

ADMINISTRATIVE PANEL DECISION

Harley-Davidson Motor Company, Inc. v. Katri Hei and
dfasdaf fasdfa, fadfas, dfadfa
Case No. D2024-4657

1. The Parties

The Complainant is Harley-Davidson Motor Company, Inc., United States of America ("USA"), represented by Briffa., United Kingdom ("UK").

The Respondents are Katri Hei, USA ("the First Respondent"), and dfasdaf fasdfa, fadfas, dfadfa, UK ("the Second Respondent").

2. The Domain Names and Registrar

The disputed domain names <harley-davidson-club.shop>, <harley-davidson-eu.shop>, <harley-davidson-onlinesale.com>, <harley-davidson-outletshop.com>, <harley-davidson-outlets.shop>, and <harley-davidson-world-outlet.shop> ("the Disputed Domain Names") are registered with Sav.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 12, 2024. On November 13, 2024, the Center transmitted by email to the Registrar requests for registrar verification in connection with the Disputed Domain Names (apart from <harley-davidson-onlinesale.com>). On November 14, 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 (Unknown) and contact information in the Complaint.

The Center sent an email to the Complainant on November 14, 2024 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting that the Complainant either file separate complaint(s) for the Disputed Domain Names (apart from <harley-davidson-onlinesale.com>) associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all Disputed Domain Names (apart from <harley-davidson-onlinesale.com>) are under common control. The Complainant filed the amended Complaints on November 21 and 22, 2024 which added the Disputed Domain Name <harley-davidson-onlinesale.com>.

On November 27, 2024, the Center transmitted by email to the Registrar requests for registrar verification in connection with the Disputed Domain Name <harley-davidson-onlinesale.com>. On the same day, the Registrar transmitted by email to the Center its verification response confirming the First Respondent is the registrant for this Disputed Domain Name and providing contact information.

The Center verified that the Complaint together with the amended Complaints 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 Respondents of the Complaint, and the proceedings commenced on December 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 23, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on December 24, 2024. Due to an apparent issue with the notification, on January 3, 2025, the Respondents were granted until January 13, 2025 to indicate whether it wished to participate to this proceeding. The Center did not receive any communication from the Respondents. Accordingly, the Center notified the commencement of the panel appointment process on January 15, 2025.

The Center appointed Colin T. O'Brien as the sole panelist in this matter on January 20, 2025. 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 well-known manufacturer, retailer, and distributor of motorcycles and related merchandise including t-shirts, jackets, and other apparel. The Complainant extensively uses the mark HARLEY-DAVIDSON in relation to these products.

The Complainant is the owner of a large portfolio of registered trademarks worldwide for the word HARLEY-DAVIDSON, which includes the following UK registered trademarks:

- Registration Number UK00901172329 for HARLEY-DAVIDSON registered August 7, 2000 in Classes 12, 14, 34; and
- Registration Number UK00001271222 HARLEY-DAVIDSON registered September 30, 1988 in Class 25.

The Complainant claims the HARLEY-DAVIDSON mark has been used since 1903.

The Complainant generated in excess of five billion USD worldwide under the HARLEY-DAVIDSON mark in 2023.

The Complainant uses the domain name <harley-davidson.com> to sell its products online. This domain name was registered on November 8, 1994.

The Disputed Domain Names were registered on the following dates:

- <harley-davidson-eu.shop> registered May 8, 2024;
- <harley-davidson-club.shop> registered May 23, 2024;
- <harley-davidson-onlinesale.com> registered May 26, 2024;
- <harley-davidson-outlets.shop> registered June 4, 2024;
- <harley-davidson-outletshop.com> registered June 4, 2024; and
- <harley-davidson-world-outlet.shop> registered June 4, 2024.

Apart from the Disputed Domain Name <harley-davidson-onlinesale.com> which resolved to an online shop purportedly offering for sale the Complainant's products, the remaining Disputed Domain Names were inactive at the time of filing of the Complaint.

5. Parties' Contentions

A. Complainant

The Complainant submits that each of the Disputed Domain Names have been registered by the same domain holder, Katri Hei. The reasons are as follows:

- five of the six Disputed Domain Names have been registered by Katri Hei;
- the Second Respondent, who was named as the registrant of the Disputed Domain Name <harley-davidson-eu.shop>, provided what appears to be a false identity for the registration details; and
- it is averred that the Disputed Domain name <harley-davidson-eu.shop> was registered at close to the same time as the other Disputed Domain Names;
- all of the Disputed Domain Names feature descriptive English words and the Complainant's well-known HARLEY-DAVIDSON mark;
- all of the Disputed Domain Names are registered with the same Registrar; and
- all of the Disputed Domain Names are hosted by the same server.

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Names.

The Disputed Domain Names are confusingly similar to the HARLEY-DAVIDSON trademarks as they are visually, aurally, and conceptually identical save for the addition of descriptive, generic or geographical terms such as "eu", "online", "sale", "club", "outlet", "outlets", "outletshop", and "world" (together the "Descriptive Terms"). The Descriptive Terms are descriptive and/or generic and geographic, they bear little to no impact on the aural, visual, and conceptual similarities between the Disputed Domain Names and the HARLEY-DAVIDSON trademarks. In fact, if anything, the Descriptive Terms invoke the Complainant to the relevant public as they indicate a connection to the Complainant either by referring to a place where the Complainant's goods can be purchased (in the case of "online", "onlinesale", "outlet", "outlets", "outletshop", and "world"), a geographic location of the Complainant's website (in the case of "eu"), or an official members club of the Complainant (in the case of "club").

The Respondents have no rights or legitimate interests in respect of any of the Disputed Domain Names and has never been authorized by the Complainant to use the HARLEY-DAVIDSON trademarks. The Complainant has not licensed the HARLEY-DAVIDSON trademarks to the Respondents or any third party to use in domain names. The Disputed Domain Names contain the HARLEY-DAVIDSON trademarks and descriptive or geographical terms. Since these descriptive or geographic terms all invoke places (e.g., shop, outlets) or geographic locations (e.g., EU) where the Complainant's goods can be purchased, they clearly create an implied affiliation with the Complainant.

In the circumstances, the Disputed Domain Names were clearly registered to take advantage of the HARLEY-DAVIDSON trademarks. By merely registering the Disputed Domain Names, the Respondents have acted in bad faith. The Disputed Domain Names are confusingly similar to the HARLEY-DAVIDSON trademarks which are well known and the Disputed Domain Names have been registered by an unaffiliated entity and, therefore, there is a presumption of bad faith.

The Disputed Domain Name <harley-davidson-onlinesale.com> is being used to sell counterfeit goods. The remaining Disputed Domain Names are being passively held.

B. Respondents

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

6. Discussion and Findings

Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple Disputed Domain Name registrants pursuant to paragraph 10(e) of the Rules.

The Disputed Domain Name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.2.

As regards common control, the Panel notes that all of the Disputed Domain Names were registered around the same time using the similar naming pattern, with the same Registrar, and are hosted by the same nameserver. Moreover, it is most likely that the name and postal address of the Second Respondent is fake.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different Disputed Domain Name registrants (referred to below as "the Respondent") in a single proceeding.

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns registered trademark rights in its famous HARLEY-DAVIDSON trademark throughout multiple countries around the world. The addition of the other terms "club", "eu", "onlinesale", "outletshop", "outlets", and "world-outlet" does not prevent a finding of confusing similarity as the Complainant's HARLEY-DAVIDSON mark is clearly recognizable in the Disputed Domain Names. See sections 1.7 and 1.8 of the [WIPO Overview 3.0](#).

Accordingly, the Disputed Domain Names are confusingly similar to a mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant has presented a prima facie case that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names and has not been commonly known by the Disputed Domain Names. The fact that the Respondent obtained the Disputed Domain Names years after the Complainant had begun using its globally famous HARLEY-DAVIDSON mark indicates the Respondent sought to piggyback on the Complainant for illegitimate reasons. The evidence provided by the Complainant shows that one of the Disputed Domain Names <harley-davidson-onlinesale.com> resolved to an active website seemingly impersonating the Complainant by featuring the Complainant's trademark and logo apparently in an attempt to convince users it was selling legitimate products associated with the Complainant. However,

the Complainant asserts that the goods being sold at the website located at <harley-davidson-onlinesale.com> are counterfeit because these goods are being sold at prices far lower than authentic HARLEY-DAVIDSON goods and include goods that the Complainant does not manufacture or license.

After a complainant has made a prima facie case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the Disputed Domain Names.

Moreover, the Panel finds that the nature of the Disputed Domain Names carries a risk of an implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. Section 2.5.1 of the [WIPO Overview 3.0](#).

In the absence of any evidence rebutting the Complainant's prima facie case indicating the Respondent's lack of rights or legitimate interests in respect of the Disputed Domain Names, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Disputed Domain Names were registered years after the Complainant first registered and used its famous HARLEY-DAVIDSON trademark. The evidence provided by the Complainant makes it clear that the Respondent undoubtedly knew of the Complainant's widely known HARLEY-DAVIDSON mark and knew that it had no rights or legitimate interests in the Disputed Domain Names.

There is no benign reason for the Respondent to have registered the Disputed Domain Names that are confusingly similar to the Complainant's mark. Further, the use of the Disputed Domain Names by the Respondent is clearly in bad faith. The Complainant has established that the Respondent used one of the Disputed Domain Names in an attempt to sell counterfeit goods of the Complainant. Panels have held that the use of a domain name for illegitimate activity, here the claimed sale of counterfeit goods, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. While only one of the Disputed Domain Names was active, the clear inference is that the passive holding of the other is also bad faith use.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Section 3.3 of the [WIPO Overview 3.0](#). Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, the use of one of the Disputed Domain Names for the sale of possible counterfeit goods, and the composition of the Disputed Domain Names, and finds that in the circumstances of this case the passive holding of the Disputed Domain Names does not prevent a finding of bad faith under the Policy.

Accordingly, the Panel concludes that the Complainant has satisfied 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 Names <harley-davidson-club.shop>, <harley-davidson-eu.shop>, <harley-davidson-onlinesale.com>, <harley-davidson-outletshop.com>, <harley-davidson-outlets.shop>, and <harley-davidson-world-outlet.shop> be transferred to the Complainant.

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: February 3, 2025