

ADMINISTRATIVE PANEL DECISION

S & S Cycle, Inc. v. Guiying Li
Case No. D2024-2069

1. The Parties

The Complainant is S & S Cycle, Inc., United States of America, represented by Husch Blackwell LLP, United States of America.

The Respondent is Guiying Li, China.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 16, 2024. On May 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 20, 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 (Non-Public Data) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 24, 2024, 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 amendment to the Complaint on May 28, 2024.

The Center verified that the Complaint together with the amendment to 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 May 31, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 20, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 9, 2024.

The Center appointed Peter Burgstaller as the sole panelist in this matter on July 15, 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 offers premium high-performance solutions for motorcycles e.g. Harley Davidson for more than 60 years. It owns the following United States of America trademark registrations:

- S&S, Reg. No. 5,148,287, registered on February 21, 2017, in international class 4;
- SS PROVEN PERFORMANCE (fig.), Reg. No. 2,950,933, registered on May 17, 2005, in international class 7 and 12; and
- S&S, Reg. No. 1,324,371, registered on March 12, 1985, in international class 12 (Annex G to the Complaint).

The Complainant further owns the domain name <sscycle.com>, registered March 13, 1996 (Annex H to the Complaint) which resolves to its business website.

The disputed domain name was registered on August 25, 2022 (Annex A to the Complaint).

At the time of filing the Complaint the disputed domain name resolved to a website showing the Complainant's figurative trademark (Reg. No. 2,950,933 ) only with inverted black/white color-combination ( Annex B to the Complaint) and a business address which in fact did not exist (Annexes C and D to the Complaint); the Respondent's website furthermore presented products for sale, displayed in identical form to those of the Complainant's website.

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 S&S trademarks are distinctive and well-known and the disputed domain name contains the S&S trademarks in its entirety, simply adding the descriptive terms "cycle" and "sale". It further notes, that it owns the domain name <sscycle.com> and the disputed domain name also represents its trade name.

The Complainant alleges, that it has never assigned, granted, licensed, sold, transferred, or in any way authorized the Respondent to register or use the S&S trademarks or its trade name in any manner.

Further, the Complainant submits that it is inconceivable that the Respondent would not have been aware of the Complainant and its trademarks when registering the disputed domain name, because the Respondent used the Complainant's S&S logo on its website and tried to create an association with the Complainant which did not exist.

Moreover, the Complainant contends that the Respondent's website clearly evidencing that the Respondent's use of the disputed domain name is not for a legitimate purpose but rather to infringe on the Complainant's copyrights therein and pirate the Complainant's content to pass it off as its own.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests with respect to 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

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 submitted evidence, which incontestably and conclusively establishes trademark rights in the mark S&S.

In addition, it is well established under UDRP decisions that the term "trademark or service mark" as used in paragraph 4(a)(i) encompasses both registered marks and unregistered/common law marks. [WIPO Overview 3.0](#), section 1.1; *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#). However, unregistered marks have to perform the function of distinguishing the goods and services of one person in trade from the goods or services of any other person in trade.

In the present case, the continuous use of the Complainant's trade name S&S CYCLE in business especially (but not limited) in the domain name <sscycle.com> to address its business website, as well as on the Website itself and in advertising, since years, leads the Panel to the conclusion that the Complainant has also established common law rights in the marks S&S CYCLE and SS CYCLE for the purposes of the Policy.

The disputed domain name <sscyclesale.com> is confusingly similar to the SS CYCLE and S&S CYCLE common law marks in which the Complainant has rights since it only adds the descriptive term "sale" to the mark. It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name the mere addition of a term will not prevent a finding of confusing similarity under the first element of the Policy. [WIPO Overview 3.0](#), section 1.8.

This is the case at present.

Finally, it has also long been held that generic Top-Level-Domains are generally disregarded when evaluating the confusing similarity of a disputed domain name. [WIPO Overview 3.0](#), section 1.11.

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 the 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 name. The Complainant focuses on the fact that its common law mark S&S CYCLE is well-known and distinctive, adding that it is inconceivable that the Respondent would not have been aware of this when registering the disputed domain name.

Further, the Complainant expressly denies there being any relationship between itself and the Respondent.

The Complainant also notes that the disputed domain name is not being used for a bona fide offering of goods or services - it refers to a website showing unauthorized the Complainant’s S&S logo together with purported legitimate products of the Complainant far below the list prices and displaying photographs of products identical to those of the Complainant’s website.

Under the Oki Data test, a reseller, distributor, or service provider must meet all of the following requirements:

- (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.
- [WIPO Overview 3.0](#), section 2.8; *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

The evidence in the Complaint does not reveal any disclaimer that discloses the Respondent’s relationship with the Complainant, and the Respondent has not introduced any evidence to the contrary. Accordingly, the Panel concludes that the Respondent clearly does not comply with the Oki Data test.

The Respondent did not reply to the Complainant’s contentions and hence has not rebutted the Complainant’s prima facie showing.

Based on the available record, 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 in the mark S&S CYCLE and SS CYCLE and it has intensively used these marks in business since decades and long before the disputed domain name was registered.

Further, the Complainant has registered and is using the domain name <sscycle.com> for many years and has a strong online presence.

It is inconceivable for this Panel that the Respondent registered and used the disputed domain name 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 has the term "sale" as suffix, which clearly refers to the Complainant's e-commerce business.

The disputed domain name was also used in bad faith: In the present case, the Panel notes that the Respondent provided, without authorization by the Complainant, a website, addressed by the disputed domain name, which prominently displayed the Complainant's S&S logo as well as offered purported legitimate products of the Complainant far below the list prices and displaying photographs of products identical to those of the Complainant's website.

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.

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 <sscyclesale.com> be transferred to the Complainant.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: July 29, 2024