

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG v. Zaza Shonia Case No. DGE2023-0003

1. The Parties

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

The Respondent is Zaza Shonia, Georgia.

2. The Domain Name and Registry

The disputed domain name <bmw.ge> is registered with Caucasus Online LLC (the .GE Registry).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 11, 2023. On January 12, 2023, the Center transmitted by email to the .GE Registry a request for registry verification in connection with the disputed domain name. On January 16, 2023, the .GE Registry transmitted by email to the Center its verification response:

- (a) confirming that it is the Registry through which the disputed domain name is registered;
- (b) disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint; and
- (c) confirming that the disputed domain name is registered subject to the .GE Domain Name Dispute Resolution Policy.

The Center sent an email communication to the Complainant on January 19, 2023 providing the registrant and contact information disclosed by the .GE Registry, and inviting the Complainant to submit an amendment to the Complaint.

On January 19, 2023, the Center received two email communications from the person identified by .GE Registry as the administrative contact for the disputed domain name Respondent, L* Douglas-Hamilton. The email account confirmed by .GE Registry as the administrative contact’s email is also the same as the email account for the registrant. In the first of the emails, L* Douglas-Hamilton stated that “The domain belongs to me.” and in the second email that “I have legally owned this domain for a while now.”

The Complainant filed an amended Complaint on January 24, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .GE Domain Name Dispute Resolution Policy (the .GE Policy), the Rules for .GE Domain Name Dispute Resolution Policy (the .GE Rules), and the WIPO Supplemental Rules for .GE Domain Name Dispute Resolution Policy (the Supplemental Rules).

In accordance with the .GE Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 26, 2023.

On January 28, 2023, the Center received an email from a L* Khoetsyan, describing her- or himself as "Representative of bmw.ge domain owner" and using an email account "[...]@bmw.ge".

In accordance with the .GE Rules, paragraph 5, the due date for Response was February 15, 2023.

On February 15, 2023, the Center received an email communication from a B* Goletiani (which included a copy of an email Mr Goletiani had sent on January 28, 2023 to the Complainant's distributor in Georgia). Mr Goletiani used two email addresses: a "@hotmail.com" address and a "@bmw.ge" address. In his email on January 28, 2023 to the distributor, Mr Goletiani represented that he owns the disputed domain name.

The Center notified the commencement of Panel appointment process on February 16, 2023.

On February 23, 2023, the Center received an email from the email account which .GE Registry had confirmed is the email address for the registrant of the disputed domain name. This email claimed that the person whom .GE Registry had confirmed to be the registrant was dead and the disputed domain name was now held by Mr Goletiani.

Also on February 23, 2023, the Center was copied into an email from Mr Goletiani to the Complainant.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on February 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 .GE Rules, paragraph 7.

4. Factual Background

The Complainant was established in Germany in 1917.

Since then, the corporate group of which it is the parent has become one of the most successful manufacturers of automobiles and motorcycles in the world. For example, from 2017 onwards it has sold more than 2,000,000 automobiles each year; it has also sold more than 162,000 motorcycles each year. The Complainant has manufacturing sites in 31 different countries around the world, employing more than 118,000 employees. The Complainant's corporate group has more than 3,500 authorised dealers and importers around the world. In 2017, the corporate group had global revenues in excess of EUR 10 billion. While revenues fell in 2018, 2019 and 2020, in 2021 global revenues exceeded EUR 16 billion.

Amongst other things, the Complainant has registered numerous domain names and promotes its products from websites that those domain names resolve to. These domain names include <bmw.com> and country specific domain names such as <bmw.ca> and <bmw.de>.

In Georgia, the Complainant's then authorised importer and distributor, Omega Motors Limited, was authorised to register the domain name <bmw.com.ge> and used that domain name from at least April 2006 until December 31, 2022 to promote the Complainant's products by reference to its BMW trademark.

Since 2007, the Complainant's BMW "brand" has been consistently ranked in the top 100 global brands by numerous ranking bodies. For example, in each year since 2007, the Complainant has been ranked between 11 and 15 by Interbrand in its Best Global Brands ranking.

The Complainant owns many registered trademarks around the world for BMW alone or in a device. For present purposes, it is sufficient to note only:

- (a) German Registered Trademark No. 410579, BMW, which has been registered since November 15, 1929 in relation to a range of goods in International Classes 12 and 17;
- (b) United States Registered Trademark No. 611,710, BMW, which has been registered since September 6, 1955 in respect of automobiles and motorcycles; and
- (c) International Registration No. 663925, BMW, which has been registered since December 22, 1995 in respect of a very wide range of goods and services in International Classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41 and 42. Georgia was one of the countries designated in International Registration No. 663925 and on August 19, 1999, the *Gazette* noted that the refusal period under Georgian law had expired.

The disputed domain name was registered on December 26, 2007.

So far as the record in this proceeding discloses, the disputed domain name has never resolved to a website. Although in communications received by the Center there has been some usage of email accounts "[...].@bmw.ge", the emails have claimed that the disputed domain name is not being used and is dormant.

In or about June 2013, the Complainant's Georgian agent and the Respondent (or a person representing the Respondent) had at least two telephone calls about the disputed domain name. In the first, the Respondent was represented as willing to transfer the disputed domain name to the Complainant for EUR 450,000. Subsequently, the price for transfer was reduced to a BMW car worth USD 100,000.

In his email to the Complainant's Georgian distributor on January 28, 2023, Mr Goletiani congratulated the distributor on his appointment. He then claimed to be the holder of the disputed domain name; that he had purchased it a long time ago and stated "I am open to negotiations regarding the sale of the domain."

5. Discussion and Findings

Paragraph 4(a) of the .GE Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (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 in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered or is being used in bad faith.

Paragraph 15(a) of the .GE Rules directs the Panel to decide the Complaint 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 the Panel deems applicable.

The Panel notes that under paragraph 11 of the .GE Rules, the language of the proceeding is English. Although not strictly necessary, the Panel further notes that the emails received by the Center from persons purporting to be, or representing, the holder of the disputed domain name have all been in English.

B. The Respondent

During the progress of the proceeding, several different people have claimed to be, or to represent, the registrant of the disputed domain name. None of them have been, or purported to be, the person identified by .GE Registry as the registrant, Zaza Shonia.

As noted above, in January 2023 L* Douglas-Hamilton claimed to be the holder and having held it “for a while now”. L* Douglas-Hamilton used the email account that .GE Registry confirmed as the email address for both the registrant and the administrative contact.

Subsequently, emails from the same account (but a person using a different name) and emails from Mr Goletiani claimed Zaza Shonia is deceased and Mr Goletiani is now the holder of the disputed domain name. Mr Goletiani’s first email also included a claim that he purchased the disputed domain name “a very long time ago”. Without wishing to cause undue distress to persons who knew Zaza Shonia, the Panel must note that no evidence in support of the claim that Zaza Shonia is deceased has been submitted. The first three emails received by the Center, from L* Douglas-Hamilton and L* Khoetsyan did not claim that Zaza Shonia was deceased.

The emails from L* Khoetsyan and Mr Goletiani were sent from accounts “[...]@bmw.ge” and so from people having some connection with whomever controls the disputed domain name.

Paragraph 2.2 of the .GE Rules defines the Registrant as meaning “a person, under whose name the Domain Name is registered”. Formally, therefore, Zaza Shonia must be regarded as the Respondent. The Panel is not prepared to depart from this formal position at least in the absence of corroborating evidence and some explanation about how and when the registration of the disputed domain name came into first L* Douglas-Hamilton’s hands and subsequently Mr Goletiani’s.

Those matters have potential significance in a case such as the present as, if there has been a transfer, the issues under the .GE Policy fall to be determined at the date of the transfer. See e.g. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 3.9 and section 4.4.6.¹

That said, the Panel notes that each of the persons who has communicated with the Center has been on notice of the Complaint and has taken the opportunity to dispute the Complaint, at least at a summary level.

B. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of at least the three registered trademarks for BMW identified in section 4 above. When regard is paid to how long the Complainant has been using the trademark and the extent of that use, the Panel considers that the trademark qualifies as a well-known trademark.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the

¹ As the criteria under the .GE Policy are similar to the criteria under the Uniform Domain Name Dispute Resolution Policy (UDRP), the Panel considers that the principles which have been developed under the UDRP may be applied where appropriate under the .GE Policy.

geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g. [WIPO Overview 3.0](#), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the country-code Top Level Domain (“ccTLD”) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the “.ge” ccTLD, therefore, the disputed domain name consists of the Complainant’s registered trademark. Accordingly, the Panel finds that the Complainant has established that the disputed domain name is identical with the Complainant’s trademark and the requirement under the first limb of the .GE Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name decades after the Complainant began using its trademark and also long after the Complainant had registered its trademark.

It is not controversial between the parties (including those corresponding with the Center as or on behalf of the Respondent) that the Complainant has not authorised the Respondent (or any of L* Douglas-Hamilton, L* Khoetsyan and Mr Goletiani) to use the disputed domain name. Nor is the Respondent affiliated with the Complainant or its corporate group. Indeed, Mr Goletiani’s email to the new distributor explained he was open to negotiations regarding the sale of the disputed domain name.

The disputed domain name is not derived from the Respondent’s name (or the name of L* Douglas-Hamilton, L* Khoetsyan or Mr Goletiani). Nor is there any suggestion of some other name by which the Respondent (or any of the others) is commonly known from which the disputed domain name could be derived.

So far as the record in this proceeding shows, there has been no use of the disputed domain name (other than for several emails sent in connection with this proceeding). One of the emails from L* Douglas-Hamilton stated "I am completely unaware of what complaint you are referring to, as I have not made any changes in over years, as far as I remember. [sic]" L* Khoetsyan simply stated "The website is not in use at the moment, but if you would like to acquire the domain, do let us know."

These matters, taken together, are sufficient to establish a *prima facie* case under the .GE Policy that the Respondent (or, if relevant, L* Douglas-Hamilton, L* Khoetsyan and Mr Goletiani) has no rights or legitimate interests in the disputed domain name.

On behalf of the Respondent, there is a claim that "it is not forbidden to have domains with different letters, sometimes the abbreviations of the company are the same."

The Panel accepts that a three letter acronym can represent many different entities. That does not necessarily entitle anyone to register it as a domain name. Whether a person may have rights or legitimate interests in a three letter domain name will depend on a number of factors. One factor is the three letter acronym in question. Another consideration may be how and why the registrant came to choose it. A further consideration may be how (if at all) the domain name in issue is being used. There may be other considerations that arise in different cases.

In the present case, the Complainant's trademark is very well-known around the world. It is very likely that many people seeing the acronym will immediately think of the Complainant. Moreover, the Complainant's registered trademark in Georgia covers a very wide range of goods and services. Thus, it is very likely that most people seeing the disputed domain name would associate it with the Complainant. Further, given the scope of the registered trademark in Georgia, there appears to be very little scope to use the disputed domain name in or related to Georgia in a way which does not infringe the Complainant's rights. Further still, there is no evidence that the Respondent (or any of L* Douglas-Hamilton, L* Khoetsyan, and Mr Goletiani) has been known by, or associated with any entity with, a name comprised of the acronym or any name from which the acronym could be derived.

The emails that have been received by the Center claim that there are no harmful intentions towards the Complainant's brand, now or in the future. None of the emails indicates what, if anything, the registrant intended to use the disputed domain name for. Each, however, did invite the Complainant to contact the sender if it was interested in acquiring the disputed domain name or to open negotiations for its transfer.

These claims fall far short of what is required to establish demonstrable preparations to use the disputed domain name in connection with some good faith offer of goods or services or, for that matter, some legitimate non-commercial or fair use. See e.g. [WIPO Overview 3.0](#), section 2.2.

On the other hand, so far as the record in this proceeding shows, the only concrete use that has been made of the disputed domain name is to offer to transfer it for EUR 450,000 or a car valued at USD 100,000 in 2013 and then, in the course of this proceeding, to solicit offers to negotiate its transfer.

This conduct clearly shows an appreciation of the value of the disputed domain name not just because it is a three letter acronym but its significance in corresponding to the Complainant's trademark. Bearing in mind the fame of the Complainant's trademark and also the very wide range of goods and services covered by its registered trademark in Georgia, the Panel does not consider the Respondent has demonstrated any credible and legitimate intent in their adoption of the disputed domain name. Rather, it appears far more likely that the Respondent intended to capitalise on the reputation and goodwill inherent in the Complainant's trademark. None of L* Douglas-Hamilton, L* Khoetsyan or Mr Goletiani is in any better or different position if they are in fact the registrant.

In these circumstances, the Panel finds that the Respondent (or any of L* Douglas-Hamilton, L* Khoetsyan and Mr Goletiani) has failed to rebut the *prima facie* case established by the Complainant that the holder of the disputed domain name does not have rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered or Used in Bad Faith

In contrast to the UDRP, the Complainant must establish only that the disputed domain name has been either registered or subsequently used in bad faith by the Respondent under the third requirement of the Policy.

Generally speaking, a finding that a domain name has been registered or is being used in bad faith requires an inference to be drawn that the respondent in question has registered or is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

The Panel has little difficulty in finding that it is very likely that the Respondent (and, if relevant, each of L* Douglas-Hamilton, L* Khoetsyan and Mr Goletiani) was well aware of the Complainant's trademark when the disputed domain name was registered. Further, given that awareness, the Respondent (or, if relevant, L* Douglas-Hamilton, L* Khoetsyan and Mr Goletiani) must have been aware that registering and using the disputed domain name would lead to confusion with the Complainant's trademark.

In the absence of some right or legitimate interest in the disputed domain name, therefore, the Panel considers it very likely the Respondent (or, if relevant, L* Douglas-Hamilton, L* Khoetsyan and Mr Goletiani) registered the disputed domain name to take advantage of its trademark significance and, further, to prevent the Complainant registering the disputed domain name itself. Such conduct would be sufficient for a finding of registration in bad faith.

Further, so far as the record in this case discloses, the only substantive use of the disputed domain name has been to offer it for sale to the Complainant and, subsequently, to hold on to it as a bargaining chip for negotiation about its transfer. This use falls within the terms of, or is closely analogous to, the conduct prescribed by paragraph 4(b)(i) of the .GE Policy:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name.”

The concrete offers of price were made a number of years ago in 2013. The Respondent's insistence on entitlement to the disputed domain name and invitation to open negotiations for its transfer is essentially the same conduct or its continuation in circumstances where the Panel has found that the Respondent does not have any rights or legitimate interests in the disputed domain name. This applies equally to L* Douglas-Hamilton, L* Khoetsyan and Mr Goletiani if one of them is the registrant as each has invited to the Complainant to begin negotiations.

The Respondent (or, if relevant, L* Douglas-Hamilton, L* Khoetsyan and Mr Goletiani) has not claimed any prejudice from the lapse of time between the offers made in 2013 and the commencement of the proceeding. While some minimal expense was presumably incurred in renewing the registration, there is no claim nor evidence that the Respondent (or, if relevant, L* Douglas-Hamilton, L* Khoetsyan and Mr Goletiani) has incurred expense in building up some business using the disputed domain name on the basis of some inducement from the Complainant. On the contrary, the evidence before the Panel indicates there has been no substantive use of the disputed domain name.

Nor is the mere passive holding of the disputed domain name a bar to the Complainant's claim to relief. See *e.g. Telstra Corporation v Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

Accordingly, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith. For the reasons outlined above, those findings apply if L* Douglas-Hamilton, L* Khoetsyan and Mr Goletiani is the registrant.

Therefore, the Complainant has established all three requirements under the .GE Policy.

6. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the .GE Policy and 15 of the .GE Rules, the Panel orders that the disputed domain name, <bmw.ge>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: March 13, 2023