

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG (“BMW”) v. Samvel Baghdasaryan,
BMW Trend
Case No. D2024-1978

1. The Parties

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

The Respondent is Samvel Baghdasaryan, BMW Trend, Armenia.

2. The Domain Name and Registrar

The disputed domain name <bmwtrend.store> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 12, 2024. On May 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 13, 2024, 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 May 14, 2024 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Respondent sent email communications to the Center on May 14, 2024. The Complainant filed an amended Complaint on May 20, 2024.

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 May 24, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 13, 2024. The Respondent did not file any formal response. Accordingly, the Center notified the commencement of the panel appointment process on June 14, 2024.

The Center appointed Gonçalo M. C. Da Cunha Ferreira as the sole panelist in this matter on June 21, 2024. 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 Bayerische Motoren Werke AG, a leading manufacturer of automobiles and motorcycles, founded in 1916, with headquarters in Germany and numerous additional locations in countries around the world. The Complainant's products and components are manufactured at 32 sites in countries around the world and the Complainant has more than 150,000 employees worldwide.

From 2018 through 2022, the Complainant sold more than 2,000,000 automobiles and more than 165,000 motorcycles under the BMW trademarks.

The Complainant has started owning registered trademarks since 1917, including, but not limited to:

- Germany trademark registration No. 221388 for the mark BMW and design, registered on December 10, 1917;
- Germany trademark registration No. 410579 for the mark BMW in block letters, registered on November 15, 1929;
- United States trademark registration No. 611710 for the mark BMW in block letters, registered on September 6, 1955;

and owns numerous registrations for the BMW mark and variations thereof covering more than 140 countries around the world.

The BMW trademarks have been recognized repeatedly as one of the top 100 brands in the world, including being ranked in the Top 10 of the Interbrand's "Best Global Brands 2023" List.

The Complainant also owns various domain names composed with the BMW trademarks such as <bmw.com> or <bmwgroup.com>.

The disputed domain name was registered on November 9, 2019 and resolve to a website prominently displaying "BMW Trend Store" that advertises, offers, and purports to sell products under the BMW mark. On the "About us & Contacts" page, it states: "We're a BMW fan community (started in 2017), we have more than 3 million followers combined in Fb & Instagram, and now we're selling the best products for BMW fans, our goal is to connect bimmerheads worldwide with our products, that's why we have the cheapest prices and worldwide free shipping! Also we have frequent sales, so don't miss out!"

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:

1. the disputed domain name is confusingly similar to the Complainant's famous and registered BMW mark.
2. the disputed domain name prominently starts with and features the Complainant's identical and famous BMW mark in its entirety and merely adds the descriptive term "trend" and the generic Top-Level domain ("gTLD") extension ".store".

3. these minor additions are entirely inadequate to distinguish the disputed domain name from the Complainant's BMW mark.
4. the Respondent has no rights or legitimate interests in the disputed domain name because the Respondent is not commonly known by the disputed domain name; and the Respondent's use of the disputed domain name does not constitute a bona fide offering of goods/services, nor does it constitute a noncommercial use or fair use of the disputed domain name.
5. the Complainant has not authorized the Respondent, or any associated person or entity, to use or register the BMW mark or M Logo marks in any manner, including in the disputed domain name, on the website, or in the registration information, nor is the Respondent, or any other associated person or entity a current or former licensee of the Complainant and its trademarks.
6. the disputed domain name resolves to a website that advertises, offers, and purports to sell counterfeit or otherwise unauthorized products under the BMW mark and M Logo marks.
7. the Respondent "intentionally attempted to attract, for commercial gain, Internet users" to the website located at the disputed domain name "by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of" the disputed domain name, the website, and/or the Respondent's activities.
8. the evidence and totality of circumstances surrounding the disputed domain name undoubtedly establish that the Respondent had actual knowledge of the Complainant and its BMW mark prior to registering and using the disputed domain name.
9. the Respondent registered and is using the disputed domain name in bad faith.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. However, the Respondent made three email communications on May 14, 2024, stating that "[H]ello, I just received a dispute and I need assistance and to know my rights," "bmtrend.store is the domain name," and "[H]ello, I just received an email from you and I honestly don't understand what's this all about, can you please help me to understand what's the problem?"

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is 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, "trend" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

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.

According to the information on the “About us & Contacts” of the website at the disputed domain name, it is “a BMW fan community”, and it is “selling the best products for BMW fans”. For purposes of assessing fair use under UDRP paragraph 4(c)(iii), a respondent’s fan site must be active, genuinely noncommercial, and clearly distinct from any official complainant site. [WIPO Overview 3.0](#), section 2.7.1. The website at the disputed domain name may be addressed to the BMW fan community as the target audience of products bearing the Complainant’s trademark (despite those products on the website not being the Complainant’s products, or of dubious origin), but that does not make this website a “fan site” but a website where the Respondent is seeking to take an unfair advantage of the BMW trademark for commercial gain. Therefore, the Respondent’s use of the website selling products for commercial gain does not constitute fair use for the purpose of the Policy.

Furthermore, the Panel considers that the composition of the disputed domain name and the use of the website create a risk of Internet user confusion.

The Respondent has not rebutted the Complainant’s prima facie showing and has not presented any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

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 intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s trademarks as to the source, sponsorship, affiliation or endorsement of such site or the products or services advertised on such site, within the meaning of paragraph 4(b)(iv) of the Policy.

Having reviewed the record, the Panel finds the Respondent’s registration and use of the disputed domain name constitutes bad faith under the Policy.

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 <bmwtrend.store> be transferred to the Complainant.

/Gonçalo M. C. Da Cunha Ferreira/

Gonçalo M. C. Da Cunha Ferreira

Sole Panelist

Date: July 5, 2024