

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG v. Xu Hai Min

Case No. D2023-4567

1. The Parties

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

The Respondent is Xu Hai Min, Singapore.

2. The Domain Name and Registrar

The disputed domain name <sgatebmwgroup.com> is registered with Dynadot Inc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 2, 2023. On November 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 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 (Privacy Protected) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 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 November 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 November 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 14, 2023.

The Center appointed Daniel Peña as the sole panelist in this matter on December 27, 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, headquartered in Germany, is one of the world's leading manufacturers of automobiles and motorcycles.

The Complainant is the proprietor of trademark registrations for its BMW mark, including the following:

- German Trademark Registration No. 410579 for BMW (word mark), registered on November 15, 1929, for goods in classes 7 and 12;
- German Trademark Registration No. 221388 for BMW (word & design mark), registered on December 10, 1917, for goods in classes 7,5,9,11, and 12;
- German Trademark Registration No. 302016105664 for BMW GROUP (word), registered on January 11, 2017, for goods and services in classes 12, 2, 3, 4, 7, 9, 11, 14, 18, 21, 25, 27, 28, 35, 36, 37, 38, 39, 40, 41, 42, and 43;
- US Trademark Registration No. 611710 for BMW (word mark), registered on September 6, 1955, for goods and services in class 12;
- US Trademark Registration No. 613465 for BMW (word & design mark), registered on October 4, 1955, for goods in class 12.
- US Trademark Registration No. 3689674 for BMW GROUP (word mark), registered on September 29, 2009, for goods in classes 3 and 4.
- US Trademark Registration No. 5735995 for BMW GROUP (word mark), registered on April 30, 2019, for goods and services in classes 7, 12, 35, 36, 38, and 41.

The disputed domain name was registered on August 20, 2023. The disputed domain name resolves to a website hosting pay-per-click ("PPC") links.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is confusingly similar to the Complainant's famous and registered mark BMW because it contains Complainant's mark in its entirety combined with the generic and/or descriptive terms "sgate" and "group".

The Complainant also argues that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent's registration and use of the disputed domain name to resolve to a webpage hosting hyperlinks that display advertising for, and redirect visitors to, third-party websites and services, does not constitute a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use. The Respondent's passing off activities are further evidence of the Respondent's lack of any legitimate interest in the Disputed Domain Name. Moreover, given the fame of the Complainant's BMW mark, the Respondent could not be known by the disputed domain name.

The Complainant argues that the Respondent has registered and is using the disputed domain name in bad faith. The Complainant notes that it uses the domain name <sgate.bmwgroup.com> in connection with its “S-Gate” platform for its authorized dealers and their employees, thus the disputed domain name is a typosquatting variation of the Complainant’s domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel’s decision be made “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”. It has been a consensus view in previous UDRP decisions that a Respondent’s default (i.e., failure to submit a response) would not by itself mean that the Complainant is deemed to have prevailed; a Respondent’s default is not necessarily an admission that the Complainant’s claims are true (See section 4.3 of the WIPO page 3 Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)).

A Complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that: (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

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant has provided evidence of its rights in the trademark BMW on the basis of its multiple trademark registrations in Germany and United States of America. A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see WIPO Overview on WIPO Panel Views on Selected UDRP Questions, (“[WIPO Overview 3.0](#)”), section 1.2.1).

Mere addition of the expressions “sgate” and “group” does not prevent a finding of confusing similarity with the Complainant’s marks. As noted in [WIPO Overview 3.0](#), section 1.8: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”. Similarly, the generic Top-Level Domain (“gTLD”), in this case “.com”, 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 (see also [WIPO Overview 3.0](#), section 1.11.1).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights, meaning that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

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.

Having reviewed the available record, 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. Rather, the disputed domain name has been used to resolve to a website with PPC links whereby the Respondent presumably earns "click-through" revenue, which does not represent a *bona fide* offering nor confer rights or legitimate interests upon the Respondent. Moreover, given the Complainant's use of the domain name <sgate.bmwgroup.com>, the disputed domain name directly infers an association with the Complainant, contrary to the fact, which cannot constitute fair use.

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

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a disputed domain name in bad faith: (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of the complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; (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; (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 its website or location.

The Panel finds that the Respondent knew of the Complainant and its trademarks when it registered the disputed domain name. The Panel makes this finding in recognition that the Respondent has registered the disputed domain name that contains the Complainant's famous trademarks BMW and BMW GROUP, with the addition of expression "sgate" that relates to the domain name <sgate.bmwgroup.com>, where the Complainant hosts its platform of services offered by the Complainant to its clients and from which the disputed domain name only differs by the omitted punctuation between the "sgate" and "bmwgroup" elements.

In the Panel's view, the Complainant's mark is widely known and registration by the unrelated the Respondent creates a presumption of bad faith in this case. On this subject, section 3.1.4 of the [WIPO Overview 3.0](#) says: "Panels have consistently found that the mere registration of a domain name that is identical or page 5 confusingly similar [...] to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." The Panel finds that the Respondent, through this scheme, has intentionally attempted to attract for commercial gain Internet users by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, and endorsement of the Respondent's scheme. The disputed domain name resolves to a webpage hosting hyperlinks that display advertising for, and redirect visitors to, third-party websites and services. The Panel finds that the Respondent has attempted to mislead the Internet users for clicks and to gain commercial revenue.

This clearly constitutes evidence of bad faith registration and use. Accordingly, the Panel finds, based on the evidence presented, that the Respondent registered and is using the disputed domain name in bad faith. Therefore, 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 <sgatebmwgroup.com> be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: January 10, 2024