

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG v. Omega Motors Ltd.

Case No. DGE2023-0005

1. The Parties

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

The Respondent is Omega Motors Ltd., Georgia.

2. The Domain Name and Registry

The disputed domain name <bmw.com.ge> is registered with World Wide Web Intelligence LTD, doing business as namespace.ge.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 23, 2023. On January 24, 2023, the Center transmitted by email to the .GE Registry a request for registry verification in connection with the disputed domain name. On January 25, 2023, the .GE Registry transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .GE Domain Name Dispute Resolution Policy (the .GE Policy), the Rules for .GE Domain Name Dispute Resolution Policy (the .GE Rules), and the WIPO Supplemental Rules for .GE Domain Name Dispute Resolution Policy (the Supplemental Rules).

In accordance with the .GE Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 31, 2023. In accordance with the .GE Rules, paragraph 5, the due date for Response was February 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 22, 2023.

The Center appointed Andrew F. Christie as the sole panelist in this matter on February 28, 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 .GE Rules, paragraph 7.

4. Factual Background

The Complainant is a corporation organized under the laws of Germany and, together with its affiliated companies, is part of the BMW Group. The Complainant manufactures, sells, and distributes automobiles and motorcycles, and provides numerous services, including maintenance and repair services and financing. In each year from 2017-2021, the Complainant has sold more than 2 million automobiles and more than 160,000 motorcycles under the BMW trademark. The Complainant's products and components are manufactured at 31 sites in countries around the world, and it has more than 118,000 employees worldwide. In 2021, the Complainant had worldwide sales and revenue exceeding EUR 11 billion. The Complainant has for decades utilized a network of authorized dealers and importers to market both new and certified pre-owned BMW vehicles, and has more than 3,500 authorized dealers and importers throughout the world, including in the country of Georgia.

The Complainant has continuously used BMW as a trademark since 1917, and owns numerous trademark registrations for BMW and variations thereof, covering more than 140 countries around the world, including German Trademark Registration No. 410579 (registered on November 15, 1929) and International Trademark Registration No. 663925 (registered on December 22, 1995, and designating Georgia on August 19, 1999), both for the word trademark BMW.

The Complainant's online network, which it has operated since at least as early as 1996, receives millions of hits each month. Its websites are accessible via domain names comprised of the trademark BMW combined with relevant geographic and/or descriptive terms, including <bmw.com>, <bmwgroup.com> and <bmwusa.com>.

The Complainant has for years permitted its authorized dealers and authorized importers to use domain names comprised in part of BMW for their authorized BMW businesses, subject to the terms of various agreements and licenses. The Complainant's national importers' domain names are frequently comprised of a main string being BMW and a country-code Top-Level Domain ("ccTLD") being the importers' market. The Respondent was previously an authorized BMW importer for the country of Georgia under the terms of an importer agreement (the "Importer Agreement"), which expired on December 31, 2022. Under the terms of the Importer Agreement, as well as an accompanying license agreement from the Complainant for registration and use of the disputed domain name (the "License Agreement"), which also expired on December 31, 2022, the Respondent was authorized to register and use the disputed domain name with its authorized BMW importer business from 2005 until the expiration of the agreements. Under the terms of the License Agreement, the Respondent is expressly required to transfer the disputed domain name upon expiration of the Importer Agreement. On December 1, 2022, the Complainant sent the Respondent a letter advising on the expiration of the Importer Agreement and License Agreement and requesting that the Respondent transfer the disputed domain name on or after December 31, 2022. The Respondent has not replied to the Complainant's letter and has not transferred the disputed domain name.

The disputed domain name was registered on February 28, 2005. The Complainant has provided a screenshot, taken on January 12, 2023, showing that the disputed domain name resolved to a page displaying the message "This site can't be reached". The Complainant has also provided a screenshot, taken on January 17, 2023, showing that the URL "https://www.bmw.com.ge/en/index.html" resolved to a webpage featuring the Complainant's BMW trademark and photographs of the Complainant's products, which is very similar to the Complainant's authorized webpages for its BMW brand. At the time of this decision, neither the disputed domain name nor the URL "https://www.bmw.com.ge/en/index.html" resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant made the following contentions to establish that the disputed domain name is confusingly

similar to a trademark in which the Complainant has rights. The disputed domain name consists solely of BMW and adds the ccTLD “.com.ge”. This minor addition of the domain extension does not distinguish the disputed domain name from the BMW trademark. Domain extensions, such as “.com.ge” are irrelevant for analysing the identity or confusing similarity of a domain name to a trademark.

The Complainant made the following contentions to establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Panels generally assess whether a respondent has any rights or legitimate interests in a domain name based on the circumstances prevailing at the time the complaint is filed. The Respondent cannot establish rights or legitimate interests in the disputed domain name based on the Respondent's prior authorized registration and use of it under the Importer Agreement and License Agreement, because these expired on December 31, 2022, which terminated any legitimate basis for the Respondent to register and use the disputed domain name. The Respondent is not commonly known by the disputed domain name. The Respondent's current use of the disputed domain name does not constitute a *bona fide* offering of goods or services, and does not constitute a noncommercial or fair use. One of the apparent uses of the disputed domain name is in a URL for a website which prominently displays, without authorization, the Complainant's BMW trademark. Neither the Respondent nor any associated person or entity is currently authorized to use or register the BMW trademark in any manner, and neither the Respondent nor any other associated person or entity is a current licensee of the Complainant's BMW trademark. The URL “https://www.bmw.com.ge/en/index.html” resolves to a webpage that features the Complainant's official website content, and which conveys the false impression to customers that they are purchasing BMW cars or requesting service appointments from an authorized importer or dealership from this website. This website does not accurately or prominently disclose the true and current relationship between the Respondent, the disputed domain name, and the Complainant. The Respondent has not responded to the Complaint, so the Panel may presume that the Respondent lacks rights and legitimate interests in the disputed domain name.

The Complainant made the following contentions to establish that the disputed domain name was registered and is being used in bad faith. The Respondent intentionally attempted to attract, for commercial gain, Internet users to the website located at the disputed domain name by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the disputed domain name, the associated website, and/or the Respondent's activities. The disputed domain name is identical and confusingly similar to the Complainant's BMW trademark. The URL “https://www.bmw.com.ge/en/index.html” resolves to a webpage displaying, without authorization, the Complainant's intellectual property, including its BMW trademark, and conveys to customers the false impression that they are purchasing BMW cars or requesting service appointments from an authorized importer or dealership from this website, which is not the case. The Respondent had actual knowledge of the Complainant and its rights in its BMW trademark prior to continuing to use and hold the disputed domain name after the Importer Agreement and License Agreement expired on December 31, 2022, and that this conduct was contrary to the terms of those agreements. The Respondent chose to continue to use and hold the disputed domain name after December 31, 2022, in a calculated attempt to impersonate the Complainant or otherwise create the false impression that the Respondent, the disputed domain name, and the associated website were still officially connected or affiliated with the Complainant, or otherwise to prevent the Complainant and its new authorized importer for the Georgia market from having access to and using the disputed domain name. The Complainant sent the Respondent a letter on December 1, 2022, advising on the expiration of the Importer Agreement and License Agreement, and requesting that the Respondent transfer the disputed domain name on or after December 31, 2022. The Respondent has not replied to that request and has not transferred the disputed domain name.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

Once the ccTLD “.com.ge” is ignored (which is appropriate in this case), the disputed domain name consists solely of the Complainant’s registered word trademark BMW.

Accordingly, the Panel finds that the disputed domain name is identical to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

From 2005 to December 31, 2022, the Respondent was an authorized BMW importer for the country of Georgia pursuant to the terms of the Importer Agreement. Under the Importer Agreement, the Respondent was provided with rights to use the Complainant’s BMW trademark. The License Agreement extended the Respondent’s rights to the BMW trademark to include the registration and use of the disputed domain name. However, the License Agreement provides that the Respondent is required to transfer the disputed domain name to the Complainant upon expiration of the Importer Agreement. The Importer Agreement expired on December 31, 2022. As a consequence, the Respondent is no longer a licensee of the Complainant, is no longer affiliated with the Complainant, is no longer authorized to use the Complainant’s BMW trademark, and is required to (but has failed to) transfer the disputed domain name to the Complainant.

Furthermore, noting the composition of the disputed domain name, it carries a high risk of implied affiliation, and it effectively impersonates or suggests sponsorship or endorsement by the Complainant.

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

C. Registered or Used in Bad Faith

The disputed domain name was registered by the Respondent when it was authorized by the Complainant to do so under the terms of the License Agreement. However, the Respondent was obliged by the License Agreement to transfer the disputed domain name to the Complainant upon expiration of the License Agreement on December 31, 2022, which it has failed to do. The evidence provided by the Complainant shows that, after the expiration of the License Agreement and in breach of the terms of the License Agreement, the Respondent used the disputed domain name in a URL which resolved to a website at which an affiliation with the Complainant was falsely implied. That is a bad faith use of the disputed domain name.

Accordingly, the Panel finds that the disputed domain name has been used in bad faith.

7. Decision

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

/Andrew F. Christie/

Andrew F. Christie

Sole Panelist

Date: March 12, 2023