

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG v. David Gibson / Pos Ability USA Inc.
Case No. D2023-3940

1. The Parties

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

The Respondent is David Gibson / Pos Ability USA Inc., US.

2. The Domain Names and Registrar

The disputed domain names <bmw-all-parts.com> and <bmwallparts.com> are registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 21, 2023. On September 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 21, 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 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 September 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 20, 2023. The Respondent sent email communications to the Center on October 20, 23, 25, November 2, 13, 16, 24, 25, 2023. The Complainant filed supplemental filings on November 24, and December 5, 2023.

On request of the Complainant, the Center suspended on October 26, 2023, the administrative proceeding until November 25, 2023, for purposes of settlement discussions concerning the disputed domain names. The Center reinstated the proceeding on request of the Complainant on November 29, 2023.

The Center appointed Peter Burgstaller as the sole panelist in this matter on December 7, 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 major manufacturer of automobiles and motorcycles in the world. It owns numerous trademarks, service marks and trade names for BMW for decades and in several jurisdictions, *inter alia*:

- German trademark registration for BMW (word), Registration No 410579, registered November 15, 1929;
- US trademark registration for BMW (word), Registration No 611710, registered September 6, 1955;
- US service mark registration for BMW (word), Registration No 1164922, registered August 11, 1981 (Annex 6 to the Complaint).

Further, the Complainant owns various domain names containing the mark BMW, e.g., <bmw.com>, <bmwgroup.com>, <bmwusa.com> or <bmw.de>.

The Complainant maintains an authorized BMW dealer network around the world; the dealers are allowed to use the well-known BMW logo of the Complainant.

The disputed domain names were registered on May 13, 2011 <bmwallparts.com> and July 28, 2015 <bmw-all-parts.com> (Annex 1 to the Complaint).

The disputed domain name <bmw-all-parts.com> resolved to the Respondent's website which contained the famous Complainant's BMW-Logo as well as offered repair parts and maintenance services for BMW vehicles as well as third-party competing car brands (e.g., Mercedes or Volvo).

The disputed domain name <bmwallparts.com> redirected to the website located at <bmw-all-parts.com> (Annex 7 and 8 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that the BMW trademark is well-known and notes that the disputed domain names entirely incorporate such trademark. The Complainant submits that the Respondent was aware of the Complainant's trademark when registering the disputed domain names and the disputed domain names resolved to a website purporting to provide identical, competing, similar, or related automobile repair and maintenance services and genuine parts for the Complainant's BMW brand automobiles, as well as for third-party competing brands, such as MERCEDES and VOLVO. In doing so, the Respondent used the disputed domain names to prominently display and reproduce - without authorization - the Complainant's various intellectual property, including the Complainant's BMW marks.

There is no legal relationship whatsoever between the Complainant and the Respondent.

B. Respondent

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

6. Discussion and Findings

The Respondent failed to send a Response within the deadline; however, it sent email correspondences on October 20, 23, 25, 2023 and November 2, 13, 16, 24, 25, 2023 to the Center, containing that it never sought to sell the disputed domain names and they do not restrict the business of the Complainant or its official dealers, but they only describe what the Respondent's business is: To dismantle used BMW vehicles and offer "all the parts" from it.

The Respondent did not submit any evidence supporting its allegations, but rather generally disputed the Complainant's allegations.

This Panel do not admit the Respondent's submission of the said email correspondences which were sent to the Center after the Respondent was notified by the Center that it has failed to comply with the deadline to submit a Response. The Panel notes that in any event the contents of the Respondent's submissions do not alter the outcome of this decision.

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 trademark and the disputed domain name. WIPO [Overview](#) of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the Complainant's mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "-all-parts" and "allparts") may bear on assessment of the second and third elements; however, the Panel finds the addition of such terms do not prevent a finding of confusing similarity between the disputed domain names and the distinctive mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which a 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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Complainant focuses on the fact that its trademarks are distinctive and well-known and provides suitable evidence of its reputation, adding that it is inconceivable that the Respondent would not have been aware of this when registering the disputed domain names. The Complainant also notes that the disputed domain names are not being used for a bona fide offering of goods or services, because the Respondent not only offers repair, maintenance service and genuine parts for the Complainant's BMW vehicles but as well as for third-party competing brands such as MERCEDES or VOLVO, along with the well-known BMW logo of the Complainant.

In this regard, the Panel refers notably to [WIPO Overview 3.0](#), section 2.8, stating as follows: "Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark."

Here the Panel notes that the Respondent's use of the disputed domain names clearly fails to meet the second above-mentioned criteria. The Panel finds that the use of the disputed domain names may be considered to involve the so-called "bait and switch" practice, and therefore the use of the disputed domain names cannot be considered fair use.

Noting the above, and that the Respondent has not brought forth evidence of any rights or legitimate interests which it might have in the disputed domain names, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Complainant provided evidence which demonstrates that it has rights and is the owner of the distinctive registered trademark BMW, registered and used in many jurisdictions around the world since decades and long before the disputed domains were registered.

Further, the Complainant registered and is using various domain names containing BMW e.g., <bmw.com>, <bmwgroup.com> or <bmwusa.com> among others, for many years; the Complainant has a strong Internet presence.

It is inconceivable for this Panel that the Respondent registered and used the disputed domain names without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith. [WIPO Overview 3.0](#), section 3.2.2. This finding is supported by the fact that the disputed domain name incorporates the Complainant's distinctive trademark BMW entirely.

The disputed domain names were used in bad faith: In the present case, the Panel notes that the Respondent provided a website, addressed by the disputed domain names, which contained the Complainant's BMW-Logo as well as offered repair parts and maintenance services for BMW vehicles as well as third-party competing car brands (e.g. Mercedes or Volvo).

By doing this, the Respondent disrupted the Complainant's business and intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark which constitutes bad faith use.

Further,

- the Complainant's trademark BMW is famous with a high distinctiveness and is well-known globally;
- the Respondent has failed to present any evidence of any good faith use with regard to the disputed domain names;
- the disputed domain names incorporate the Complainant's trademark in its entirety, and are thus suited to divert or mislead potential web users from the website they are actually trying to visit (the Complainant's site or the site of official dealers);
- the suffixes "-all-parts" and "allparts" to the BMW mark in the disputed domain names refer to a relevant business of the Complainant and even strengthen the impression that the Respondent must be in some way related with the Complainant which is not the case; and
- the Respondent provided a website under the disputed domain names where it used the distinctive and famous BMW logo which strengthen the likelihood of confusion with the Complainant's distinctive trademarks as to the source, sponsorship, affiliation or endorsement of its website.

Based on the available record, the Panel finds that the Complainant has established 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 names <bmw-all-parts.com> and <bmwallparts.com> be transferred to the Complainant.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: December 21, 2023