

## **ADMINISTRATIVE PANEL DECISION**

Harley-Davidson Motor Company, Inc. v. AAA BBB, Domain Administrator  
Case No. D2024-4660

### **1. The Parties**

Complainant is Harley-Davidson Motor Company, Inc., United States of America, represented by Briffa, United Kingdom.

Respondent is AAA BBB, Domain Administrator, United States of America.

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

The disputed domain names <harley-davidsonstore.shop> and <harley-davidsonus.top> (the “Domain Names”) are registered with NameSilo, 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 and November 27, 2024, the Center respectively transmitted by emails to the Registrar requests for registrar verification in connection with the Domain Names. On November 14, 2024 and December 3, 2024, the Registrar respectively transmitted by emails to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent (Unknown) and contact information in the Complaint.

The Center sent an email to Complainant on November 14, 2024 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, requesting that Complainant either file separate complaint(s) for the Domain Names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all Domain Names are under common control. Complainant filed an amended Complaint on November 22, 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 Respondent 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. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on December 24, 2024.

The Center appointed Robert A. Badgley as the sole panelist in this matter on January 3, 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**

Complainant is a leading motorcycle manufacturer and has been in business for more than a century. According to Global Brands, Complainant's HARLEY-DAVIDSON trademark is the fourth most valuable brand in the field of motorcycles.

Complainant holds various registered trademarks for HARLEY-DAVIDSON, including: United Kingdom Reg. No. UK00001271222 for the mark HARLEY-DAVIDSON, registered on September 30, 1988 in connection with, among other things, "jackets, trousers, belts"; United Kingdom Reg. No. UK00901172329 for the mark HARLEY-DAVIDSON, registered on August 7, 2000 in connection with, among other things, "vehicles, [...], motorcycles, motorcycle engines and accessories for motorcycles."

Complainant's gross sales in 2023 exceeded USD 5 billion.

Complainant has owned the domain name <harley-davidson.com> since 1994 and uses that domain name to host a commercial website and promote its products. At this website, Complainant frequently uses the marks HARLEY-DAVIDSON, HD, and H-D to identify and distinguish its various products.

Complainant maintains a robust social media presence, with more than 12 million Facebook followers, 4.7 million Instagram followers, and 498,000 X followers.

The Domain Names were registered on May 16 and 29, 2024. Both Domain Names resolve to websites featuring Complainant's trademark and logos and offering goods for sale. According to Complainant, these are counterfeit goods designed to resemble Complainant's products.

Respondent has not denied any of the foregoing allegations.

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

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

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

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

Respondent did not reply to Complainant's contentions.

#### **6. Discussion and Findings**

##### **6.1 Consolidation and Multiple Purported Respondents**

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 Complainant's implicit request to consolidate in a single UDRP proceeding multiple domain names purportedly registered by different persons or entities, 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 noted above, both Domain Names were registered within a two-week period with the same Registrar. In addition, as Complainant asserts, there are similarities between the websites to which the Domain Names resolve, namely:

- a. Similar images of Harley-Davidson branded goods, similar font and similar website format.
- b. They offer discounts of over 70% for Harley-Davidson branded goods on their landing pages.
- c. Their landing pages feature images of Harley-Davidson apparel with red markings in the top right corners featuring the discounted percentage and followed by the word 'OFF'.

The Panel notes further that neither of the nominal Respondents has come forward to deny that both Domain Names were registered by the same person or entity or are under common control.

In these circumstances, the Panel finds it more likely than not that the two named Respondents are one and the same person, and henceforth the Panel will refer to them in the singular as "Respondent."

## **6.2 Merits**

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to each of the Domain Names:

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

### **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 Complainant's trademark and the Domain Names. [WIPO Overview 3.0](#), section 1.7.

The Panel concludes that Complainant has rights in the trademark HARLEY-DAVIDSON through registration and use demonstrated in the record. The Panel also concludes that the Domain Names are confusingly similar to that mark. The Domain Names entirely incorporate the mark and add the words "store" or "us." The Panel concludes that the mark remains clearly recognizable within the Domain Names despite these additional words.

Complainant has established Policy paragraph 4(a)(i).

### **B. Rights or Legitimate Interests**

For each of the Domain Names, pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services; or

- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized 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 often primarily within the knowledge or control of the respondent. Thus, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production 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.

The Panel concludes that Respondent lacks rights or legitimate interests in connection with the Domain Names. Respondent has not come forward in this proceeding to refute any of the plausible allegations made by Complainant, or challenge any of the evidence put forth by Complainant. It is clear from this undisputed record that Respondent targeted Complainant’s famous HARLEY-DAVIDSON mark. According to the undisputed record, Respondent is selling “counterfeit” versions of Complainant’s products. Such conduct obviously does not invest Respondent with rights or legitimate interests vis-à-vis the Domain Names.

Complainant has established Policy paragraph 4(a)(ii).

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

For each of the Domain Names, paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation,” are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent registered and used the Domain Names in bad faith under the Policy. The Panel incorporates its discussion above in the “Rights or Legitimate Interests” section. On this record, the Panel finds it clear that Respondent targeted Complainant’s famous mark when registering the Domain Names and has used the Domain Names for illegitimate commercial gain by seeking to divert Internet traffic for commercial gain by free-riding on Complainant’s well-known mark and, according to the undisputed record, selling counterfeit goods. This constitutes bad faith registration and use within the meaning of the above-quoted Policy paragraph 4(b)(iv).

Complainant has established Policy paragraph 4(a)(iii).

## **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 Domain Names <harley-davidsonstore.shop> and <harley-davidsonus.top> be transferred to Complainant.

*/Robert A. Badgley/*

**Robert A. Badgley**

Sole Panelist

Date: January 17, 2025