

## **ADMINISTRATIVE PANEL DECISION**

**Bayerische Motoren Werke AG v. Li Jiang**

**Case No. D2023-4526**

### **1. The Parties**

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

The Respondent is Li Jiang, China.

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

The disputed domain name <aosbmwgroup.com> is registered with Cosmotown, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 31, 2023. On October 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 1, 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 (Privacy Protected) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 2, 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 November 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 November 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 8, 2023.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on December 18, 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 motor vehicle manufacturer based in Munich, Germany. It manufactured, marketed, and sold, in each year from 2018 through 2022, more than 2,000,000 automobiles and more than 162,000 motorcycles under the BMW registered trademarks.

The Complainant owns many registrations for the mark “BMW”, including International mark No 410579 International Classes 12 and 7 for various goods, including vehicles and motorcycles, filed on February 23, 1929 and Registered on November 15, 1929; and US mark No 0611710 for Class 12: automobiles, motorcycles, filed on March 10, 1954 and registered on September 6, 1955.

The Complainant owns and operates country-specific and region-specific domain names and websites at, for example, <bmwusa.com>, <bmw.ca>, and <bmw.de>. The Complainant utilizes the domain name “www.aos.bmwgroup.com” for its “Aftersales Online System,” which provides original service information, parts information, and BMW CarData for its BMW brand automobiles. The Complainant also authorizes its dealers to use trade names and domain names comprised in part of the BMW registered marks, subject to the terms of various agreements, for their authorized BMW businesses.

The disputed domain name was first registered on May 25, 2020, and updated on November 1, 2023. It resolves to a website where hyperlinks to third party providers are displayed.

#### 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 name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its registered “BMW” trademark. That trademark has been in use since 1917 and the Complainant says it enjoys unquestionable fame as a result of its extensive and long use and advertising. The Complainant says that the BMW mark represents one of the most recognized brands in the world. The Complainant points out that it has an extensive online network, that includes the website at “aos.bmwgroup.com” which operates its “Aftersales Online System,” providing original service information, parts information, and BMW CarData for its BMW brand automobiles. The Complainant contends that the disputed domain name is confusingly similar to its registered BMW marks as it prominently features the mark BMW and merely adds the component “AOS”, which stands for “Aftersales Online System” in this context and relates to the Complainant’s business. The resulting domain name is, according to the Complainant, an intentional typo-squatted version of BMW’s AOS domain name (i.e., <aos.bmwgroup.com> vs. <aosbmwgroup.com>). The minor alteration is entirely inadequate to distinguish the disputed domain name from the BMW marks, the Complainant says, and in any case, Panels have consistently held that a domain name containing a complainant’s mark in its entirety is confusingly similar to the mark at issue. Addition of generic elements is not sufficient to obviate the risk of confusing similarity.

The Complainant points out that if it can make a *prima facie* showing that the Respondent has no rights or legitimate interests in a disputed domain name, the burden of proof on the second element shifts to the Respondent. The Complainant says that the relevant WHOIS and registration information, and the lack of information and evidence in the record to the contrary, establishes that the Respondent is not commonly known as the disputed domain name or any derivation of it. The Complainant has not authorized the use of its BMW marks in any way by the Respondent.

The disputed domain name resolves to a website that offers third party links, which does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use such that respondents can claim any legitimate rights or interests. The Complainant also contends that the disputed domain name constitutes typosquatting on its own website and domain name.

The Complainant maintains that the Respondent's use of the confusingly similar disputed domain name constitutes an attempt to pass itself off as the Complainant, or as affiliated with the Complainant, and is likely to cause confusion in the marketplace, amounting to infringement of the Complainant's intellectual property, disrupting its business, and indicating the Respondent's bad faith registration and use of the disputed domain name under Policy 4(b)(iii), (iv). The Respondent has also engaged in typosquatting, which has been consistently found to constitute an independent ground of bad faith under prior UDRP decisions.

The Complainant says that the Respondent also has a bad-faith pattern of registering domain names featuring various third-party trademarks under UDRP 4(b)(ii), as evidenced by various other UDRP decisions listing "Li Jiang" as the respondent and transferring the disputed domains to the respective mark owners. Finally, the Complainant points to the legal presumption of bad faith where a Respondent should have been aware of a Complainant's trademark rights, actually or constructively. The Complainant says that it is inconceivable that the Respondent did not have actual knowledge of the Complainant and its rights in the BMW trademarks before registering and using the disputed domain name, especially since the disputed domain name features the identical and highly distinctive BMW mark which was registered by Respondent more than 100 years after the Complainant's first use of the same. The Complainant contends that the Respondent had actual knowledge of the Complainant because the disputed domain name is an intentional typo-squatted version of BMW's own AOS domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **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.

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 BMW registered mark is visibly reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the Complainant's registered BMW mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 the Respondent may demonstrate rights or legitimate interests in a disputed domain name. Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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).

As per the available record set out above, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant

evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. The Respondent is not commonly known by the disputed domain name or any derivation of it, and the Complainant has not authorized the use of its distinctive BMW trademark in the disputed domain name or in any other manner. The disputed domain name resolves to a website where hyperlinks to third party providers are supplied, an activity that does not result in the recognition of rights or legitimate interests, since it relies on deception to attract consumers to the website.

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 Panel notes that the Respondent has engaged in a pattern of bad faith conduct and has attempted intentionally to attract, for commercial gain, Internet users by creating a likelihood of confusion with the complainant's mark. The Respondent registered the disputed domain name that includes the highly distinctive and globally reputed BMW trademark at a time when that mark had been in widespread use for many decades. The Composition of the disputed domain name further indicates that the Respondent was well aware of the BMW registered marks and the rights of the Complainant therein. The disputed domain name resolves to a website where hyperlinks to third party providers are made available, indicating that the Respondent seeks to derive commercial gain from the deceptive inclusion of the BMW mark in the disputed domain name. Further, there is evidence on the public record that the Respondent has been found to have engaged in similar conduct by past panels. The disputed domain name also closely matches a domain name used by the Complainant to operate some of its services online, further adding to the potential confusion and deception of Internet users. Finally, the Respondent used a privacy service to disguise its identity.

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 name <aosbmwgroup.com> be transferred to the Complainant.

*/William van Caenegem/*

**William van Caenegem**

Sole Panelist

Date: January 1, 2024