

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG v. JK WebApp Case No. D2023-1698

1. The Parties

Complainant is Bayerische Motoren Werke AG, internally represented.

Respondent is JK WebApp, India.

2. The Domain Name and Registrar

The disputed domain name <bmw-bike.org> (the “Domain Name”) is registered with Hostinger, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 18, 2023. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 19, 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 (Privacy Protect, LLC) and contact information in the Complaint.

The Center sent an email to Complainant on April 28, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on May 2, 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 Respondent of the Complaint, and the proceedings commenced on May 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2023. The Center received informal communications from an email address using “jkwebapp[...].” as part of the email address and another email address connected to the domain name <jkwebapp.in>, but Respondent did not submit any formal response. Accordingly, the Center notified the Commencement of Panel Appointment Process on May 31, 2023.

The Center appointed Robert A. Badgley as the sole panelist in this matter on June 2, 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.

On June 20, 2023, the Panel issued the following Procedural Order No. 1:

“In accordance with the Panel’s powers under paragraphs 10 and 12 of the Rules for Uniform Domain Name Dispute Resolution Policy, considering the Respondent’s allegation that the disputed domain name was registered for a client, and that the named Respondent provides email addresses that were never used for the notification of the Complaint (*i.e.*: [...]@gmail.com, and [...]@startdistributor.com), the Panel issues this Procedural Order No. 1, by virtue of which:

- the Respondent and the person/entity using [...]@gmail.com, and/or [...]@startdistributor.com is invited to submit a response to the Complaint, and/or explain its registration or use of the disputed domain name by June 25, 2023;
- the Complainant is invited to comment on such response, if any, by June 30, 2023.”

“The Parties’ further submissions should be limited to the above request. Any submissions should be directed to the WIPO Arbitration and Mediation Center, copying the other Party.”

“The Decision due date is extended to July 5, 2023”.

No response to Procedural Order No. 1 was submitted.

4. Factual Background

Founded in 1916, Complainant is a leading manufacturer of automobiles. Complainant also manufactures motorcycles. Like bicycles, motorcycles are often referred to colloquially as “bikes”.

Complainant’s vehicles are sold under the trademark BMW, a mark which is registered in numerous countries (including India, Respondent’s reported country). Annexed to the Complaint are details about Complainant’s numerous trademark registrations, including German trademark 221,388 (registered on December 10, 1917 and Indian trademark 2244668 (registered on September 8, 2017). Complainant has sales operations in more than 140 countries, and maintains sales and service centers in several Indian cities, including Pune (Respondent’s city).

The BMW mark has been recognized repeatedly as one of the top 100 brands in the world, as is evidenced by various surveys annexed to the Complaint.

Complainant operates a website at the domain name <bmw.com>, and owns numerous other BMW-formative domain names, including <bmw.in> for India. Complainant also maintains a robust social media presence.

The Domain Name was registered on January 12, 2023. The Domain Name does not currently resolve to an active website. According to Complainant, however:

“The Domain Name is used for fraudulent activities by approaching the public by way of emails. The Domain Name has been used to reach out to people in India via email offering fake BMW motorbike dealerships for the Indian market. (...) In [a January 16, 2023] email, the Respondent portrays itself as an Indian subsidiary of BMW. The email makes explicit reference is made to BMW INDIA PVT. LTD which is the official Indian subsidiary of Complainant by stating ‘Greetings from BMW India Pvt. Ltd’. The idea behind this fake offering is obviously to trick people into transferring money to Respondent without receiving anything in return. The general public will believe that there is an association/link with the Complainant Company.”

“(…) The fraudulent activity becomes even more apparent from the two attachments that were sent with the above-mentioned email (…). The first attachment shows a fake catalogue of BMW motorbikes using the famous BMW logos without any authorization from Complainant. (…) The second attachment contains a fake BMW district dealership application form which is used to solicit or ‘phish’ for users’ confidential information.”

Respondent has not denied any of the foregoing allegations.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not reply to Complainant’s contentions. A party purporting to be associated with Respondent stated, in two separate emails, that Respondent is a website developer who registered the Domain Name at the behest of a client, but Respondent has no control over the Domain Name.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark BMW through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The Domain Name incorporates the BMW mark in its entirety and adds the word “bike.” The BMW mark is clearly recognizable within the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your 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) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or

- (iii) you [Respondent] are 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 Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name. Respondent did not come forward to dispute the serious allegations raised in the Complaint, and no one responded to Procedural Order No. 1 to assert and support with evidence that Respondent and the person using the Domain Name for fraudulent purposes are not one and the same person. Thus, the Panel will treat all named Respondents, all persons with the email addresses cited in Procedural Order No. 1, and the person using the Domain Name for fraudulent email purposes, as a single person.

Whether Respondent registered the Domain Name for its own nefarious purposes or did so at the behest of a disreputable client, the use to which the Domain Name has been put – a fraudulent website falsely purporting to be affiliated with Complainant and the famous BMW mark, and seeking to phish for the confidential and financial information of unwitting Internet users – is plainly illegitimate.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation,” are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes, on this record, that Respondent has registered and used the Domain Name in bad faith under the Policy. The reasons set forth in the previous section apply with equal vigor here. Respondent’s conduct constitutes bad faith registration and use within the meaning of the above-quoted Policy paragraph 4(b)(iv).

Complainant has established Policy paragraph 4(a)(iii).

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 Domain Name <bmw-bike.org> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: June 26, 2023