

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG v. Artur Tadevosyan
Case No. D2023-0482

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 Artur Tadevosyan, United States.

2. The Domain Name and Registrar

The disputed domain name <longislandbmw.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 1, 2023. On February 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 3, 2023, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 14, 2023 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 February 16, 2023.

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 February 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 27, 2023. The Respondent sent two informal emails to the Center on April 4 and April 5, 2023.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on April 4, 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 is a leading manufacturer of automobiles and owns many trademark registrations for BMW such as United States registration No. 0611710, registered on September 6, 1955, and German registration No. 410579, registered on November 15, 1929.

The disputed domain name was registered on June 26, 2011, and does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The trademark BMW is well-known. The disputed domain name incorporates the Complainant's trademark in its entirety. The addition of the geographic descriptor "Long Island" does not eliminate confusing similarity but on the contrary increases confusion. The generic Top-Level Domain ("gTLD") ".com" does nothing to eliminate confusing similarity.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not been commonly known by the disputed domain name. The Complainant did not authorize the Respondent to use its trademark. The disputed domain name is not used in connection with a *bona fide* offering of goods or services nor constitutes a legitimate noncommercial fair use as it resolves to a parked website.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The disputed domain name is confusingly similar to the Complainant's trademark as it prominently features the Complainant's trademark together with the descriptor "Long Island". The structure of the domain name reflects what is commonly used by the Complainant and its dealers. The Respondent is attempting to pass itself off as the Complainant or as affiliated or authorized by the Complainant. Passive holding as is the case here indicates bad faith. The Respondent must have been aware of the Complainant's trademark particularly that it is well-known.

B. Respondent

The Respondent did not submit a formal reply, but sent emails stating that he works in a BMW dealership and has registered the domain name since 2011.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant owns trademark registrations for the trademark BMW. The Panel is satisfied that the Complainant has established its ownership of the trademark BMW. The disputed domain name incorporates the Complainant's trademark BMW in its entirety. The addition of the words "Long Island" does not eliminate confusing similarity. The gTLD ".com" is generally ignored when assessing confusing similarity.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

A complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent. In the instant case, the Complainant asserts that the Respondent does not have rights or legitimate interests in the disputed domain name. Therefore, the Complainant has established a *prima facie* case and the burden of production shifts to the Respondent to show that it has rights or legitimate interests.

The Respondent has not provided any evidence to show that it has any rights or legitimate interests in the disputed domain name. The explanation (for which no evidence was provided) submitted by the Respondent that he works at a BMW dealership, even if accepted by the Panel as true does not by itself confer any rights or legitimate interests; such claim would be grounded on authorization to register the disputed domain name of which there is none.

Additionally, prior UDRP panels have found that domain names identical to or comprising a complainant's trademark plus certain additional terms (here, a geographical term) are seen as tending to suggest sponsorship or endorsement by the trademark owner and carry a high risk of implied affiliation (see section 2.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

Consequently, the Panel finds that the Complainant has met the requirement under the Policy of showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Respondent must have been aware of the Complainant's trademark as it is well-known (and he even claims to work for a dealer, if true thereby removing all doubt of knowledge of the Complainant's mark). The disputed domain name does not resolve to an active website, which constitutes passive holding. Noting the Respondent's failure to provide any good-faith explanation for its registration and use of the disputed domain name, the presumed knowledge by the Respondent of the Complainant's trademark (i.e., based on the Respondent's own claims), and the absence of a plausible use of the disputed domain name that would be legitimate (*Johnson & Johnson v. Daniel Wistbacka*, WIPO Case No. [D2017-0709](#)), the Panel finds that the use of the disputed domain name in these circumstances does not prevent the Panel's bad faith finding.

Further, prior UDRP panels have recognized that the mere registration of a domain name that is identical to a famous or widely-known trademark by an unaffiliated entity can itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) 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, <longislandbmw.com> be transferred to the Complainant.

Nayiri Boghossian/
Nayiri Boghossian
Sole Panelist
Date: April 17, 2023