

## **ADMINISTRATIVE PANEL DECISION**

**Bridgestone South Africa Holdings (Pty) Ltd v. Anthony Marcus, Auto Align and Tire CC, and Glen Martin**

**Case No. D2023-1359**

### **1. The Parties**

The Complainant is Bridgestone South Africa Holdings (Pty) Ltd, South Africa, represented by Moore Attorneys Incorporated, South Africa.

The Respondents are Anthony Marcus, Auto Align and Tire CC, and Glen Martin, South Africa.

### **2. The Domain Name and Registrar**

The disputed domain name <supaquick.net> 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 March 29, 2023. On March 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 30, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrants 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 March 30, 2023, providing the registrants 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 April 3, 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 April 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 2, 2023. The Respondent sent informal email communications on April 3, April 5, and April 18, 2023.

The Center appointed Archibald Findlay SC as the sole panelist in this matter on May 17, 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 following facts and circumstances are to be found in the Complaint and its Annexures and, in the absence of challenge, can be accepted as background.

The Complainant is a multinational auto and truck parts manufacturer founded in 1936, and as of 2015 it is one of the largest manufacturers of tires in the world.

The Complainant established its wholly-owned subsidiary Supa Quick in 1986, as a tire dealer and auto fitment center. The Complainant operates and manages 250 Supa Quick franchises throughout South Africa and employs over 4,000 fitment experts. The Complainant has spent considerable time, money, and effort in promoting and using its SUPA QUICK trademarks since at least 1986 which has, as a result, become well-known in South Africa.

The Complainant operates a webpage where members of the public can view its products at the domain name <bridgestone.co.za> and its SUPA QUICK brand also has an active website at the domain name <supaquick.com> registered on September 3, 1998. Additionally, the Complainant's <supaquick.co.za> domain name, registered on May 27, 1997, re-directs to the <supaquick.com> website. The Complainant's SUPA QUICK brand also has an active presence on various social media platforms.

The Complainant is the proprietor in South Africa of the SUPA QUICK and SUPA QUICK TYRE EXPERTS trademarks, including, *inter alia*:

- South Africa Trademark Registration No. 1986/02468 SUPA QUICK in Class 25;
- South Africa Trademark Registration No. 1987/03198 SUPA QUICK in Class 09;
- South Africa Trademark Registration No. 2011/02399 SUPA QUICK in Class 12;
- South Africa Trademark Registration No. 2011/02400 SUPA QUICK in Class 35; and
- South Africa Trademark Registration No. 2011/02405 SUPA QUICK TYRE EXPERTS in Class 35.

Details of the Complainant's trademarks are attached to the Complaint.

The Complainant is also the proprietor of the SUPA QUICK trademark in several other African countries, namely, Botswana, Namibia, Mozambique, Zambia and Zimbabwe; details of which are also attached to the Complaint.

The Complainant enjoys extensive common-law rights in its SUPA QUICK trademark. In this regard, the Complainant submits that the SUPA QUICK trademark is a widely-recognized brand and due to the extensive marketplace exposure of the SUPA QUICK trademark, it has become well-known to members of the public within the relevant sector.

The Complainant's common law trademark and service mark rights from its prior and extensive use of the SUPA QUICK trademark plainly satisfies the Policy. Further, the Complainant's multiple registrations of national and international trademarks also satisfy the Policy (*Horten Advokatpartnerselskab v. Domain ID Shield Service CO., Limited / Krutikov Valeriy Nikolaevich*, WIPO Case No. [D2016-0205](#)).

The disputed domain name was registered on January 27, 2011, and does not presently resolve to an active website.

## 5. Parties' Contentions

### A. Complainant

The Complainant contends that it enjoys extensive common-law rights in its SUPA QUICK trademark and submits that the SUPA QUICK trademark is a widely-recognized brand and, due to the extensive marketplace exposure of the SUPA QUICK trademark, it has become well-known to members of the public within the relevant sector.

On October 2, 2019, the Complainant was alerted to the existence of the disputed domain name. The Complainant through its attorneys, addressed a letter of demand to the registrants of the disputed domain name, a copy of which is annexed to the Complaint.

Subsequently to this letter of demand, the Complainant contends that one of the Respondents telephonically offered to transfer the disputed domain name to the Complainant but has since been unresponsive to further requests to do so.

The Respondents' disputed domain name <supaquick.net> is virtually identical to the Complainant's SUPA QUICK trademark, as it wholly incorporates the Complainant's trademark.

The addition of the generic Top-Level Domain ("gTLD") ".net" further creates a false impression that the disputed domain name is connected and/or associated with the Complainant, which is certainly not the case.

The Complainant also drew the Panel's attention to the test for confusing similarity set out in *The Vanguard Group, Inc. v Lorna Kang*, WIPO Case No. [D2002-1064](#) where that UDRP panel held as follows;

"The Panel considers the appropriate test for confusing similarity to be a literal comparison of the disputed domain name and the Complainant's mark".

The Complainant submitted that, on a literal comparison of the disputed domain name and the Complainant's trademark, the disputed domain name is virtually identical to the Complainant's registered SUPA QUICK trademark and that the addition of the gTLD ".net" does not distinguish the disputed domain name from the Complainant's trademark. In fact, the Complainant argued, it creates an impression that the services of the disputed domain name are linked to that of the Complainant's online platform.

The Respondents are neither affiliated with the Complainant nor licensed to use the Complainant's SUPA QUICK mark, nor licensed to register or use domain names, nor associated email accounts, incorporating the SUPA QUICK mark. Without the Complainant's knowledge or consent, the Respondents registered the disputed domain name on January 27, 2011.

The disputed domain name consists of the Complainant's entire distinctive SUPA QUICK mark and was clearly intended to be confusingly similar to the SUPA QUICK mark within the meaning of paragraph 4(a)(i) of the Policy. As set forth above, the Complainant's rights in the SUPA QUICK mark are clearly established through registration and use, both in South Africa and other Southern African countries.

In considering the question of identity or confusing similarity, the first element of the Policy is essentially a standing requirement. The threshold inquiry under the first element of the Policy is largely framed in terms of whether the trademark and the disputed domain name, when directly compared, are identical or confusingly similar. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7 (and cases cited therein).

The disputed domain name is confusingly similar to the Complainant's well-known SUPA QUICK mark and includes the whole of the Complainant's well-known SUPA QUICK mark. It follows, so the Complainant contends, that the disputed domain name is clearly confusingly similar to the Complainant's registered trademark SUPA QUICK.

The Respondents have no rights or legitimate interests in the disputed domain name in question as they do not operate a genuine business under the disputed domain name, as it is not connected with a *bona fide* offering of goods and services. The disputed domain name links to a parked website, and there can thus be no doubt that the disputed domain name was registered merely to interfere with the business of the Complainant and to confuse members of the public into believing that the disputed domain name belongs to the Complainant, when it does not. Furthermore, the Respondents are not commonly known by the disputed domain name.

The Complainant asserts that it has never provided the Respondents with permission to register the disputed domain name and/or use its trademarks. Given the Complainant's reputation, the adoption and registration of a domain name that is a replication of the Complainant's trademarks constitutes a misrepresentation that the disputed domain name is that of the Complainant, or that it is connected to or endorsed by the Complainant, when it is not.

It is highly unlikely that the Respondents would not have been aware of the Complainant's legal rights in the disputed domain name containing the mark SUPA QUICK at the time of registration.

The Complainant is of the view that the disputed domain name amounts to an abusive registration in the hands of the Respondents. The purpose of registering the disputed domain name is to confuse members of the public by making them believe that the disputed domain name is that of the Complainant.

The Respondents' registration of the disputed domain name cannot amount to a *bona fide* use on goods and/or services as it can be developed to take unfair advantage of and be detrimental to the distinctive character and reputation of the Complainant's acquired goodwill and reputation.

The Complainant registered the domain name <supaquick.co.za> in South Africa on May 27, 1997. This is 14 years before the Respondent registered the disputed domain name. The Complainant registered the domain name <supaquick.com> on September 3, 1998. This is 13 years before the Respondents registered the disputed domain name.

The Complainant's contentions in this regard are that the disputed domain name was registered and is being used in bad faith in that:

- (a) the Respondents seek to take unfair advantage of it which is detrimental to the Complainant's good will and reputation;
- (b) by so doing aim to prevent the trademark owner from reflecting the trademark in corresponding domain names; and
- (c) this is thus an abusive registration.

The registration of the disputed domain name may lead to confusion in that people may believe that the disputed domain name is that of the Complainant, when it is not, and unfairly disrupt the business of the Complainant.

Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

In light of the above, the Complainant submits that it has met the evidentiary thresholds of paragraphs 4(a), (b), (c) of the UDRP and accordingly calls for the transfer of the disputed domain name to the Complainant.

## B. Respondents

The Respondents did not submit a formal response to the Complainant's contentions.

The Respondents sent several email communications claiming to be using the disputed domain name for "Supaquick Kloof", and in connection with an email address, and in particular the Respondents stated in an email communication received on May 10, 2023;

"Please note that SupaQuick Kloof does not currently make use of the domain name <supaquick.net> and any use of the domain name was done so in without the knowledge or permission of Bridgestone South Africa as the holder of the SupaQuick trade marks."

## 6. Discussion and Findings

### A. Substantive Elements of the Policy

Paragraph 15(a) of the Rules requires that:

"A Panel shall decide a 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 it deems applicable."

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) That the disputed domain name registered by the Respondents is identical or confusingly similar to a trademark or a service mark in which the Complainant has rights.
- (ii) That the Respondents have no rights or legitimate interests in respect of the disputed domain name.
- (iii) That the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy sets out four illustrative circumstances or acts which would, for the purposes of paragraph 4(a)(iii) above, be evidence of the registration and use of a domain name in bad faith. These are non-exclusive.

Similarly, paragraph 4(c) of the Policy sets out three illustrative circumstances which would demonstrate the Respondents' rights or legitimate interests in the disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy.

### B. Identical or Confusingly Similar

The Complainant put up an extensive list of its registered SUPA QUICK marks which it owns in many countries.

The fact that the word mark SUPA QUICK has been entirely incorporated into the disputed domain name is sufficient to establish that it is identical to the Complainant's registered trademark, since the space between "supa" and "quick" cannot be reflected in a disputed domain name (*Quixtar Investments, Inc. v. Dennis Hoffman*, WIPO Case No. [D2000-0253](#); *Universal City Studios, Inc. v. David Burns and Adam-12 Dot Com*, WIPO Case No. [D2001-0784](#); *Lilly ICOS LLC v. John Hopking / Neo net Ltd.*, WIPO Case No. [D2005-0694](#); and *SOCIÉTÉ DES PRODUITS NESTLÉ SA v. Mustafa Yakin / Moniker Privacy Services*, WIPO Case No. [D2008-0016](#)).

The addition of the gTLD ".net" does not dispel the confusing similarity between the disputed domain name and the Complainant's mark (*TPI Holdings, Inc. v. LaPorte Holdings*, WIPO Case No. [D2006-0235](#); *Allstate Insurance Company v. Rakshita Mercantile Private Limited*, WIPO Case No. [D2011-0280](#)).

This is so in the view of the Panel and the use of the gTLD “.net” is not an element that would generally be taken into consideration when evaluating the identity and similarity of the Complainant’s trademark and the disputed domain name (*Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#); *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#); *Phenomedia AG v. Meta Verzeichnis Com*, WIPO Case No. [D2001-0374](#); and *Qantas Airways Limited v. Minh Huynh*, WIPO Case No. [D2008-1382](#)).

In these circumstances, the Panel has no difficulty in concluding that the Complainant has established the first element in terms of paragraph 4(a)(i) of the Policy.

### **C. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy sets out three illustrative circumstances as examples which, if established by a respondent, shall demonstrate his rights to or legitimate interests in the disputed domain name for the purposes of paragraph 4(a)(ii) of the Policy, namely:

- (i) before any notice to the Respondents of the dispute, the use by the Respondents of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondents (as an individual, business or other organization) has been commonly known by the domain name, even if the Respondents have acquired no trademark or service mark rights; or
- (iii) the Respondents are 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 or service mark at issue.

Although paragraph 4(a)(ii) requires the Complainant to prove that the Respondents have no rights to or legitimate interests in the disputed domain name, once the Complainant establishes a *prima facie* case that the Respondents have no rights or legitimate interests in the disputed domain name, the burden of production of evidence on this factor shifts to the Respondents to rebut the showing, despite the overall burden of proof remaining upon the Complainant to prove each of the three elements of paragraph 4(a) of the Policy (*Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); and *Universal City Studios, Inc. v. David Burns and Adam-12 Dot Co*, *supra*).

Despite the Respondents’ email communications, the Respondents have not produced any evidence to rebut such *prima facie* case as may have been established by the Complainant, and the enquiry must therefore focus upon what is evidenced by the Complainant in order to determine whether or not it has been so established.

The Complainant contends that it is the sole proprietor of the trademark SUPA QUICK and that the Respondents have not been given any permission to register or use any domain name incorporating the trademark of the Complainant.

Apart from there being no authorization on the part of the Complainant, there is no existing relationship or association between the Complainant and the Respondents, whether by license or otherwise, which also militates against the Respondents having rights or legitimate interests in or other entitlement which might fall within that purview (*Sybase, Inc. v. Analytical Systems, supra*).

The Complainant, having made out a *prima facie* case, the burden of production of evidence has shifted to the Respondent which has not come forward with any counter ancillary evidence (*Julian Barnes v. Old Barn Studios Limited*, WIPO Case No. [D2001-0121](#); and *The American Automobile Association, Inc. v. aaaaautoinsurance.com Privacy--Protect.org, aaa-netaccess.com Privacy--Protect.org, aaanetacceess.com Privacy--Protect.org, Isaac Goldstein*, WIPO Case No. [D2011-2069](#)).

Moreover, there is no evidence that the Respondents are commonly known by that disputed domain name or otherwise have rights in the disputed domain name (*Abbott Laboratories v. Li Jian Fu, Li Jian Fu*, WIPO Case No. [D2016-0501](#)). While the Respondents claimed to have used the disputed domain name for “Supaquick Kloof”, and in connection with an email address, little is known about the extent and nature of such use. The Respondents in a later communication stated “that any use of the domain name was done so in without the knowledge or permission of Bridgestone South Africa as the holder of the SupaQuick trade marks”.

In view of the facts and circumstances put up on this ground, and which are unchallenged by the Respondents, the Panel is of the view that the Complainant should therefore succeed on this ground as well.

The Panel is therefore satisfied that, in the circumstances, the Complainant has established the second element of the Policy.

#### **D. Registration and Use in Bad Faith**

Paragraph 4(b) of the Policy provides that for the purposes of paragraph 4(a)(iii) of the Policy, 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 the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, 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 the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

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

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation or endorsement of your website or location or of a product or service on your website or location.”

The selection of a disputed domain name that is identical to the Complainant’s prior registered trademark, particularly in the absence of any explanation, leads to the conclusion, in the view of the Panel, that the Respondents must have known of the reputation of the Complainant in the market and therefore selected the disputed domain name in circumstances where they were aware of the Complainant’s reputation and intended to benefit therefrom (*Deutsche Post AG v. MailMij LLC*, WIPO Case No. [D2003-0128](#); and *Barclays Bank PLC v. Miami Investment Brokers Inc, supra*). The fact that the Respondents are not presently using the disputed domain name does not detract from a finding of bad faith noting that the disputed domain name is identical to the Complainant’s trademark.

Finally, the Complainant does not make the case that the Respondents are actively using the disputed domain name. Accordingly, the issue does not relate to use as the Complainant alleges that the disputed domain name currently diverts to a parked page.

As found by previous UDRP panels, such as *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and section 3.3 of the [WIPO Overview 3.0](#), it has been concluded that the non-use of a domain name does not prevent a finding of bad faith use.

It is the Panel's view that, especially as the disputed domain name fully incorporates that of the Complainant's trademark and the Respondents have not denied offering, during a telephone call with the Complainant, volunteering to transfer ownership in the disputed domain name to the Complainant, which they have failed to do. Furthermore, the Panel notes that the Respondent stated that "any use of the domain name was done so in without the knowledge or permission of Bridgestone South Africa as the holder of the SupaQuick trade marks".

The Panel is therefore satisfied that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

## **7. Decision**

For the foregoing reasons, in accordance with paragraph 4(a) of the Policy and paragraph 15 of the Rules, the Panel orders that the disputed domain name, <supaquick.net>, be transferred to the Complainant.

*/Archibald Findlay/*

**Archibald Findlay**

Sole Panelist

Date: May 31, 2023