

## **ADMINISTRATIVE PANEL DECISION**

### **Bayerische Motoren Werke AG v. Harrison Gray**

### **Case No. D2023-0894**

#### **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 Harrison Gray, United States.

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

The disputed domain name <longislandcitybmw.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 February 27, 2023. On February 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 1, 2023, the Registrar 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 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 March 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 27, 2023.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on March 31, 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 is a German company active in the manufacturing and distribution of automotive vehicles, as well as associated services such as maintenance, repair and financing. The Complainant claims to be active internationally in over 31 countries and managing over 118.000 employees worldwide.

Amongst others, the Complainant owns several active verbal word trademarks, including:

- German semi-figurative trademark BWM No. 410579, November 15, 1929 in classes 7 and 12; and
- United States verbal trademark BMW No. 0611710 registered on September 6, 1955 in class 12.

The Complainant claims that it has extensively and widely promoted its products and services under its trademarks, which are thus well-known and duly exploited.

The Complainant operates the domain names <bmw.com> and <bmwgroup.com>, registered on January 29, 1996 and November 4, 1998 respectively. The Complainant claims to routinely authorize dealers and importers to use domain names including its trademarks as well as an extension or added term to reflect their geographic location.

The disputed domain name was registered by the Respondent on September 26, 2018. At the time of filing of the Complaint, it appears that the disputed domain name resolves to a parked webpage hosting pay-per-click hyperlinks that display advertising for, and redirect visitors to several third-party websites and services, including competitors of the Complainant.

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

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

The Complainant contends that the disputed domain name is confusingly similar to its well-known BMW trademarks, as the disputed domain name fully incorporates the trademarks. Additionally, the association with the terms "longislandcity" does not suffice to distinguish the disputed domain name from the Complainant's trademarks but rather will be perceived as a reference to the location of an authorized dealer of the Complainant's product and services.

The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name, as the Respondent is not commonly known by the disputed domain name, does not use the disputed domain name for a *bona fide* offering of goods or services and does not make a non-commercial use or fair use of the disputed domain name. In addition, the Respondent has not acquired trademark rights in the disputed domain name and has not been authorized, licensed or otherwise permitted by the Complainant to use or register its trademarks, including as domain name.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith as they intentionally attempted to attract, for commercial gain, Internet users to the disputed domain name by creating a likelihood of confusion with the Complainant's mark. Furthermore, the Complainant argues that the legal presumption of bad faith should apply given the actual or constructive knowledge of the Complainant's trademarks by the Respondent.

##### **B. Respondent**

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

## 6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, a complainant must establish each of the following elements:

- (i) the disputed domain names are identical or confusingly similar to the trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

### A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the UDRP, the Complainant must demonstrate that the disputed domain name is (i) identical or confusingly similar to a trademark or service mark, (ii) in which the Complainant has rights.

On the basis of the evidence presented, it is established that the Complainant owns several BMW verbal and semi-figurative trademarks. The disputed domain name reproduces the Complainant's BMW trademarks in their entirety, with the addition of the term "longislandcity". Previous UDRP panels have consistently held that, in circumstances where the disputed domain name incorporates the entirety of a trademark or its dominant feature is recognizable, the disputed domain name will be considered confusingly similar to the trademark (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7; *Fondation Le Corbusier v. Monsieur Bernard Weber, Madame Heidi Weber*, WIPO Case No. [D2003-0251](#); and *Bayerische Motoren Werke AG ("BMW") v. Registration Private, Domains By Proxy, LLC / Armands Piebalgs*, WIPO Case No. [D2017-0156](#)). This finding of confusing similarity is not prevented by the addition of other terms ([WIPO Overview 3.0](#), section 1.8; *Intesa Sanpaolo S.p.A. v. Rampe Purda*, WIPO Case No. [D2010-1116](#); and *Société des Bains de Mer et du Cercle des Etrangers à Monaco v. Mark Bolet*, WIPO Case No. [D2006-1245](#)).

Additionally, it is well-established that the generic Top-Level Domain ".com" is typically not taken into account for the purpose of assessing confusing similarity under the Policy, as it is merely standard registration requirements ([WIPO Overview 3.0](#), section 1.11).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

### B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, evidence of the Respondent's rights or legitimate interests in the disputed domain name for the purposes of paragraph 4(a)(ii) may be established, in particular, by any of the following circumstances:

- (i) prior to becoming aware of the dispute, the Respondent has used the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services, or made demonstrable preparations to do so;
- (ii) the Respondent is commonly known by the disputed domain name in question, even without having acquired trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent to misleadingly divert consumers for profit by creating confusion or to tarnish the trademark or service mark at issue.

Where the Complainant establishes *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name, the burden of production on this element is on the Respondent and it is up to the Respondent to provide relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent does not provide such relevant evidence, the Complainant is deemed to have satisfied the second element ([WIPO Overview 3.0](#), section 2.1).

The Complainant establishes *prima facie* that the Respondent has no rights in BMW as trademarks and that the Respondent has not been authorized, licensed or otherwise permitted by the Complainant to register or use said trademarks or in any corresponding domain names. The Complainant also establishes *prima facie* that the Respondent is not commonly known by the disputed domain name and is not making legitimate or noncommercial or fair use of the disputed domain name.

In addition, the Complainant establishes that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, since the disputed domain name competes with or capitalizes on the reputation and goodwill of the Complainant's mark or otherwise mislead Internet users by redirecting to a parking page with pay-per-click commercial links to competitors of the Complainant ([WIPO Overview 3.0](#), section 2.9). Indeed, the Panel notes that the composition of the disputed domain name incorporating the Complainant's trademarks in their entirety together with the terms associated with the Complainant's business carries a risk of implied affiliation. This risk is heightened by the association with a geographic term ("longislandcity", by reference to the neighbourhood of New York City), given the Complainant's practice of authorizing dealers to use a specific domain name structure incorporating the Complainant's trademark and a geographic descriptor.

The Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not exercised its right to defend itself and has not asserted the existence of a legitimate interest in the disputed domain name, so the Panel must conclude that the second condition of paragraph (4)(a) of the Policy is satisfied.

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

Paragraph 4(b) of the Policy provides circumstances, in particular but without limitation, that shall be evidence of a disputed domain name being registered and used in bad faith – including the circumstance that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the disputed domain name, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the disputed domain name or location or of a product or service on the disputed domain name.

In addition to the circumstances provided in paragraph 4(b) of the Policy, the Panel may also consider special circumstances such as (i) the nature of the domain name (e.g., a typo of a widely known mark, or a domain name incorporating the complainant's mark plus an additional term such as a descriptive or geographic term), (ii) a clear lack of rights or legitimate interests coupled with the absence of a credible explanation for the respondent's choice of domain name, or (iii) other indicia generally suggesting that the respondent has targeted the complainant in some way ([WIPO Overview 3.0](#), section 3.2.1).

The disputed domain name was registered on September 26, 2018, which is subsequent to the registration of the Complainant's BMW trademarks in 1929 and 1955. Numerous UDRP panels have found that the Complainant's BMW trademarks are well-known (see e.g. *Bayerische Motoren Werke AG v. Diagnostic Software, Global Domain Privacy / Elizabeth Davis, Chen Guo Qiang*, WIPO Case No. [D2020-1110](#) and *Bayerische Motoren Werke AG v. Gerry Scarantine*, WIPO Case No. [D2018-0233](#)).

Previous UDRP panels have held on multiple occasions that the mere registration of a domain name that is identical or confusingly similar to a well-known or widely-known trademark by an unaffiliated entity may be sufficient to create a presumption of bad faith, as the respondent knew or should have known that its domain name would be identical or confusingly similar to the complainant's trademark ([WIPO Overview 3.0](#), sections 3.1.4 and 3.2.2). In this case, given the long-lasting worldwide reputation which the BMW trademarks enjoy,

the Panel finds that the Respondent knew or should have known that it was registering the disputed domain name in violation of the Complainant's trademarks.

Moreover, the redirection to a parking page with pay-per-click commercial links is further evidence of bad faith, as the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark ([WIPO Overview 3.0](#), section 3.1.4). Further, the incorporation of the terms "longislandcity" in the disputed domain name, in addition to the Complainant's trademarks increases the likelihood of confusion for the public given the Complainant's practice of authorizing dealers and importers to use a specific domain name structure incorporating the Complainant's trademark and a geographic descriptor.

Additionally, the Panel finds that several other circumstances are indicative of bad faith, including (i) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name, (ii) the use of a privacy shield to hide the registrant's identity, and (iii) the failure to submit a response ([WIPO Overview 3.0](#), section 3.2 and 3.6).

For the reasons set out above, the Panel considers that the requirement of registration and use in bad faith of the disputed domain name set out in paragraph 4(a)(iii) of the Policy is satisfied.

## 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 <longislandcitybmw.com> be transferred to the Complainant.

*/Benoit Van Asbroeck/*

**Benoit Van Asbroeck**

Sole Panelist

Date: April 14, 2023