that the disputed domain names are confusingly similar to the PORSCHE trademarks.

B. Rights or Legitimate Interests

Under the second element of the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is generally deemed to have satisfied the second element, as set out in paragraph 4(a)(ii) of the Policy (see also section 2.1 of the [WIPO Overview 3.0](#)).

Moreover, the Policy provides guidance to respondents on how to demonstrate rights or legitimate interests in a domain name. In particular, paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name, including: (i) use of the domain name "in connection with a *bona fide* offering of goods or services"; or (ii) demonstration that the Respondent has been "commonly known by the domain name"; or (iii) "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".

It appears that the Respondent has no rights or legitimate interests in respect of the disputed domain names considering the Complainant's assertions that it has not authorized the Respondent to use the PORSCHE

name and/or trademarks. Based on the evidence provided by the Complainant, the Panel finds that there is no evidence to suggest that the Respondent has used, or undertaken any demonstrable preparations to use, the disputed domain names in connection with a *bona fide* offering of goods or services. According to section 2.9 of the [WIPO Overview 3.0](#), the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users.

Moreover, there is no indication that the Respondent is commonly known by the disputed domain names or any similar names, nor is there evidence that the Respondent is making legitimate noncommercial or fair use of the disputed domain names.

The Panel notes that the Respondent did not file a formal response and has therefore failed to prove that it enjoys rights or legitimate interests in the disputed domain names.

The Panel therefore finds that the Complainant has made a *prima facie* demonstration of the Respondent's lack of rights or legitimate interests in respect of the disputed domain names, which has not been rebutted by the Respondent, and that the Complainant has accordingly established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires the Complainant to demonstrate that the Respondent registered and is using the disputed domain names in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a Respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when, by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

Based on the information and the evidence provided by the Complainant, the Panel finds that at the time of registration of the disputed domain names, the Respondent was or should have been aware of the Complainant's trademarks, since the Complainant's earliest trademark registration in the United States dates from 1956, *i.e.*, 65 years before the registration of the disputed domain names. Even a simple online search for the term PORSCHE would have revealed that it is a world-renowned brand. Given the extensive prior use and fame of these marks, in the opinion of the Panel, the Respondent should have been aware of the Complainant's trademarks when registering the disputed domain names.

The Respondent has provided no evidence to justify its registrations of the disputed domain names and therefore it seems rather unlikely that the Respondent's adoption of the uncommon and distinctive PORSCHE trademark was a mere coincidence.

The Panel is therefore of the view that the Respondent registered the disputed domain names with full knowledge of the Complainant's trademarks. Moreover, the construction of the disputed domain names themselves, namely the combination of the Complainant's trademark with the additional geographical terms referring to the city of San Luis Obispo in California and its common abbreviation "SLO" refer to the location of one of the Complainant's local dealers, implying that the Respondent was aware of the Complainant and its goods and services.

Furthermore, the disputed domain names resolve to parking pages with sponsored links (PPC) and the Respondent registered them through a privacy service (privacy shield). Use of privacy or proxy services in order to avoid being notified of a UDRP proceeding filed against the respondent commonly supports an inference of bad faith in accordance with the practice of previous UDRP panels (see section 3.6 of the [WIPO Overview 3.0](#)).

The Panel finds it likely that the Respondent used the inherently misleading disputed domain names as parking pages comprising competing PPC links to purposefully exploit the popularity of the Complainant's trademarks for profit.

In these circumstances where the Respondent has offered no explanation for the registration of the disputed domain names, the Panel finds that the Respondent is using the disputed domain names to intentionally attempt to attract, for commercial gain, Internet users to the PPC pages resolving on the disputed domain names by creating a likelihood of confusion with the Complainant's trademark.

Accordingly, the Panel finds that the disputed domain names were registered and are being used in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

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 names, <porschesanluisobispo.com> and <porscheslo.com>, be transferred to the Complainant.

/Petra Pecar/

Petra Pecar

Sole Panelist

Date: August 1, 2022