

ADMINISTRATIVE PANEL DECISION

Dr. Ing. h.c. F. Porsche AG v. Super Privacy Service LTD c/o Dynadot /
Abedellatif Shatila
Case No. D2022-0928

1. The Parties

The Complainant is Dr. Ing. h.c. F. Porsche AG, Germany, represented by UNIT4 IP
Rechtsanwälte, Stolz Stelzenmüller Weiser Grohmann Partnerschaft mbB Rechtsanwälte, Germany.

The Respondent is Super Privacy Service LTD c/o Dynadot, United States of America ("USA") / Abedellatif
Shatila, Lebanon.

2. The Domain Name and Registrar

The disputed domain name <porschemadison.com> is registered with Dynadot, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 16, 2022. On March 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 18, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on March 18, 2022 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 amendment to the Complaint on March 23, 2022.

The Center verified that the Complaint together with the amendment to the 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 March 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 19, 2022.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on May 9, 2022. 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 manufacturer of sports cars that has been operating under the brand and trade name PORSCHE for more than 70 years.

The Complainant owns numerous registered trademarks worldwide consisting of or incorporating the word PORSCHE, including the Lebanon trademark registration number 77819, obtained on November 23, 1998.

The Complainant is also the holder of dozens of domain names encompassing the PORSCHE trademark, including <porsche.com>, registered on November 7, 1996.

The disputed domain name <porschemadison.com> was registered on May 2, 2020.

The Complainant provided evidence that the disputed domain name redirected to a webpage announcing that the disputed domain name was being offered for sale, for USD 1,000.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The disputed domain name consists of the famous trademark PORSCHE to which is appended the name of a well-known city in the USA, Madison, that is descriptive of the location of a PORSCHE dealership. The disputed domain name is therefore confusingly similar to the trademarks in which the Complainant has rights, as previously decided in many other UDRP cases.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name. There is not and never has been a business relationship between the Parties. The Complainant has not licensed or otherwise permitted the Respondent to use its name and trademarks. Obviously, the Respondent is not commonly known by the disputed domain name. Neither is there a use nor are there any preparations to use the disputed domain name with a *bona fide* offering of goods or services. The disputed domain does not resolve to an active website and is being offered for sale, what does not constitute a legitimate interest in the domain name. Investigations revealed that a multitude of domain names corresponding to famous marks of individual brand owners have been registered by "Abedellatif Shatila" over many years.

- The disputed domain name was registered and is being used in bad faith. It is evident that the Respondent has registered the disputed domain name only for the purpose of selling it and thus in bad faith. There is no doubt that, already at the time of registration of the disputed domain name, the Respondent must have known about the Complainant and its world-famous name and trademarks PORSCHE, which have enjoyed an outstanding reputation worldwide for more than 70 years. The disputed domain name is also misleading the public, as it is exclusively associated with the world-famous Complainant. It is obvious that the public expects an official domain/website at the disputed domain name, which is not the case. Further, the registration of the disputed domain by the Respondent prevents the Complainant from registering and using it for its business and local PORSCHE dealership in the city of Madison, USA, thus limiting its rights in the PORSCHE name and trademarks. In addition, the Respondent conceals his true identity intentionally in order to frustrate the enforcement of the Complainant's rights by using a privacy service, which underlines his bad faith. The disputed domain name was registered primarily for the purpose of disrupting the business

of the Complainant and for commercial gain. Finally, as the disputed domain name does not resolve to an active website, the Respondent is also engaged in bad faith passive holding in the sense of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 3.3, and of paragraph 4(b), in particular with regard to the fact that: (i) the Complainant's name and marks are world-famous and have a strong reputation, (ii) the true identity of the domain holder is concealed, and (iii) any good faith use of the disputed domain name is absolutely implausible.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark 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 and is being used in bad faith.

A. Identical or Confusingly Similar

The Complaint has provided evidence of trademark registrations for PORSCHE obtained by the Complainant as early as in 1956.

The disputed domain name differs from the Complainant's trademark PORSCHE by the mere addition of the suffix "madison", as well as the generic Top-Level Domain ("gTLD") ".com".

Previous UDRP decisions have found that the mere addition of terms to a trademark in a domain name do not avoid a finding of confusing similarity. This has been held in many UDRP cases (see, e.g., *Inter-IKEA Systems B.V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#); *Wal-Mart Stores, Inc. v. Lars Stork*, WIPO Case No. [D2000-0628](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#); *AltaVista Company v. S. M. A., Inc.*, WIPO Case No. [D2000-0927](#)).

It is also already well established that the addition of a gTLD such as ".com" is typically irrelevant when determining whether a domain name is confusingly similar to a complainant's trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks, and that the Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate a right or legitimate interest in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name; or

(iii) the respondent is 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 at issue.

Based on the Respondent's default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has provided no evidence of rights or legitimate interests in the disputed domain name.

The Complainant has not licensed or authorized the usage of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name. The Panel also notes that the present record provides no evidence to demonstrate the Respondent's intent to use or to make preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Indeed, the disputed domain name is being offered for sale for valuable consideration, likely in excess of the registration costs, in an attempt to unfairly capitalize on the reputation and goodwill of the Complainant's trademark.

Moreover, the nature of the disputed domain name, incorporating the Complainant's well-known trademark and a term that relates to an physical location where the Complainant operates, carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent in 2020, the trademark PORSCHE was already famous worldwide for many decades. Such is the reputation of the Complainant's trademark that it would be very unlikely to imagine that the Respondent had not considered it when registering the disputed domain name.

Besides the gTLD ".com", the disputed domain name is comprised of the Complainant's trademark PORSCHE and of the city name "Madison". The Respondent has not provided any justification for the registration of a domain name containing a notorious third-party trademark and a reference to a capital of a state in the United States. Indeed, the Complainant demonstrated that the Respondent has already registered other domain names encompassing famous brands of automotive manufacturers together with the

name of major cities.

Therefore, the Panel concludes that it would not be feasible to consider that the Respondent – at the time of the registration of the disputed domain name – could not have been aware of the Complainant's trademark, as well as that the adoption of the expression "porschemadison" could be a mere coincidence.

The disputed domain name redirects Internet users to a website offering the disputed domain name for sale. The Panel finds that the circumstances of the case, including (i) the worldwide notoriety of the Complainant's trademark PORSCHE, (ii) the offer of the disputed domain name for sale for valuable consideration likely in excess of documented out-of-pocket costs directly related to the domain name, and (iii) the Respondent's demonstrated pattern of conduct of registering domain names containing famous brands, are enough to characterize bad faith also in the use of the disputed domain name within the context of 4(b)(i) of the Policy.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied 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 <porschemadison.com> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: May 23, 2022