

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG v. Domain Administrator, Fundacion Privacy Services LTD

Case No. D2023-0986

1. The Parties

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

The Respondent is Domain Administrator, Fundacion Privacy Services LTD, Panama.

2. The Domain Names and Registrar

The disputed domain names <bmwbloomfield.com> and <bmwfairfax.com> are registered with Media Elite Holdings Limited (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 6, 2023. On March 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 7, 2023, 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 (Privacy Protected) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 9, 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 March 14, 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 March 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 12, 2023.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on April 18, 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 headquartered in Germany and it has numerous additional locations in countries around the world. BMW's products and components are manufactured at 31 sites in countries around the world, and BMW has more than 118,000 employees worldwide.

The Complainant is part of the BMW Group and manufactures, sells, and distributes automobiles and motorcycles, and provides numerous services, including maintenance and repair services and financing.

The Complainant utilizes a network of authorized dealers to market both new and certified pre-owned BMW vehicles and has more than 3,500 authorized BMW dealers in locations throughout the world.

The BMW trademark is in use since 1917.

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.

The Complainant has a strong online presence, operating official websites under the domain names <bmw.com> and <bmwgroup.com>. The Complainant's websites provide information regarding products/services of the Complainant and allow users to select their country or region to go to the Complainant's country-specific or region-specific websites for detailed and geographically relevant information regarding products/services under the BMW trademark. The Complainant's country-specific and region-specific websites are located at BMW-formative domains, such as, for example, <bmwusa.com>, <bmw.ca>, and <bmw.de>.

In addition to its corporate websites, the Complainant has permitted its authorized dealers to use trade names and domains comprised in part of the BMW trademark, subject to the terms of various agreements, for their authorized BMW businesses, and numerous dealers use and have used such names for years. The Complainant's dealers' domains are frequently comprised of the BMW trademark as the main domain string and a geographic location and/or a country-code extension reflecting the dealers' particular market.

The Complainant has continuously used the BMW trademark since 1917 and owns numerous registrations for the BMW trademarks and variations thereof covering more than 140 countries around the world.

The BMW trademark is protected, *inter alia*, by the following trademark registrations:

- German Trademark Registration No. 410579 for BMW, registered on November 15, 1929;
- German Trademark Registration No. 221388 for BMW (word & device), registered on December 10, 1917;
- United States of America ("United States") Trademark Registration No. 0611710 for BMW, registered on September 6, 1955;
- United States Trademark Registration No. 0613465 for BMW (word & device), registered on October 4, 1955; and
- United States Trademark Registration No. 1164922 for BMW, registered on August 11, 1981.

The disputed domain name <bmwbloomfield.com> was created on May 3, 2008, and the disputed domain name <bmwfairfax.com> was created on May 10, 2016. The disputed domain names are used to host pay-per-click (“PPC”) hyperlinks that display advertising for, and redirect visitors to, various third-party websites and services, including some of which compete with or relate to the Complainant and its BMW trademark. The disputed domain names are available for purchase via the website at the domain name “sedo.com”, with a minimum listed offer of USD 500.

5. Parties’ Contentions

A. Complainant

Identical or Confusingly Similar

The Complainant contends that the disputed domain names and the BMW trademark are confusingly similar.

According to the Complainant’s contentions, the disputed domain names fully incorporate the Complainant’s BMW trademark.

The Complainant contends that the addition of the geographic terms “bloomfield” and “fairfax” does not prevent a finding of confusing similarity between the disputed domain names and the BMW trademark, as the BMW trademark remains recognizable in the disputed domain name.

The Complainant submits that the applicable generic Top-Level Domain (“gTLD”) in the disputed domain names should be viewed as a standard registration requirement and as such should be disregarded under the first element confusing similarity test.

No rights or legitimate Interests

The Respondent has no connection with the Complainant or any of its affiliates. The Complainant does not carry out any activity for, nor have any business with, the Respondent.

The Complainant further contends that the Respondent is not commonly known by the disputed domain name.

The Complainant contends that the disputed domain names only resolve to a PPC parking page. The use of the disputed domain names to host a parked page comprising PPC links, including hyperlinks competing with and/or relating to the Complainants’ businesses, does not represent a *bona fide* offering or a legitimate noncommercial or fair use of the domain names where such links compete with or capitalize on the reputation and goodwill of the Complainant’s mark or otherwise mislead Internet users.

The Complainant submits also that the fact that the Respondent intends to sell the disputed domain names, presumably for valuable consideration in excess of the out-of-pocket costs associated with registering the disputed domain names, does not constitute a *bona fide* offering of goods or services nor a noncommercial or fair use of the disputed domain names such that the Respondent can claim any legitimate rights or interests in the disputed domain names.

Registered and used in bad faith

The Complainant claims that the use of the disputed domain names that are identical or confusingly similar to a trademark to obtain click-through-revenue can amount to bad faith.

The Complainant further contends that the Respondent has registered and is using the disputed domain names in bad faith as it intentionally attempted to attract, for commercial gain, Internet users to the disputed domain names by creating a likelihood of confusion with the Complainant’s mark.

The Respondent registered the disputed domain names in order to prevent the Complainant, being owner of the BMW trademark, from reflecting the trademark in a corresponding disputed domain names. The Respondent appears to have a pattern of engaging in such conduct. To substantiate this contention, the Complainant referred to adverse UDRP decisions naming "Domain Administrator" and/or "Fundacion Privacy Services LTD" as the named Respondent and where the tribunal decided and found against the Respondent.

Furthermore the Complainant contends that the fact the disputed domain names are available for purchase on at market platform at the "sedo.com" domain name, with a minimum listed offer of USD 500, is yet another evidence of bad faith registration and use of the disputed domain names.

Finally, the Complainant submits that the evidence and totality of circumstances indicate that the Respondent had actual knowledge of the Complainant and its BMW trademark prior to registration and use of the disputed domain names. That is another *indicia* of bad faith registration of the disputed domain names.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[a] 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."

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel "shall draw such inferences therefrom as it considers appropriate".

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

Under the first element, the Complainant must establish that the disputed domain names are identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry; (i) the Complainant must demonstrate that it has rights in a trademark and, if so, (ii) the disputed domain names must be shown to be identical or confusingly similar to the trademark.

According to section 1.1.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the term "trademark or service mark" as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks.

Ownership of a nationally or regionally registered trademark serves as a *prima facie* evidence that the Complainant has trademark rights for the purposes of standing to file this Complaint. See section 1.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The Complainant submitted evidence that the BMW trademark enjoys protection under national trademark registrations. Thus, the Panel finds that the Complainant's rights in the BMW trademark have been established pursuant to the first element of the Policy.

The disputed domain names consist of the Complainant's BMW trademark followed by the additional term "bloomfield" in the disputed domain name <bmwbloomfield.com> and the additional term "fairfax" in the disputed domain name <bmwfairfax.com>, and followed by the generic Top-Level Domain ("gTLD") ".com".

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within a domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term may however bear on assessment of the second and third elements.

Under section 1.7 of the [WIPO Overview 3.0](#), while each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

Finally, for the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the gTLD, see section 1.11.1 of the [WIPO Overview 3.0](#).

It is the view of the Panel that it is readily apparent that the Complainant's BMW trademark remains recognizable in the disputed domain names.

Accordingly, the Panel finds that the disputed domain names are confusingly similar to the BMW trademark in which the Complainant has rights.

The first element of paragraph 4(a) of the Policy is therefore satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

Based on the Complainant's contentions, the Respondent is not a licensee of, or otherwise affiliated with, the Complainant, and has not been authorized by the Complainant to use its BMW trademark.

The Complainant further contends that the Respondent is not commonly known by the disputed domain names and has not made any *bona fide* use - neither commercial nor noncommercial, of the same.

Based on the present case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain names, and there is no similarity or association between the name of the Respondent and the disputed domain names, which could demonstrate rights or legitimate interests of the Respondent. See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#).

There is no evidence that the Respondent has used or made demonstrable preparations to use the disputed domain names in connection with a legitimate noncommercial fair use or a *bona fide* offering of goods or services.

Simply holding the disputed domain names and publishing the disputed domain names on a domain name marketplace for their sale for sums likely greater than out-of-pocket costs does not, in the absence of other evidence, amount to use for a *bona fide* offering of goods or services. Nor does the use of the disputed domain names for a parking page with PPC links.

The Panel notes the statements in the [WIPO Overview 3.0](#) on the question of whether “parked” pages comprising PPC links support the Respondent’s rights or legitimate interests. Section 2.9 of the [WIPO Overview 3.0](#) stated that:

“[a]pplying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users.

Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the UDRP – where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant’s (or its competitor’s) trademark.”

In the instance of this proceeding, the Panel has established that the disputed domain names resolve to parking pages with various headings and PPC links, which are related to sales cars and referring to the Complainant’s BMW trademarks. These topics clearly overlap the Complainant’s business activity under the BMW trademark. Furthermore, some of the PPC links redirect Internet users to online marketplaces and dealers of the cars of various brands in direct competition with the Complainant, illustrating the intent of the Respondent to use the disputed domain names to capitalize on the reputation and goodwill associated with the Complainant’s BMW trademark.

In the present case, the use of the Complainant’s BMW trademark in the disputed domain names have no inherent meaning and hence the Respondent’s use of the confusingly similar disputed domain names to host a parking page with PPC links does not, absent any further explanation, provide the Respondent with rights or legitimate interests in the disputed domain names.

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has chosen not to respond to the Complaint and thus has failed to provide any evidence of rights or legitimate interests in the disputed domain names. The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names under paragraph 4(a)(ii) of the Policy.

The second element of paragraph 4(a) of the Policy is therefore satisfied.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must show that the Respondent registered and is using the disputed domain names in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.3.

The Registrar has confirmed that the disputed domain names were created on May 3, 2008, for <bmwbloomfield.com>, and May 10, 2016, for <bmwfairfax.com>, *i.e.* decades after the Complainant first used and registered the BMW trademark. Numerous UDRP panels have found that the Complainant's BMW trademarks are well known (see *e.g.* *Bayerische Motoren Werke AG v. Gerry Scarantine*, WIPO Case No. [D2018-0233](#); *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. Zinaida*, WIPO Case No. [D2021-1574](#)). Given that the Complainant's BMW trademark is globally renowned, the Panel finds that it is impossible to believe that the Respondent chose to register the disputed domain names randomly with no knowledge of the BMW trademark (see *Barney's Inc. v. BNY Bulletin Board*, WIPO Case No. [D2000-0059](#); and *Kate Spade, LLC v. Darmstadter Designs*, WIPO Case No. [D2001-1384](#)).

The Panel finds, on the balance of probabilities, that the Respondent would have been aware of the Complainant and its reputation in the BMW trademark at the time the Respondent registered the disputed domain names. There is no obvious reason, nor has the Respondent offered an explanation, for the Respondent to register disputed domain names incorporating the BMW trademark unless, as suggested by the Complainant and not denied by the Respondent, there was an intention to create a likelihood of confusion between the disputed domain names and the BMW trademark.

The disputed domain names are being used for a parking page with PPC links for which the Respondent might have received some commercial and financial gain. In these circumstances, where the Respondent has offered no plausible explanation for the registration of the disputed domain names, the Panel finds that the Respondent is using the disputed domain names to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the BMW trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent. See [WIPO Overview 3.0](#), section 3.1.4.

Respectively, the Panel finds that the use of a domain name that is identical or confusingly similar to a trademark to obtain click-through-revenue can amount to bad faith use (see, among others, *Ilscience Limited v. Domains By Proxy LLC / Dr Chauncey Siemens*, WIPO Case No. [D2016-0909](#); and *AMADEUS IT GROUP, S.A. v. Contact Privacy Inc. Customer 0151133672, Contact Privacy Inc. Customer 0151133672 / Milen Radumilo*, WIPO Case No. [D2018-2192](#)).

According to section 3.1.2 of the [WIPO Overview 3.0](#), UDRP panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration.

This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner. A pattern of abuse has also been found where the respondent registers, simultaneously or otherwise, multiple trademark-abusive domain names corresponding to the distinct marks of individual brand owners.

In the light of the Respondent's involvement in multiple domain name dispute resolution proceedings, in which the Respondent has been ordered to transfer ownership of domain names (see, *e.g.*, *Equifax Inc. v. Fundacion Privacy Services LTD*, WIPO Case No. [D2023-0101](#); and *Carvana, LLC v. Fundacion Privacy Services LTD*, WIPO Case No. [D2022-4636](#)), the Panel finds that the Respondent has engaged in a pattern of bad faith conduct. Additionally, given the Respondent's registration of two domain names including the Complainant's trademark, the Panel's view is that the Respondent has registered the disputed domain names in order to prevent the Complainant from reflecting its mark in corresponding domain names.

Finally, in the present case, the disputed domain names are advertised for sale on a domain marketplace, which requests interested buyers to submit offers for its purchase.

The fact that the disputed domain names have simply been listed for sale to the public, but that there was no direct offer to the Complainant or one of its competitors, does not preclude a finding of bad faith in this case. The Panel draws the inference of bad faith on the part of the Respondent based on a number of circumstances in the present proceeding, which indicate in this case that the Respondent's intent in registering the disputed

domain names was in fact to profit in some fashion from or otherwise exploit the Complainant's BMW trademark.

In light of the aforesaid and applying the above-referenced factors, the Panel finds that the Respondent registered and is using the disputed domain names in bad faith.

The third element of paragraph 4(a) of the Policy is therefore 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 names, <bmwbloomfield.com> and <bmwfairfax.com>, be transferred to the Complainant.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: May 15, 2023