

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG v. DB LHS, DB LHS
Case No. D2023-2782

1. The Parties

The Complainant is Bayerische Motoren Werke AG, Germany, represented by Kelly IP, LLP, United States of America (the “US”).

The Respondent is DB LHS, US.

2. The Domain Name and Registrar

The disputed domain name <bmwalpina.com> (the “Disputed Domain Name”) is registered with Domain.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 29, 2023. On June 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 30, 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 (Redacted for privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 13, 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 July 14, 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 July 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 10, 2023.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on August 21, 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 worldwide known manufacturer of automobiles and motorcycles. The Complainant manufactures, markets and sells many millions of vehicles and has more than 149 000 employees worldwide.

The Complainant owns numerous registrations for BMW and variations thereof covering more than 140 countries around the world, including Germany and the US. The Complainant also acquired, in March 2022, the rights to the ALPINA trademarks from Alpina Burkard Bovensiepen GmbH & Co. KG, a Germany company founded in 1965.

Consequently, the Complainant is the owner of numerous trademarks on the terms “BMW” and “ALPINA” (the “BMW Trademarks” and the “ALPINA Trademarks”), including:

- the Germany word trademark No. 410579, BMW, registered on November 15, 1929, and duly renewed for products and services in classes 12 and 7;

- the Germany combined trademark No. 221388  , registered on December 10, 1917, and duly renewed for products and services in classes 7, 8, 9, 11 and 12;

- the Germany combined trademark No. 935368,  , registered on September 12, 1975, and duly renewed for products and services in classes 7, 9 and 12;

- the Germany combined trademark No. 1019887  , registered on July 7, 1981, and duly renewed for products and services in classes 9, 12 and 20;

- the US word trademark No. 611710, BMW, registered on September 6, 1955 and duly renewed for products and services in class 19;

- the US combined trademark No. 613465, BMW registered on October 4, 1955 and duly renewed for products and services in class 19;

- the US word trademark No. 1164922, BMW, registered on August 11, 1981 and duly renewed for products and services in classes 37 and 42;

- the US combined trademark No. 1261465, ALPINA, registered on December 20, 1983 and duly renewed for products and services in classes 7, 9 and 12;

- the US word trademark No. 2909087, ALPINA, registered on December 7, 2004 and duly renewed for products and services in class 12.

The Complainant has also registered numerous domain names comprised of the BMW Trademark alone and combined with relevant geographic, descriptive or product terms, including <bmw.com>, <bmwgroup.com> and <bmwusa.com>.

The Disputed Domain Name was registered on March 23, 2005 and, at the time of the Complaint, it revolved to a pay-per-click (“PPC”) parking page:

- containing hyperlinks that display advertising for, and redirect visitors to, various third-party websites and services, some of which compete with or relate to the Complainant; and

- offering the Disputed Domain Name for purchase for USD 3,900.

5. Parties' Contentions

A. Complainant

First, the Complainant states that the Disputed Domain Name is confusingly similar to its BMW and ALPINA Trademarks, because it consists solely of the Complainant's identical BMW and ALPINA Trademarks in combination with the generic Top-Level Domain ("gTLD") ".com."

Then, the Complainant states that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant notes that the Whois record of the Disputed Domain Name is evidence that the Respondent is not commonly known as the Disputed Domain Name or any derivations thereof. In addition, the Complainant explains that it has not authorized the Respondent, or any associates person or entity, to use or register the BMW and ALPINA Trademarks in any manner, nor is the Respondent or any other associated person or entity a current or former licensee of the Complainant and its BMW and ALPINA Trademarks. Moreover, the Complainant points out that the Respondent's use of the Disputed Domain Name does not constitute a *bona fide* offering of goods or services, nor does it constitute a non-commercial use or fair use of the Disputed Domain Name since:

- the Respondent uses the Disputed Domain Name to host PPC hyperlinks that display advertising for, and redirect visitors to, various third-party websites and services, some of which compete with or relate to the Complainant;
- the Respondent intends to sell the Disputed Domain Name for valuable consideration in excess of the out-of-pocket costs associated with registering the Disputed Domain Name.

Lastly, the Complainant states that to the extent that the Respondent does not reply in this case, the Panel may presume that the Respondent lacks rights and legitimate interests in the Disputed Domain Name.

Finally, the Complainant states that the Disputed Domain Name was registered and is being used in bad faith. The Complainant explains that the Respondent's use of the confusingly similar Disputed Domain Name to operate a website in a manner to pass off as the Complainant, or as affiliated with the Complainant, and to host PPC hyperlinks, some of which compete with or relate to the Complainant, is likely to cause confusion in the marketplace and amounts to infringement of the Complainant's intellectual property, disrupts the Complainant's businesses, and indicates the Respondent's bad faith registration and use of the Disputed Domain Name. The Complainant also adds that the Respondent offering the Disputed Domain Name for sale is evidence of bad faith in registration and use of the Disputed Domain Name. Finally, the Complainant underlines that the Respondent undoubtedly had knowledge of the Complainant and its trademarks prior to registering and using the Disputed Domain Name, considering the continuous use by the Complainant of the well-known BMW Trademark around the world since at least as early as 1917 and the use of the well-known ALPINA Trademark since 1960s, which is another element demonstrating that the Respondent has registered and is using the Disputed Domain Name in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the 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;
- (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

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the BMW and ALPINA Trademarks.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially 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.

This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the Disputed Domain Name is composed of:

- the BMW Trademark;
- the ALPINA Trademark; and
- the gTLD ".com".

According to prior UDRP panel decisions, it is sufficient that the domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing.

The Panel notes that the Disputed Domain Name is composed of two of the Complainant's registered trademarks and the Complainant's trademarks are clearly recognizable in the Disputed Domain Name. This aspect will be taken into consideration under the third element.

Furthermore, the Panel adds that the gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

Finally, the Panel holds that the Disputed Domain Name is identical to the BMW and ALPINA Trademarks, and that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name.

These circumstances are:

- (i) before any notice of the dispute, the respondent's use 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 respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; 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 or service mark at issue.

According to prior UDRP panel decisions, it is sufficient that a complainant shows *prima facie* that a respondent lacks rights or legitimate interests in a domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in a UDRP proceedings is on the complainant, UDRP 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 *prima facie* that a 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 (see section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

Indeed, it appears that the Complainant has not given any license or authorization of any kind to the Respondent to use the BMW and ALPINA Trademarks. Moreover, the Panel finds that there is no evidence that the Respondent is commonly known by the Disputed Domain Name or that the Respondent has the intent to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, the Respondent uses the Disputed Domain Name to host PPC hyperlinks to various third-party websites some of which compete with or relate to the Complainant and is intending to sell the Disputed Domain Name for valuable consideration in excess of the out-of-pocket costs associated with registering the Disputed Domain Name.

Finally, the Respondent did not reply to the Complainant’s contentions, and consequently, did not rebut the Complainant’s *prima facie* case.

Therefore, according to the Policy, paragraphs 4(a)(ii) and 4(c), the Panel considers that the Complainant has established that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the Disputed Domain Name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent’s 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 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 the respondent’s documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent's website or location or of a product or service on the respondent's website or location.

First, according to prior UDRP panel decisions, the mere registration of a domain name that is identical or confusingly similar to a widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)). Indeed, the Panel considers that it is established that the BMW and ALPINA Trademarks were registered and used well before the registration of the Disputed Domain Name and that these Trademarks are well known around the world. Therefore, there is a presumption of bad faith registration of the Disputed Domain Name given that it wholly reproduces both BMW and ALPINA Trademarks. The Panel also considers that the combination of two trademarks of the Complainant reinforces the likelihood of confusion between the Disputed Domain Name and the Complainant's trademarks.

Moreover, the Panel points out that the Respondent is offering the Disputed Domain Name to sell for valuable consideration in excess of the out-of-pocket costs associated with registering the Disputed Domain Name.

Additionally, the Disputed Domain Name revolves to a parking page with sponsored PPC links to various third-party websites some of which compete with or relate to the Complainant.

Finally, the Respondent has not provided any response to the Complainant's contentions.

Considering all of the above, it is not possible to conceive any plausible actual or contemplated good faith registration and use of the Disputed Domain Name by the Respondent.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the Disputed Domain Name in bad faith according to the Policy, paragraphs 4(a)(iii) and 4(b).

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, <bmwalpina.com> be transferred to the Complainant.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: September 4, 2023