

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG v. 深圳市昌道科技有限公司 (Shen Zhen Shi Chang Dao Ke Ji You Xian Gong Si)

Case No. D2025-1095

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 深圳市昌道科技有限公司 (Shen Zhen Shi Chang Dao Ke Ji You Xian Gong Si), China.

2. The Domain Name and Registrar

The disputed domain name <istabmw.com> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on March 17, 2025. On March 18, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 19, 2025, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name 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 19, 2025, 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 in English on March 24, 2025.

On March 19, 2025, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. On March 24, 2025, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 in English and Chinese of the Complaint, and the proceedings commenced on March 25, 2025. In accordance with the Rules, paragraph 5, the due date for Response was April 14, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 15, 2025.

The Center appointed Jacob Changjie Chen as the sole panelist in this matter on April 22, 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, headquartered in Germany, is one of the leading manufacturers of automobiles and motorcycles. The Complainant has been using its BMW trademark in connection with advertising, promoting and offering of automobiles, motorcycles and other related products and services. In addition, the Complainant offers ISTA and ISPI proprietary diagnostic systems for maintenance, repair, serving and programming BMW automobiles, which are offered exclusively to authorized dealers and other permitted parties.

The Complainant is the owner of the following BMW and ISTA registrations:

- Germany Trademark BMW No. 221388, registered on December 10, 1917, in Classes 7, 8, 9, 11, and 12;
- United States Trademark BMW No. 611710, registered on September 6, 1955, in Class 12;
- Germany Trademark ISTA No. 302017102978, registered on April 10, 2017, in Classes 9, 37, and 42; and
- United States Trademark ISTA No. 5430672, registered on March 27, 2018, in Classes 9, and 42.

The Complainant operates its international portal websites located at the domain names <bmw.com> and <bmwgroup.com>, to promote its products and services.

The disputed domain name was registered on December 3, 2022. Shortly before the filing of the Complaint, the disputed domain name resolved to a website purportedly providing paid diagnostic coding programming for BMW motorcycles and system tools by a SmartBimmer. At the time of filing of the amended Complaint, the disputed domain name resolved to a website titled ISPI NEXT purportedly offering paid downloads of and updates for the Complainant's ISTA diagnostic software, and other OEM spare parts and related goods for the Complainant's BMW branded products, as well as for third-party competing brands. At the bottom of the webpage, there was a fine print disclaimer stating that "The BMW logo and the ISPI Next logo are registered trademarks of BMW AG, we're not affiliated with BMW in any way".

5. Parties' Contentions

A. Complainant

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

Notably, the Complainant contends that:

- The disputed domain name is confusingly similar to the Complainant's trademarks as it consists solely of the Complainant's two identical trademarks and such combination in no way distinguishes the disputed domain name from the Complainant's trademarks but instead increases the likelihood of confusion.

- The Respondent has no rights or legitimate interests in the disputed domain name.
- The Respondent registered and is using the disputed domain name in bad faith. The Respondent had actual knowledge of the Complainant and its trademarks prior to registering and using the disputed domain name. By using the disputed domain name to build the website, the Respondent is passing itself off as the Complainant or as affiliated with the Complainant. The Registration and use in bad faith is thus constituted.

B. Respondent

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

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that (i) the disputed domain name targets the Complainant's two English trademarks; and (ii) the disputed domain name resolves to a website with content displayed entirely in English.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition \("WIPO Overview 3.0"\)](#), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

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 trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

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

The entirety of the marks is reproduced within the disputed domain name. Although the two trademarks are combined, the Panel finds that both marks are clearly recognizable within the disputed domain name. The combination does not prevent a finding of confusing similarity between the disputed domain name and the marks for the purpose of the Policy. Accordingly, the disputed domain name is confusingly similar to each of the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 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 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 name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Shortly before the filing of the Complaint, the disputed domain name resolved to a website purportedly providing paid diagnostic coding programming for BMW motorcycles and system tools by a SmartBimmer. At the time of filing of the amended Complaint, the disputed domain name resolved to a website titled ISPI NEXT purportedly offering paid downloads of and updates for the Complainant’s ISTA diagnostic software, and other OEM spare parts and related goods for the Complainant’s BMW branded products, as well as for third-party competing brands. At the bottom of its homepage, the website contains a disclaimer stating “The BMW logo and the ISPI Next logo are registered trademarks of BMW AG, we’re not affiliated with BMW in any way”. The disclaimer is however neither sufficiently prominent nor effective as it is put at the very bottom of the webpage, a place where a customer would not normally have a chance to review before placing orders. In addition, the website at the disputed domain name also offers third-party products. The Panel finds such use does not constitute a bona fide offering of goods or services.

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

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the disputed domain name consists solely of the Complainant’s two trademarks, and has resolved to a website expressively providing products and services connected to the Complainant. It is thus inconceivable that the Respondent could have registered the disputed domain name without knowledge of the Complainant and its trademarks. This is sufficient evidence of registration in bad faith.

By choosing two of the Complainant’s trademarks and combining them in the disputed domain name, the Respondent is intentionally attempting to misrepresent itself as being affiliated with or endorsed by the Complainant. The use of the disputed domain name as described above also shows that 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, which constitutes bad faith under paragraph 4(b)(iv) of

the Policy. Though a disclaimer appears at the bottom of the website, the Panel finds, considering the overall circumstances of this case, that the mere existence of a disclaimer cannot cure such bad faith.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

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 name <istabmw.com> be transferred to the Complainant.

/Jacob Changjie Chen/

Jacob Changjie Chen

Sole Panelist

Date: May 6, 2025