

ADMINISTRATIVE PANEL DECISION

Gustav Magenwirth GmbH & Co. KG v. xieg bohk
Case No. D2022-4891

1. The Parties

The Complainant is Gustav Magenwirth GmbH & Co. KG, Germany, represented by Lipsitz & McAllister, LLC, United States of America (“United States”).

The Respondent is xieg bohk, Hong Kong, China.

2. The Domain Names and Registrar

The disputed domain names <magurabike.com> and <maguracycling.store> are registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 20, 2022. On December 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On December 22, 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 (Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 4, 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 amendment to the Complaint on January 4, 2023.

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 January 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 13, 2023.

The Center appointed Andrew F. Christie as the sole panelist in this matter on February 20, 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 has used the word trademark MAGURA and its corresponding stylized trademark in connection with various parts for bicycles, motorcycles, and other motorized vehicles and machines since at least as early as 1990.

The Complainant owns several trademark registrations for the word and stylized MAGURA trademarks including United States Trademark Registration No. 3594989 (registered on March 24, 2009) for the word trademark MAGURA and United States Trademark Registration No. 1830232 (registered on April 12, 1994) for the stylized trademark MAGURA.

The disputed domain names were registered on June 16, 2022. The Complaint did not contain any evidence showing the Respondent's use of the disputed domain names. However, the Panel has established that, at the time of this decision: (i) the disputed domain name <magurabike.com> resolved to a website at which bicycle parts and accessories containing the MAGURA word trademark were offered for sale; and (ii) the disputed domain name <maguracycling.store> resolved to a website at which bicycle parts and accessories containing the MAGURA word trademark were offered for sale, and on which appeared the MAGURA stylized trademark.

5. Parties' Contentions

A. Complainant

The Complainant made the following contentions to establish that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights. The Respondent is using the Complainant's identical trademark MAGURA in its URLs and on its websites. The Respondent is also using the Complainant's gear logo on its websites.

The Complainant made the following contentions to establish that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent's websites resolving from the disputed domain names are purporting to sell the Complainant's original MAGURA products and use the Complainant's MAGURA trademark in their URLs and on their websites, along with the Complainant's gear logo. The Respondent is not a MAGURA dealer and is not in any way authorized to use the Complainant's trademarks. The Respondent is passing off goods on its website as originating from the Complainant. The Complainant's attempts to order goods via the website were unsuccessful, with credit card information being accepted but no charge incurred or goods shipped.

The Complainant made the following contentions to establish that the disputed domain names were registered and are being used in bad faith. The disputed domain names use well-known trademarks of the Complainant, as evidenced by the display for sale on the websites resolving from the disputed domain names of exact images of the Complainant's products at significantly lower prices. Such use of the Complainant's trademarks can be for no other reason than to disrupt the Complainant's business and to cause confusion.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

Once the generic Top-Level Domain (“gTLD”) extensions “.com” and “.store” are disregarded (which is appropriate in this case), the disputed domain names consist of the Complainant’s registered word trademark MAGURA, followed by “bike” in the first disputed domain name and “cycling” in the second disputed domain name. The Complainant’s trademark is clearly recognizable within the disputed domain names. The addition of the words “bike” and “cycling”, which are descriptive of the Complainant’s business, does not avoid a finding of confusing similarity of the disputed domain names with the Complainant’s word trademark. Accordingly, the Panel finds that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights

B. Rights or Legitimate Interests

The Respondent is not a licensee of the Complainant, is not otherwise affiliated with the Complainant, and has not been authorized by the Complainant to use its MAGURA word trademark or stylized trademark. The Respondent has not provided any evidence that it has been commonly known by, or has made a *bona fide* use of, the disputed domain names, or that it has, for any other reason, rights or legitimate interests in the disputed domain names. The Panel has established that the disputed domain names have been used to resolve to websites both of which purport to offer MAGURA products for sale at discounted prices, and one of which displays the Complainant’s MAGURA stylized trademark. The contents of the Respondent’s websites are such that many Internet users will form the false belief that the websites are operated by, or affiliated with, the Complainant. Given the confusing similarity of the disputed domain names to the Complainant’s trademark, the absence of any relationship between the Respondent and the Complainant, and the failure to avoid the implied false affiliation with the Complainant, the Respondent’s use of each disputed domain name is neither a *bona fide* use nor a legitimate noncommercial or fair use.

The Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, and the Respondent has not rebutted this. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

The disputed domain names were registered several decades after the Complainant first registered its MAGURA word trademark and stylized trademark. It is inconceivable that the Respondent registered the disputed domain names ignorant of the existence of the Complainant’s trademarks, given that: (i) each disputed domain name consists of the Complainant’s word trademark with the mere addition of a word that is descriptive of the Complainant’s business; and (ii) the Respondent used each disputed domain name to resolve to a website that displays the Complainant’s MAGURA word trademark and/or stylized trademark, and which purports to offer for sale the Complainant’s goods.

Given the Respondent’s lack of rights or legitimate interests in the disputed domain names and the confusing similarity of the disputed domain names to the Complainant’s word trademark, any use of the disputed domain names by the Respondent almost certainly implies an affiliation with the Complainant that does not exist. The Respondent’s registration of the disputed domain names in these circumstances is a bad faith registration.

Furthermore, the Panel has established that the Respondent has used the disputed domain names in an attempt to attract, for commercial gain, Internet users to websites by creating confusion in the minds of the public as to an association between the websites and the Complainant. The Respondent’s use of the disputed domain names in this manner is a bad faith use.

Accordingly, the Panel finds that the disputed domain names have been registered and are 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 names, <magurabike.com> and <maguracycling.store>, be transferred to the Complainant.

/Christie, Andrew F/

Christie, Andrew F

Sole Panelist

Date: March 5, 2023