

## **ADMINISTRATIVE PANEL DECISION**

**Bayerische Motoren Werke AG v. Host Master, Tulip Trading Company Limited**

**Case No. D2023-0276**

### **1. The Parties**

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

The Respondent is Host Master, Tulip Trading Company Limited, Saint Kitts and Nevis.

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

The disputed domain name <bmwalexandria.com> is registered with Above.com, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 20, 2023. On January 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 24, 2023, 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 (Privacy Protected) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 30, 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 amended Complaint on January 30, 2023.

The Center verified that the Complaint together with the amended 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 31, 2023. In accordance with the 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 21, 2023.

The Center appointed C. K. Kwong as the sole panelist in this matter on March 7, 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, Bayerische Motoren Werke AG, a corporation organized under the laws of Germany, is the owner of numerous trademarks consisting of or comprising the letters "bmw". These registrations include:

1. German Trademark Registration No. 410579 for the mark BMW, registered on November 15, 1929, in respect of goods under international classes 7 and 12;
2. German Trademark Registration No. 221388 for the mark BMW and device, registered on December 10, 1917, for goods under international classes 7, 8, 9, 11, and 12;
3. United States Trademark Registration No. 611710 for the mark BMW, registered on September 6, 1955, for goods under international class 12;
4. United States Trademark Registration No. 1164922 for the mark BMW registered on August 11, 1981, in respect of services under international classes 37 and 42.

The evidence produced by the Complainant shows its first registration for the mark BMW well before the registration of the disputed domain name <bmwalexandria.com> on December 15, 2017.

The disputed domain name resolves to a website with pay-per-click hyperlinks that display advertising for, and redirect visitors to, various third party website and services, some of which relate or compete with the Complainant. The website also contains a message that the disputed domain name "Might Be For Sale" and invites visitors to make an offer for the disputed domain name by using the prescribed form as shown in Exhibit 8 to the Amended Complaint.

Other than the particulars shown in the printout of the database searches conducted by the Complainant on the Whois Database (as provided in Exhibit 1 to the Amended Complaint), the webpages shown in Exhibits 8 to the Amended Complaint, there is no evidence concerning the background, businesses or activities of the Respondent.

The Complainant owns, *inter alia*, the domain name <bmw.com> and <bmwgroup.com> to operate its international portal websites as well as country-specific and region-specific websites using BMW-formative domain names such as <bmwusa.com>, <bmw.ca>, and <bmw.de> as shown in Exhibit 5 to the Amended Complaint for providing information on the Complainant's products and services.

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

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

The Complainant has made the following contentions:

The Complainant is one of the most successful manufacturers of automobiles and motorcycles in the world. It has manufactured, marketed and sold many millions of vehicles under the BMW mark.

While headquartered in Germany, the Complainant's products and components are manufactured in 31 countries around the world with more than 118,000 employees worldwide.

For decades, the Complainants has been utilizing a network of authorized dealers and importers to market both new and certified pre-owned BMW vehicles. It has more than 3,500 authorized BMW dealers and importers throughout the world including Alexandria, Virginia.

Over the years, the Complainant has spent tens of millions of dollars annually to advertise, market and promote the BMW name and mark in connection with its products and services through a variety of media, including television and print advertisements, the Internet and high profile sponsorship.

As a result of the extensive and long use and advertising since 1917, the BMW mark has become one of the most recognized brands in the world.

Other than the international portal websites located at the domain name <bmw.com> and <bmwgroup.com>, BMW's customers may also go to BMW's country-specific or region-specific websites, such as those at <bmwusa.com>, <bmw.ca>, and <bmw.de>, for retailed and geographically relevant information regarding BMW products and services.

In addition to its own corporate websites, BMW has for years permitted on agreed terms, its authorized dealers and importers to use trade names and domain names embodying the BMW mark. Such domain names are frequently comprised of the BMW mark as the main domain string and a geographic location and/or a country code domain extension reflecting the dealers' or importers' particular market. For example, the authorized BMW dealer for Alexandria, Virginia does business under the name "BMW of Alexandria" and operates online from the domain name <bmwofalexandria.com> [see Exhibit 6 to the Amended Complaint].

As a result, persons seeing domain names consisting of the BMW mark combined with geographic locations and/or country code domain extensions will believe that the corresponding website is owned, operated and/or authorized by BMW.

The Complainant has continuously used BMW as a trademark and service mark since 1917. It owns numerous registrations for the BMW mark and variations thereof in more than 140 countries around the world.

The disputed domain name prominently starts with and has included the Complainant's famous BMW mark in its entirety. Merely adding the geographic description "Alexandria" and the domain extension ".com" are insufficient to obviate the risk of confusion. The confusion is further increased in this case because the disputed domain name is almost identical to that used by BMW's authorized dealer for Alexandria, Virginia who actually operates online at the domain name <bmwofalexandria.com> with only the word "of" being omitted.

The Whois record for the disputed domain name was initially privacy protected and did not identify a registrant. This is evidence that the Respondent is not commonly known as <bmwalexandria.com>.

The Complainant has not authorized or licensed the Respondent to use or register the BMW mark in any manner. The Respondent uses the disputed domain name to host pay-per-click hyperlinks that display advertising for and redirect visitors to various third party websites and services, some of which relate to or compete with the Complainant. It does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the domain name to claim legitimate rights or interests in the disputed domain name.

The website to which the disputed domain name resolves, displays the message that the disputed domain name might be for sale and invites visitors to make an offer for the disputed domain name, presumably for valuable consideration in excess of the out of pocket costs associated with registering the disputed domain name.

The Respondent intentionally attempted to attract for commercial gain Internet users to the websites to which the disputed domain name resolves by creating a likelihood of confusion with the Complainant's mark as to

the source, sponsorship, affiliation or endorsement of the disputed domain name, the associated website and/or the Respondent's activities.

The Respondent registered the disputed domain name in order to prevent the Complainant, being owner of the trademark or service mark, BMW from reflecting the mark in a corresponding disputed domain name.

The Respondent appears to have a pattern of engaging in such conduct. There is an adverse UDRP decision in *Sedgwick Claims Mgmt. Services, Inc. v. Tulip Trading Company Limited*, WIPO Case No. [D2021-2237](#), when the tribunal decided and found against the Respondent.

The evidence and totality of circumstances have established that the Respondent had actual knowledge of the Complainant and its BMW mark prior to registration and use of the disputed domain name. The disputed domain name was chosen by the Respondent in a calculated and premediated attempt to impersonate the Complainant or otherwise create the false impression that the offending website was the Complainant's official website or one connected or affiliated with the Complainant's authorized dealer in Alexandria, Virginia.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. The naming of party and notice of proceedings**

The Whois Lookup search results provided in Exhibit 1 to the Amended Complaint showed the name/Admin name/Tech name of the original registrant as above-privacy.

The answers provided by the Registrar to the Center on January 30, 2023, in response to the Center's request for Registrar Verification disclosed the identity of the current Registrant of the disputed domain name as Tulip Trading Company Limited.

The Complainant accordingly filed an Amended Complaint to identify and replace the former registrant with Tulip Trading Company Limited named as the Respondent on January 31, 2023, following the said verification particulars provided by the Registrar.

On January 31, 2023, the Center forwarded the Notification of Complaint and Commencement of Administrative Proceedings according to the contact details of the Respondent, including those found in the Amended Complaint, Whois, and Registrar Verification. The said notification was sent by post/courier and email as per the contact particulars so provided with copies to the Registrar.

In the circumstances, the Panel finds that the proper Parties to these proceedings have been named and notified. As long as the Complainant or the Center as the case may be communicated with the Respondent using the contact information which the Respondent have chosen to provide to the Registrar as reflected in the above contact details, their respective notice obligations will be discharged and the Respondent is bound accordingly.

The Panel is satisfied that the Center has discharged its responsibility under paragraph 2(a) of the Rules to employ reasonably available means calculated to achieve actual notice to the Respondent of the Complaint and that the failure of the Respondent to furnish a reply is not due to any omission or inadequate communication by the Center.

## B. The Three Elements

In rendering its decision, the Panel must adjudicate the dispute in accordance with paragraph 15(a) of the Rules which provides that, “the 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”. Paragraph 14(b) of the Rules further provides that, “[i]f a Party, in the absence of exceptional circumstances, does not comply with any provisions of, or requirement under, these Rules or any requests from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate”. Paragraph 5(e) of the Rules further provides that, “if a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint”.

The failure of the Respondent to respond does not automatically result in a favourable decision for the Complainant, which is specifically required under paragraph 4(a) of the Policy to establish each of the three elements as provided therein. See *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) and *Berlitz Investment Corp. v. Stefan Tincuлесcu*, WIPO Case No. [D2003-0465](#).

The said three elements are considered below.

### 1. Identical or Confusingly Similar

On the evidence available, the Panel has no hesitation in finding that the Complainant has rights in the trademark BMW by reason of the trademark registrations recited in Section 4 above.

Furthermore, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark BMW. The addition of the geographical name, Alexandria as suffix does not prevent the disputed domain name from being confusingly similar to the Complainant’s trademark BMW, as it remains clearly recognizable in the disputed domain name.

It is well-established practice to disregard the generic Top-Level Domain part of a domain name, such as “.com”, when assessing whether a domain name is identical or confusingly similar to the mark in issue. *Société Anonyme des Eaux Minérales d’Evian and Societe des Eaux de Volvic v. Beroca Holdings B.V.I. Limited*, WIPO Case No. [D2008-0416](#).

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy is established.

### 2. Rights or Legitimate Interests

The Complainant needs to establish a *prima facie* case showing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#). Once such *prima facie* case is made, the burden will shift to the Respondent to prove that it has rights or legitimate interests in the disputed domain name.

The Complainant has confirmed that it has not authorized, licensed, or permitted the Respondent to use the mark BMW.

There is no explanation on the record as to why it was necessary for the Respondent to adopt the term “bmw” in the disputed domain name.

There is no evidence before the Panel to suggest that the Respondent is commonly known as <bmwalexandria.com>.

There is also no evidence available to demonstrate any legitimate noncommercial or fair use of the disputed domain name by the Respondent. Moreover, given the likely commercial revenue derived from the links found at the disputed domain name, the Respondent cannot claim to be using the confusingly similar disputed domain name for a noncommercial or *bona fide* offering of goods or services.

The Complainant has put forward a very strong *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Accordingly, the Panel is satisfied that the Respondent has no rights to or legitimate interests in the disputed domain name.

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

The Complainant has registered its BMW trademark since at least 1917 and has been using it for over 100 years before the registration of the disputed domain name by the Respondent.

The incorporation of the rather unique distinctive abbreviation BMW, being the first syllables of the three words comprising the Complainant's name "Bayerische Motoren Werke", as part of the disputed domain name without any explanation under the above circumstances and the prior substantial use of the Complainant's BMW mark which has become famous worldwide in respect of automobiles and motorcycles, lead to the conclusion that the Respondent must have been aware of the existence of the Complainant and its trademark BMW at the time of the registration and use of the disputed domain name.

The disputed domain name has also been used in the context as described above as shown in Exhibit 8 to the Amended Complaint showing pay-per-click links. The use of the disputed domain name disrupts the Complainant's business by directing Internet users to the website to which it resolves containing hyperlinks that display advertisements and/or redirects visitors to websites of the Complainant and its competitors. Furthermore, the disputed domain name is almost identical to the domain name <bmwofalexandria.com> of the Complainant's authorized dealer in Alexandria, Virginia. Accordingly, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to said website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or products on the said website.

The Respondent also seems to be engaged in a pattern of conduct of registering domain names including third party trademarks, which further indicates bad faith on the Respondent's part.

The Panel finds that the circumstances under paragraph 4(b)(iii) and (iv) of the Policy have been established. Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith under paragraph 4(a)(iii) 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 name, <bmwalexandria.com>, be transferred to the Complainant.

/C. K. Kwong/

**C. K. Kwong**

Sole Panelist

Date: March 28, 2023