

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG v. chris muzylowski, zygmunt motors inc.
Case No. D2024-4069

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 chris muzylowski, zygmunt motors inc., United States.

2. The Domain Names and Registrar

The disputed domain names <bmwmechanicdoylestown.com>, <bmwrepairdoylestown.com>, <bmwrepairshopdoylestown.com>, <bmwrepairshopdoylestown.com>, <bmwrepairshop18901.com>, <bmwrepair18901.com>, <bmwservicedoylestown.com>, <bmwservice18901.com>, <bmw18901.com>, <thompsonbmwdoylestown.com> and <thompsonbmw18901.com> are registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 3, 2024. On October 4, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 4, 2024, 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" / Registration Private, Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 8, 2024, 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 October 9, 2024.

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 October 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 3, 2024. The Response was filed with the Center on November 3 and November 4, 2024.

The Center appointed Adam Taylor as the sole panelist in this matter on November 22, 2024. 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, a vehicle manufacturer founded in 1917, has sold many millions of vehicles under the well-known BMW mark.

The Complainant owns numerous registered trade marks for BMW including German trade mark No. 410579, registered November 15, 1929, in classes 7 and 12, and United States trade mark No. 611,710, registered September 6, 1955, in class 12.

The Complainant's website is located at "www.bmw.com".

The Complainant operates a network of over 3,600 authorised dealers worldwide including Thompson Automotive Group ("Thompson"), which is an authorised BMW dealership for Doylestown, Pennsylvania, with a website at "www.thompsonbmw.com".

The disputed domain names were registered on the following dates:

- December 6, 2012: <bmwservicedoylestown.com> and <thompsonbmwdoylestown.com>;
- March 4, 2017: <bmwmechanicdoylestown.com>;
- March 20, 2014: <bmwservice18901.com>;
- March 27, 2014: <thompsonbmw18901.com>;
- April 15, 2014: <bmwrepairdoylestown.com>;
- March 10, 2015: <bmwrepair18901.com>, <bmwrepairshop18901.com>, <bmwrepairshopdoylestown.com> and <bmwrepairshopdoylestown.com>;
- July 17, 2015: <bmw18901.com>.

As of September 9, 2024, the disputed domain names <bmw18901.com>, <bmwmechanicdoylestown.com>, <bmwrepairdoylestown.com>, <bmwservice18901.com>, <bmwservicedoylestown.com>, <thompsonbmwdoylestown.com> and <thompsonbmw18901.com> ("the Group 1 Domain Names") redirected Internet users to the Respondent's website at "www.zygmuntmotors.com". This website, branded ZYGMUNT MOTORS INC, stated: "Zygmunt Motors, Inc. is a full-service, automotive repair center and BMW repair shop in Doylestown, PA. We service most makes and models, with specialization in import and European vehicles."

As of September 9, 2024, the disputed domain names <bmwrepair18901.com>, <bmwrepairshop18901.com>, <bmwrepairshopdoylestown.com> and <bmwrepairshopdoylestown.com> ("the Group 2 Domain Names") resolved to GoDaddy parking pages with pay per click ("PPC") links to vehicle repair, insurance and servicing websites.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for transfer of the disputed domain names.

B. Respondent

The Respondent contends that the Complainant has failed to satisfy the elements required under the Policy for transfer of the disputed domain names.

Notably, the Respondent contends that:

- it offers "European car services" with a "speciality in BMW repair and maintenance";
- Internet searches for the second-level parts of the disputed domain names <bmwmechanicdoylestown.com>, <bmwrepairdoylestown.com>, <bmwrepairshopdoylestown.com>, <bmwrepairshopdoylestown.com>, <bmwrepairshop18901.com>, <bmwrepair18901.com> and <bmwservicedoylestown.com> all bring up multiple results for BMW repair and maintenance services in Doylestown including the Respondent's main website and Thompson's website;
- searches for the second-level parts of the disputed domain names <bmwservice18901.com> and <bmw18901.com> only bring up results relating to this proceeding (amongst irrelevant results);
- the Respondent's website does not obviously trade off the Complainant's reputation but, on the contrary, it contains a very clear description of the goods and services offered by the Respondent including its 40 years of activity in relation to BMW vehicles and the Respondent does not claim to be world famous or an official representative or distributor of the Complainant;
- there are thousands of vehicle service centres worldwide that are not official distributors of the Complainant;
- there are no contract terms obliging consumers to only use the Complainant's services in connection with its vehicles, which would be anti-competitive;
- as with other service centres, the Respondent deliberately added distinguishing terms to the disputed domain names such as the Doylestown zip code "18901", the name of the city and the terms "service", "repair" and "shop", all of which lead to a clear distinction in the minds of customers between the world-famous German car manufacturer and a local service centre that provides services to BMW vehicles and selling BMW parts;
- such additional terms should bear on assessment of the second and third elements under the Policy;
- in two recent Taiwanese trade mark infringement cases, the courts rejected claims of likelihood of confusion in the context of hashtags relating to third party trade marks;
- for all the above reasons, it is impossible that ordinary users of the Respondent's website would confuse the world famous German car manufacturer BMW with the disputed domain names;
- the Respondent has never done, or intended to do, anything that would damage the Complainant's business or reputation, which is proved by the fact that the Respondent never resolved any of the disputed domain names directly to a web page, and the Complainant has not provided any evidence to the contrary;
- the Respondent has demonstrated rights or legitimate interests in the disputed domain names; and
- the disputed domain names were not registered and are not being used in bad faith and none of the four examples of bad faith in the Policy apply.

6. Discussion and Findings

Consent to Remedy – Preliminary Issue

The Respondent has indicated in the Complaint that it consents to transfer of the disputed domain names <thompsonbmwdolestown.com> and <thompsonbmw18901.com> (“the Thompson Domains”) to the Complainant and has not raised any arguments specifically in relation to these disputed domain names.

Many panels will order transfer solely on the basis of a consent to transfer by the respondent on the record, but panels may still find it appropriate to proceed to a substantive decision on the merits in certain circumstances. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 4.10.

In this case, the Panel has decided to proceed to a substantive determination because the Panel considers that the Respondent’s registration and use of the Thompson Domains is relevant to its motive in registering and using the other disputed domain names. See further below.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trade mark and the disputed domain names. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, “18901”, “doylestown”, “doylestown”, “mechanic”, “repair”, “service”, “shop”, “thompson”) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It makes no difference that the additional term “thompson” in the Thompson Domains is a third party trade mark. This is also insufficient to avoid a finding of confusing similarity. [WIPO Overview 3.0](#), section 1.12.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognised that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

As to paragraph 4(c)(i) of the Policy, the Respondent is redirecting the Group 1 Domain Names to a website offering servicing and parts related to the Complainant's vehicles. The consensus view of UDRP panels is that to establish a bona fide offering of goods or services in such circumstances, a respondent must comply with certain conditions (the "Oki Data requirements"). Cases applying the Oki Data requirements usually involve a domain name comprising a trade mark plus a descriptive term (e.g., "parts", "repairs", or "location"), [WIPO Overview 3.0](#), section 2.8.

In this case, the Panel considers that the Respondent has failed to comply with the Oki Data requirements in that the Respondent is not using the site to sell only the trademarked goods or services. The Respondent admits that its website offers parts and servicing for vehicles from competing manufacturers, particularly those produced in Europe, where the Complainant is located. While the Respondent strongly disputes that there is any likelihood of confusion (discussed further below), the Respondent has not sought to justify its use of the disputed domain names containing the Complainant's mark to offer goods and services relating to products of the Complainant's competitors.

Furthermore, the Panel considers that the Respondent has failed to comply with the Oki Data requirements not to "corner the market" in domain names that reflect the trade mark by registering 11 domain names incorporating the Complainant's mark.

As regards the Group 2 Domain Names, panels have found that PPC websites do not normally meet the Oki Data requirements as they do not themselves directly offer the goods or services at issue. [WIPO Overview 3.0](#), section 2.8.2.

Indeed, the PPC links also lead to vehicle-related goods/services that are not specific to the Complainant's vehicles and therefore encompass the Complainant's competitors. Use of domain names to host PPC links that compete with or capitalise on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users does not represent a bona fide offering. [WIPO Overview 3.0](#), section 2.9.

Accordingly, the Panel concludes that the Respondent's use of the disputed domain names cannot be said to be bona fide.

Nor is there any evidence that paragraph 4(c)(ii) of the Policy applies, i.e., that the Respondent has been "commonly known by the disputed domain name(s)".

While the Respondent invokes paragraph 4(c)(ii) of the Policy, this is relevant only where the Respondent has been acting "without intent for commercial gain", which is not the case here.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

As regards the Group 1 Domain Names, the Panel considers that the Respondent intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trade mark in connection with the offering of goods and services relating not only to the Complainant's vehicles but also those of its competitors, in accordance with paragraph 4(b)(iv) of the Policy.

The Panel notes that the Group 1 Domain Names include the Thompson Domains, which reflect the name of the Complainant's authorised dealer in Doylestown. The Respondent has not sought to explain, let alone defend, the Thompson Domains; instead, it has simply consented to their transfer without comment. This is perhaps unsurprising as the Panel can see no conceivable legitimate basis for the Respondent to have registered these two disputed domain names and redirected them to its own website. The Respondent's only possible motive was to attract Internet users to its website by creating a likelihood of confusion with the Thompson's trade mark in addition to the Complainant's trade mark.

In the Panel's view, the Thompson Domains, one of which was registered on the date when the Respondent started registering the Group 1 Domain Names, and both of which, like with the other Group 1 Domain Names, have been used to redirect Internet users to the Respondent's main website, indicate that the Group 1 Domain Names constitute a pattern of conduct designed to create a likelihood of confusion with marks connected with the Complainant rather than for a legitimate and fair offering of goods and services without intent to cause confusion, as the Respondent claims.

The Respondent contends that it deliberately added terms to the Complainant's mark – namely "Doylestown" (and the misspelling "Doylestown"), the zip code "18901", and the terms "mechanic", "repair", "service", and "shop" – in order to distinguish between the Complainant, a world-famous German car manufacturer and the Respondent, a local service centre that provides services to BMW vehicles and selling BMW parts. However, such terms could also be indicative of goods and services offered by an official Complainant distributor, one of whom the Respondent has indeed specifically set out to target by means of the Thompson Domains. Furthermore, the Respondent clearly deployed the terms "18901" and "Doylestown" within the Thompson Domains in order to increase the likelihood of customer confusion, rather than to reduce it.

The Respondent contests any likelihood of confusion, stating that its website does not claim to be operated by a world-famous entity or an official representative or distributor of the Complainant. However, the Panel notes that the Respondent's website lacks a clear and prominent disclaimer of any official connection with the Complainant. While the absence of a disclaimer may or may not be material when considering only the Respondent's primary domain name and website, the Panel considers that the lack of a disclaimer is particularly significant in the context of the Respondent's redirection of a number of domain names incorporating third party trade marks to the Respondent's primary domain name as well as the Respondent's likely illegitimate motive as illustrated by the Thompson Domains.

The likelihood of confusion is not diminished by the possibility, or even probability, that, notwithstanding the lack of a prominent disclaimer, Internet users arriving at the Respondent's site via the Group 1 Domain Names will at some point realise that it is not connected with the Complainant. Paragraph 4(b)(iv) of the Policy is concerned with the intentional attracting of Internet users. Here, the Group 1 Domain Names create a risk of implied affiliation with the Complainant, and the Respondent profits from at least some of the traffic intended for the Complainant, including from the supply of goods and services relating to the vehicles of the Complainant's competitors.

The Respondent asserts that there are thousands of unofficial vehicle service centres worldwide that offer services relating to the Complainant's vehicles and provides evidence that Internet searches for the second-level parts of the disputed domain names (excluding the Thompson Domains) bring up results for multiple BMW suppliers in Doylestown, including the websites of Thompson and the Respondent. However, the Panel does not consider that the fact that other businesses in Doylestown are acting in a similar manner as the Respondent assists the Respondent – if that is the Respondent's point. First, so far as the Panel can tell, none of those other suppliers are using the Complainant's mark within their domain names. Second, the legitimacy of any use of the Complainant's mark by those suppliers will depend on their particular circumstances, the details of which are outside the Panel's knowledge and the scope of this proceeding. Third, even if any such suppliers were acting illegitimately, it is difficult to see how this would justify the Respondent also doing so.

Furthermore, the Panel does not consider the following further contentions assist the Respondent for the reasons given:

- That it would be anticompetitive if consumers were required to use only the Complainant's services in connection with its vehicles. The issue here is not whether or not the Respondent is permitted to service the Complainant's vehicles but, rather, the circumstances whereby the Respondent has registered and used domain names that include the Complainant's mark to promote the Respondent's services.
- That the Respondent has not used the Group 1 Domain Names to resolve directly to their own websites but has simply redirected them to the Respondent's main site. In the Panel's view, few customers are likely to notice whether or not they arrived at the Respondent's website directly or via a redirect from another domain name and what matters here is not their means of travel but what Internet users encounter when they reach their destination.
- That findings of Taiwanese courts in two recent trade mark infringement cases concerning use of trade marks in hashtags support the Respondent's case regarding the lack of likelihood of confusion. The Panel is concerned with bad faith under the Policy, and notes that broader trade mark matters are outside the scope of this proceeding. Moreover, the Panel notes there are substantial differences between the cited cases and the present proceeding.

As regards the Group 2 Domain Names, by using these domain names, which all include the Complainant's distinctive mark, for parking pages with PPC links relating to the Complainant's industry including competitors, the Respondent has also intentionally created a likelihood of confusion with the Complainant's trade mark in accordance with paragraph 4(b)(iv) of the Policy.

The Respondent has not specifically sought to defend the PPC pages but, in any case, neither the fact that the PPC links are generated by a third party such as a registrar, nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith. [WIPO Overview 3.0](#), section 3.5.

For the above reasons, the Panel finds that the Complainant has established the third element 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 names <bmwmechanicdoylestown.com>, <bmwrepairdoylestown.com>, <bmwrepairshopdoylestown.com>, <bmwrepairshopdoylestown.com>, <bmwrepairshop18901.com>, <bmwrepair18901.com>, <bmwservicedoylestown.com>, <bmwservice18901.com>, <bmw18901.com>, <thompsonbmwdoylestown.com> and <thompsonbmw18901.com> be transferred to the Complainant.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: December 13, 2024