

## **ADMINISTRATIVE PANEL DECISION**

Dr. Ing. h.c. F. Porsche AG v. Registration Private, Domains By Proxy, LLC /  
Tiffany Bomar, Carlock Automotive Group  
Case No. D2022-2396

### **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 Registration Private, Domains By Proxy, LLC, United States of America (“United States”) / Tiffany Bomar, Carlock Automotive Group, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <porschejackson.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 30, 2022. On July 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 5, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on July 6, 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 on July 11, 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 notified the Respondent of the Complaint, and the proceedings commenced on July 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 2, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 3, 2022.

The Center appointed Miguel B. O'Farrell as the sole panelist in this matter on August 8, 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, Dr. Ing. h.c. F. Porsche AG, has manufactured the famous PORSCHE sport cars for over 70 years using the prominent and distinctive part in its company name/trade name.

The Complainant owns several trademark registrations worldwide for PORSCHE including the following:

European Union Trademark Registration No. 000073098 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 PORSCHE, registered on October 27, 1990 in classes 12 and 42;

United States Trademark Registration No. 0618933 PORSCHE, registered on January 10, 1956 for automobiles and parts thereof in class 12;

United States Trademark Registration No. 2112920 PORSCHE, registered on November 11, 1997 in class 14;

United States Trademark Registration No. 2200107 PORSCHE, registered on October 27, 1998 in classes 39 and 42.

In 1996, the Complainant registered the domain name <porsche.com> which relates to a website with special sections directed national or regional audiences in many parts of the world, including the United States of America.

The disputed domain name <porschejackson.com> was registered on March 25, 2019 and does not resolve to an active website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant and its world-famous name and trademarks PORSCHE have enjoyed an outstanding reputation worldwide for more than 70 years.

The PORSCHE cars are distributed through a network of Porsche Centers, covering *inter alia* the city Jackson in the USA.

The Complainant owns several domain names consisting of "Porsche + city" used by its local Porsche dealers, for example <porschedallas.com> (see WIPO Case No. [D2018-2456](#) "*Dr. Ing. H.c.F. Porsche AG v. Privacydotlink Customer 3692605 / Carlos Fuentes*"). However, the Complainant is unable to register and use the disputed domain name accordingly due to the disputed domain registration that blocks this domain.

In essence, the Complainant claims that the disputed domain name is confusingly similar with the trademark PORSCHE in which the Complainant has rights and that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

More specifically, there is not and has never been a business relationship between the parties.

The Complainant has not licensed or otherwise permitted the Respondent to use its name and trademarks.

The Respondent is not commonly known by the disputed domain name, which obviously points and is exclusively associated with the world-famous Complainant.

The disputed domain name was registered primarily for the intention of disrupting the business of the Complainant.

Finally, the Complainant requests the Panel to issue a decision ordering that the disputed domain name be transferred to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with 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 disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

As set forth in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is confusingly similar with the Complainant's PORSCHE trademark.

The disputed domain name incorporates the Complainant's trademark PORSCHE in its entirety with the addition of the term "Jackson" which, pursuant to sections 1.7 and 1.8 of [WIPO Overview 3.0](#), does not prevent a finding of confusing similarity.

The ".com" generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark PORSCHE in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

## **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following non-exclusive defenses:

- (i) before any notice to it of the dispute, the respondent's use of, or 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 has been commonly known by the domain name, even if it 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.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established, as it is put in section 2.1 of [WIPO Overview 3.0](#), that 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 disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other circumstances to suggest that the Respondent has rights or legitimate interests in the disputed domain name.

Likewise, and as further discussed under section 6.C of this Decision, it does not seem that the Respondent is making any legitimate noncommercial or fair use of the disputed domain name, but rather it is not using the disputed domain name to resolve to a website.

As established in section 2.5 of [WIPO Overview 3.0](#): "Fundamentally, a respondent's use of a domain name will not be considered 'fair' if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant's mark is often central to this inquiry." Here, the nature of the disputed domain name carries a risk of implied affiliation.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name (*Telstra Corporation Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

## **C. Registered and Used in Bad Faith**

The Panel is satisfied that the Respondent must have been aware of the Complainant's trade name and trademark PORSCHE when it registered the disputed domain name on March 25, 2019.

By registering the disputed domain name, the Respondent was targeting the Complainant and its business by incorporating the Complainant's trademark PORSCHE in its entirety with the addition of what is likely meant to be the city name Jackson, Mississippi, with intention to confuse Internet users and lead them to think that the relevant website belongs to the Complainant's distributor in that city (given the Complainant's naming convention) and thereby capitalize on the fame of the Complainant's name and trademark for its own

monetary benefit.

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name is also a significant factor to consider that the disputed domain name was registered in bad faith, as stated in section 3.2.1 of [WIPO Overview 3.0](#).

Furthermore, UDRP panelists have found that a domain name that resolves to an inactive website does not prevent a finding of bad faith under the doctrine of "passive holding" when circumstances exist such as the distinctiveness or reputation of the complainant's mark, the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good faith use, the respondent's use of a privacy service to mask its identity, and the implausibility of any good faith use to which the disputed domain name may be put. The Panel finds that all these circumstances are relevant to this administrative proceeding and that the current non-use of the disputed domain name does not prevent a finding of bad faith in these circumstances (section 3.3 of [WIPO Overview 3.0](#)).

For the above reasons, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy have been fulfilled.

## **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 <porschejackson.com> be transferred to the Complainant.

*/Miguel B. O'Farrell/*

**Miguel B. O'Farrell**

Sole Panelist

Date: August 19, 2022