

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG v. Gunnar Franek, gunnar.ai
Case No. DAI2024-0003

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 Gunnar Franek, gunnar.ai, United States.

2. The Domain Name and Registrar

The disputed domain name <bmwgroup.ai> is registered with Porkbun LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 9, 2024. On January 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 10, 2024, 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 January 15, 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 January 15, 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 January 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 12, 2024. The Respondent did not submit any formal response. On January 29, 2024 the Respondent sent to the Center an informal email. Accordingly, the Center notified the Respondent with Commencement of Panel Appointment Process on February 13, 2024.

The Center appointed Elise Dufour as the sole panelist in this matter on February 16, 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

Founded in 1916, the Complainant is Bayerische Motoren Werke AG, a leading manufacturer of automobiles and motorcycles, which headquarters are located in Germany.

The Complainant's products and components are manufactured at 31 sites in countries around the world, and the Complainant has more than 149,000 employees worldwide.

In addition, from 2018 through 2022, the Complainant sold more than 2,000,000 automobiles and more than 162,000 motorcycles under the BMW trademarks.

The Complainant owns numerous registered trademarks, including, but not limited to:

- German trademark registration No. 221388 for the mark BMW and Design, registered on December 10, 1917;
- German trademark registration No. 410579 for the mark BMW in block letters, registered on November 15, 1929;
- German trademark registration No. 302016105664 for the mark BMW GROUP in block letters, registered on November 1, 2027;
- United States trademark registration No. 611710 for the mark BMW in block letters, registered on September 6, 1955;

The BMW trademarks have been recognized repeatedly as one of the top 100 brands in the world.

The Complainant also owns various domain names composed with the BMW trademarks such as <bmw.com> or <bmwgroup.com>.

The disputed domain name was registered on September 9, 2023. It used to be offered for sale on the Registrar's website for the price of USD 100,00.00.

The disputed domain name now resolves to a Registrar waiting page.

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.

The Complainant submits that the disputed domain name is identical and confusing similar to its famous registered trademarks BMW, inasmuch the disputed domain name consists of the Complainant's identical BMW GROUP trademark in combination with the country-code Top-Level Domain ("ccTLD") ".ai".

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has never authorized the registration of the disputed domain name. In addition, the Complainant stresses that the Respondent is intending to sell and profit from the disputed

domain name, given that the disputed domain name resolves to a webpage advertising and explicitly offering the disputed domain name for sale, with a listed “Buy Now Price” of USD 100,000 a sum far in excess of the costs of registration. For The Complainant, this is not a bona fide offering of services or goods or a legitimate noncommercial or fair use.

According to the Complainant, the disputed domain name has been registered and used in opportunistic bad faith. Offering it for sale for a sum in excess of registration costs demonstrates the Respondent’s primary intention behind registering the disputed domain name is financial gain.

B. Respondent

The Respondent did not put in a formal Response but sent an informal email on January 29, 2024 stating : “Hi, I’ve just been made aware of this whole ordeal... and it seems to be happening very quickly! I will be contacting better counsel tomorrow. Please bear with me. Thanks, Gunnar Franek”.

6. Discussion and Findings

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Complainant provided evidence of its rights in the BMW and BMW GROUP trademarks, which have been registered since at least as early as 1917 and 2017 respectively, well before the Respondent registered the disputed domain name.

The Complainant has also submitted evidence, which supports that BMW is a widely known trademark and a distinctive identifier of the Complainant’s products. The Complainant has therefore proven that it has the requisite rights in the marks BMW and BMW GROUP.

Here, the Panel found that the disputed domain name is confusingly similar to the Complainant’s BMW trademark and it is identical to the Complainant’s BMW GROUP trademark. The BMW trademark is completely incorporated in the disputed domain name.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

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.

Indeed, the fact that the disputed domain name resolves to a page where it is offered for sale at a high price cannot be considered a bona fide offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name, particularly where the Complainant's trademark is fully incorporated 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.

As such the Panel finds that the Respondent does not have rights or a legitimate interest in the disputed domain name and that the Complainant has satisfied the paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Respondent registered and has been using the disputed domain name that is confusingly similar to the BMW trademark and is identical to BMW GROUP trademark. When the Respondent registered the disputed domain name in September 2023, the Complainant had been using its trademarks for many years worldwide. Given the Complainant's widespread and long-standing use of its trademarks worldwide, the Panel finds it is highly unlikely the Respondent was unaware of its trademarks when it registered the disputed domain name.

The Respondent's bad faith registration is also evidenced by the facts that: (1) the Respondent has not shown that he has any rights or legitimate interests in the disputed domain name; (2) the Respondent registered the disputed domain name that is exactly the same as the Complainant's registered BMW GROUP trademark; (3) the Respondent did not answer to the Complainant's arguments.

On the uncontroverted evidence, the Panel finds that the Respondent registered the disputed domain name in bad faith.

As per the use of the disputed domain name, 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 trademarks as to the source, sponsorship, affiliation or endorsement of such site or the products or services advertised on such site, within the meaning of paragraph 4(b)(iv) of the Policy.

Furthermore, as indicated above, the disputed domain name was offered for sale for USD 100,000 on the Registrar's website, proving that the Respondent has most likely registered the disputed domain name with a view to re-selling it at a profit in excess of the registration costs.

The Panel therefore holds that the Complainant has established element (iii) above.

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, <bmwgroup.ai> be transferred to the Complainant.

/Elise Dufour/

Elise Dufour

Sole Panelist

Date: March 1, 2024