

ADMINISTRATIVE PANEL DECISION

BMW Car Club of Victoria Inc. v. Graeme Alan Bell
Case No. DAU2023-0020

1. The Parties

The Complainant is BMW Car Club of Victoria Inc., Australia, internally represented.

The Respondent is Graeme Alan Bell, Australia.

2. The Domain Names and Registrar

The disputed domain names <bmwccv.au> (the “first disputed domain name”) and <bmwccv.com.au> (the “second disputed domain name”) are registered with Web Address Registration Pty Ltd (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 21, 2023. On April 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 25, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au 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 May 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 25, 2023. The Response was filed with the Center on May 21, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on June 5, 2023. 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 was formed in 1980. As its name suggests, it is a club for BMW car enthusiasts based in Victoria, Australia. It operates with the approval of BMW Clubs Australia which in turn operates under the umbrella of BMW headquartered in Germany.

The membership of the Complainant has varied over time. In 2017, it was as high as 717, falling to a low of 485 in May 2020 and recovering to 673 around August 2022.

From 2005 until 2009, the Complainant maintained a website at “www.bmwccv.bmwclubs.asn.au”.

From 2009 until 2019, the Complainant maintained a website at “www.bmwccv.com.au/forums” or “www.bmwccv.com.au”.

Since 2019, the Complainant’s website has been at “www.bmwclubvic.com.au”.

In the period from 2009 to 2019, the Complainant used the second disputed domain name in the email addresses of committee members conducting the club’s business and in activities such as soliciting advertising. The Complainant also used “BMWCCV” as a shorthand reference to itself and in events it conducted such as the promotion and conduct of the “BMWCCV Motorsport – Round 3 Winton” in 2011. The Complainant has continued to use the acronym BMWCCV on its website and in communications to members such as “BMWCCV Event Alerts”.

The Complaint also includes a letter of support from BMW Clubs Australia which claims that the Complainant has used the acronym BMWCCV for club branding, merchandise and communication for 40 years. Evidence of the use on merchandise has not been included.

The Respondent conducts a business under the name Bell Motorsport. He is a BMW enthusiast and his business involves production of BMW race cars and modifying BMW road cars.

The Respondent was a committee member of the Complainant from at least 2005 until around April 9, 2018. For a considerable part of that period, the Respondent was the Complainant’s president and, amongst other things, its Motorsport Captain. The Complainant recognized the Respondent’s services to the club by awarding him a life membership.

By April 2018, however, there had been a change in the officers of the Complainant and, on April 9, 2018, the Respondent resigned in acrimonious circumstances.¹ At that time, the Respondent was the Complainant’s Motorsport Captain. The Respondent’s partner and at least one other person resigned from the Complainant shortly afterwards.

Shortly before he resigned, on April 2, 2018, the Respondent registered, or caused to be registered, a non-profit incorporated association under the name BMW Drivers Club Melbourne Inc. – Melbourne being the capital of Victoria. The Respondent, his partner, and their associate became the founding officers of this entity. According to the Respondent, this club is now the second largest BMW car club in Australia. This club also operates under the auspices of BMW Clubs Australia and the international umbrella organization. This club has been awarded the International BMW Club of the Year in 2021 by BMW Group Classic and BMW Clubs International Council.

The Respondent registered the second disputed domain name some time before 2009 – the Registrar gives a creation date in 2008. The Respondent had tried to interest the Complainant in registering the second disputed domain name but, at the time, the Complainant preferred to use “bmwccv.bmwclubs.asn.au”.

¹ The Respondent disputes the allegations made against him leading up to his resignation. The Panel is not in a position to determine the rights or wrongs of the allegations. Nor is it any part of the Panel’s role which is solely concerned with determining the three issues arising under the Policy.

The Respondent says he registered the second disputed domain name to ensure that no-one could gazump the Complainant.

As noted above, however, the Complainant's position changed in 2009 and it switched over to using the second disputed domain name. This was done with the Respondent's knowledge and consent. The Respondent did not charge the Complainant for this use of the second disputed domain name and paid the renewal fees out of his own pocket.

The Complainant continued to use the second disputed domain name for its URL after the Respondent resigned.

While the Respondent disputed allegations which had been made against him and the history of the registration and use of the second disputed domain name, the Respondent agreed in writing on four separate occasions in 2019 to transfer the registration of the second disputed domain name to the Complainant. However, the Respondent never acted on those promises.

According to the Complainant, a further request to transfer the second disputed domain name was made early in 2020 and orally agreed to by the Respondent. If so, the Respondent still did not transfer the second disputed domain name to the Complainant.

Instead, in March 2020, the Complainant registered the domain name <bmwcarclubvic.com.au> and transferred its website and adopted it for its electronic communications.

Since the Complainant transferred its website to "www.bmwcarclubvic.com.au", the second disputed domain name has been inactive.

The Respondent, however, has renewed the registration each year. On March 24, 2022, the first disputed domain name was registered. This was the date when direct registration in the ".au" domain became available on a priority basis to those already holding a registration in a second level domain such as ".com.au". So far as the record in this proceeding shows, the first disputed domain name has always been inactive.

On June 27, 2022, shortly after the Respondent received a letter from BMW Clubs Australia requesting that he release the disputed domain names to the Complainant, the Respondent registered the business name "Bell Motoring World Car Collection, Victoria".

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain names, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered or subsequently used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that the Panel deems applicable.

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 name. Overview of Panel Views on Selected auDRP Questions, Second Edition ("auDA Overview 2.0"), section 1.7.

Based on the available record, the Panel finds the Complainant has established a sufficient reputation in the acronym BMWCCV for it to qualify as an unregistered trade mark or service mark for the purposes of the Policy. auDA Overview 2.0, section 1.3.

In comparing that trade mark to the disputed domain names, it is permissible to disregard the second level and first level domain elements, ".com.au" and ".au", as functional requirements of the domain name system. See auDA Overview 2.0, 1.11 and by analogy with the corresponding requirement under the Uniform Domain Name Dispute Resolution Policy (UDRP), WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.

Disregarding those domain name elements, both disputed domain names consist of the Complainant's trade mark.

Accordingly, the disputed domain names are identical to the Complainant's trade mark for the purposes of the Policy.

Based on the available record, therefore, the Panel finds the first element of the Policy has not 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.

While 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. auDA Overview 2.0, section 2.1.

In the present case, it is not in dispute between the Parties that the Respondent is no longer associated with the Complainant nor authorised by the Complainant to use the disputed domain names.

Neither is the disputed domain name derived from the Respondent's own name. Nor does the Respondent claim to have been commonly known by some other name from which the disputed domain names could be derived when he registered them. While the Respondent incorporated the association under the name BMW Drivers Club Melbourne Inc. in 2018, such incorporation was years after the registration of the second disputed domain name.

First, the name of that club does not provide an acronym for the letters of the above-mentioned association (namely, "bmwdcm").

Secondly, even on the Respondent's own case, he registered at least the second disputed domain name to protect the Complainant's interests, not in connection with a proposed business operating under the name Bell Motoring World Car Collection, Victoria.

Thirdly, while registration of a business name can qualify as a name for the purposes of the first requirement of the Policy, mere registration as a business name is not in itself sufficient to confer rights or legitimate interests under the Policy. This is because registration of a business name does not confer substantive rights; it is an obligation imposed on someone who is carrying on, or purports to be carrying on, business under a name other than their own name. See *Business Names Registration Act 2011* (Cth), section 18. See also *Peachbulk Pty Ltd v. Domain Boutique Pty Ltd*, WIPO Case No. [DAU2020-0013](#).

As a consequence, it is well-established that registration of and the right to use a business name are subject to prior existing trade mark rights including unregistered trade mark rights: *BM Auto Sales Pty Ltd v. Budget Rent A Car System Pty Ltd* (1976) 51 ALJR 363; 12 ALR 363 at 369 (Gibbs J, Barwick CJ and Murphy J agreeing); *Cardile v LED Builders Pty Ltd* [1999] HCA 18; 198 CLR 380 at [61] (Gaudron, McHugh, Gummow and Callinan JJ).

Fourthly, there is no evidence before the Panel of any business being carried on under the business name Bell Motoring World Car Collection, Victoria; nor any evidence of preparations for any such use. That means there is no evidence of a reputation in the business name. Accordingly, the Panel cannot accept that the Respondent is using the disputed domain names in connection with a good faith offer of goods or services or preparations for such a use.

Moreover, the Respondent registered the business name well after he became aware that the Complainant disputed his entitlement to hold the disputed domain names. In addition, as stated above, it appears that BMW Clubs Australia supported the Complainant's entitlement notwithstanding the Respondent's incorporation of the association BMW Drivers Club Melbourne Inc. with the recognition of both BMW Clubs Australia and the BMW Clubs International Council.

In these circumstances, the Panel cannot accept that the Respondent adopted the business name in good faith.

Based on the available record, therefore, the Panel finds the second element of the Policy has been established.

C. Registered or Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain names have been either registered or subsequently used in bad faith by the Respondent. In contrast to the Uniform Domain Name Dispute Resolution Policy, the requirements of registration or use are disjunctive. It is necessary for the Complainant to establish only one or the other. See auDA Overview 2.0, section 3.1.

Paragraph 4(b) of the Policy provides that:

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business or activities of another person; or

- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location; or
- (v) if any of your representations or warranties as to eligibility or third party rights given on application or renewal are, or subsequently become, false or misleading in any manner.

The instances of bad faith set out in paragraph 4(b) of the Policy are examples only, intended to illustrate types of conduct which is caught by the Policy. See auDA Overview 2.0, section 3.1.6.

It is also well-established that there can be use in bad faith under the Policy even in the absence of actual use – so-called passive holding. See in the context of the UDRP, *Telstra Corporation Limited v Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

There is no dispute in the present case that the Respondent was in fact well aware of the Complainant's trade mark when he registered both disputed domain names.

It does not appear to be contended that the Respondent registered the second disputed domain name in bad faith. In any event, the Complainant clearly accepted that registration and acquiesced in it.

Despite promising to transfer the registration of the second disputed domain name to the Complainant, however, the Respondent has continued to hold on to the registration after his association with the Complainant came to an end. The Panel finds that his maintenance of control over the second disputed domain name once that association came to end and he had set up and was operating a rival car club constitutes use in bad faith under the Policy.

It is true the Respondent did allow the Complainant to continue using the second disputed domain name after he severed his ties with the Complainant and set up the rival club. Understandably, that arrangement was not acceptable to the Complainant in the circumstances. His insistence on maintaining control over the second disputed domain name in these circumstances, therefore, is akin to the conduct proscribed by paragraph 4(b)(ii) and (iii) of the Policy.

Furthermore, the Respondent's renewal of the registration of the second disputed domain name each year after he severed ties with the Complainant appears to qualify as bad faith in accordance with paragraph 4(b)(v). First, until the belated registration of Bell Motoring World Car Collection, Victoria, the Respondent does not appear to have been eligible to hold the second disputed domain name and so was in breach of the warranties given both on registration and renewal. See auDA Overview 2.0, section 3.1.5. As noted in Section 5B above, the belated registration of Bell Motoring World Car Collection, Victoria did not confer rights or legitimate interests in the disputed domain name. Further, if the Respondent were to use the second disputed domain name in connection with the activities he is actually carrying on, that use would misrepresent an association with or endorsement by the Complainant.

Accordingly, the Panel finds that the Respondent has used the second disputed domain name in bad faith contrary to the Policy.

For the reasons outlined in section 5B above, the Panel has rejected the Respondent's claim to rights or legitimate interests in the first disputed domain name. In those circumstances, the Panel infers that the Respondent registered the first disputed domain name for the purposes specified in paragraph 4(b)(ii) or (iii). Furthermore, for the reasons explained in relation to the second disputed domain name, the Panel also finds that the Respondent has used the first disputed domain name in bad faith.

Accordingly, the Complainant has established all three requirements under 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:

1. the disputed domain name, <bmwccv.com.au>, be transferred to the Complainant; and
2. the disputed domain name, <bmwccv.au>, be cancelled.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: June 19, 2023

ADDENDUM TO ADMINISTRATIVE PANEL DECISION

This is an addendum to the Administrative Panel Decision (“Decision”) dated June 19, 2023 with regard to the disputed domain names <bmwccv.com.au> and <bmwccv.au>. The Panel wishes to issue the following clarifications.

Factual Background

The Panel notes that based on the available information, the Respondent has never been the Complainant’s president, and such has not been correctly reflected under the Factual Background.

Accordingly, the Panel clarifies that “The Respondent was a committee member of the Complainant from at least 2005 until around April 9, 2018. For a considerable part of that period, the Respondent was the Complainant’s president and, amongst other things, its Motorsport Captain.” should be replaced by the following: “The Respondent was a committee member of the Complainant from at least 2005 until around April 9, 2018. For a considerable part of that period, the Respondent was the Complainant’s Motorsport Captain.”

First Element

A typographical error inadvertently crept into the Panel’s decision under the first element. The decision mentions that “Based on the available record, therefore, the Panel finds the first element of the Policy has not been established.”

However, as the Panel found that the first element of the Policy has been established, the Panel intends to state the following: “Based on the available record, therefore, the Panel finds the first element of the Policy has been established”.

Decision

The Panel reaffirms the Decision in favor of the Complainant.

For avoidance of doubt, the Panel restates paragraph 7 of its Decision as follows:

“For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that:

1. the disputed domain name, <bmwccv.com.au>, be transferred to the Complainant; and
2. the disputed domain name, <bmwccv.au>, be cancelled.”

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: July 10, 2023