

DISPUTE RESOLUTION SERVICE**D00019045****Decision of Independent Expert**

Bayerische Motoren Werke AG

and

Balog Sebastian

1. The Parties:

Complainant: Bayerische Motoren Werke AG
Petuelring 130, Dept. AJ-35
Munich
80788
Germany

Respondent: Mr Balog Sebastian
Libertatii Nr 268
Bl 3 Ap 5
Bistrita
Bistrita-Nasaud
420006
Romania

2. The domain names:

bmwupdates.co.uk
bmwwin.co.uk

3. Procedural History:

On 23 June 2017, the dispute was received. The complaint was validated on 26 June and notification of the complaint was sent to both parties. On 13 July, a response reminder was sent to the Respondent. On 18 July, no response had been received and notification of no response was sent to both parties. On 21 July, the Expert decision payment received and on 28 July the Expert – Tim Brown - was appointed.

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the

foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant - Bayerische Motoren Werke AG ("BMW") – is a manufacturer of automobiles and motorcycles located in Munich, Germany. The Complainant has manufactured, marketed and sold many millions of vehicles under the BMW mark since it was founded 101 years ago. In each year from 2011 through 2016 the Complainant produced and sold more than 1,300,000 automobiles and more than 100,000 motorcycles under the BMW mark.

The Complainant's products and components are manufactured at 30 sites in 14 countries on four continents and it has more than 124,000 employees worldwide.

The Complainant maintains data relating to its automobiles which are tracked through each car's VIN (Vehicle Identification Number), a unique serial number used by the automotive industry. The Complainant maintains and permits access to its proprietary data regarding its vehicles in compliance with laws governing such data, including competition laws and data protection laws.

The Complainant provides access to non-public technical data, such as the car's dealer history, service history and mileage to third parties that apply for and receive authorisation from the Complainant by demonstrating that the applicant is a legitimate car repair shop and complies with the Complainant's data-usage terms and conditions.

The Complainant offers navigation software and systems for its automobiles. The Complainant provides updates and activation codes for its navigation software through its authorised dealers and via its "shopbmwusa.com" website, among other official BMW websites.

The domain name bmwupdates.co.uk was registered on 21 December 2015 and the domain name bmwvin.co.uk was registered on 30 August 2016.

The Respondent did not reply to these proceedings.

5. Parties' Contentions

5.1. Complainant – Rights

The Complainant says that it has continuously used the term "BMW" as a trademark and service mark since 1917 and owns numerous registrations for the BMW mark and variations of it in more than 140 countries around the world.

A number of representative marks have been exhibited, including Germany trade mark number 221388 for the mark BMW and design; it was filed on 05 October 1917 and registered on 10 December 1917, covering products in international classes 12, 7, 8, 9, and 11 including automobiles and related parts and accessories. Furthermore, *inter alia*, a European Union Trade Mark with registration number 000091835 has been exhibited for the mark BMW in block letters which was filed on 1 April 1996 covering products in international classes 9 and 12, including software and vehicles, respectively and numerous additional products and services in numerous additional classes.

The Complainant contends that the domain names are similar to its BMW mark because each contains the Complainant's BMW mark in its entirety. Furthermore, the Complainant says the

addition of the generic or descriptive terms "vin" and "updates", which each describe features of products offered by Complainant under its BMW mark, heightens the similarity of the domain names to the mark.

5.2. Complainant – Abusive Registration

The Complainant contends that the domain names constitute Abusive Registrations because the Respondent registered the domain names in a manner that takes unfair advantage of and is unfairly detrimental to Complainant's rights in its famous BMW mark.

The Complainant further avers says that Respondent is not and has never been authorised to use Complainant's BMW mark and that the Respondent's registration of the domain names takes unfair advantage of and is unfairly detrimental to Complainant because the Respondent's registrations interfere with its ability to control use of its BMW mark.

The Complainant says that given the fame of its BMW mark and its longstanding use of the BMW mark in its own domain names across its online network, there is no doubt that the Respondent registered the domain names to misappropriate Complainant's goodwill in its BMW mark and to attract and divert Internet users searching for the Complainant's website or a website authorised by Complainant.

The Complainant avers that the domain names also constitute Abusive Registrations because the Respondent has used the domain names in a manner that takes unfair advantage of and is unfairly detrimental to the Complainant's rights in its famous BMW mark because the Respondent's use of the domain names is likely to confuse people or businesses that the domain names are registered to, operated or authorised by, or otherwise connected with the Complainant because the Respondent has used the domain names to offer unauthorised, counterfeit BMW products.

Furthermore, the Respondent's use of the domain names to offer unauthorised, counterfeit products unfairly disrupts the Complainant's business and unfairly damages the Complainant's BMW brand.

The Complainant says that the Respondent cannot demonstrate that the domain names are not abusive registrations. The Complainant contends that the Respondent has not used the domain names in connection with a genuine offering of goods or services. The Respondent has not been commonly known by the domain names or legitimately connected with a mark which is identical or similar to the domain names. The Respondent has not made legitimate non-commercial or fair use of the domain names. Instead, the Complainant contends that the Respondent has used the domain names to advertise and offer unauthorised, counterfeit products and to unfairly compete with the Complainant and the Complainant's own offering of genuine BMW products.

5.3. Respondent

As noted above, the Respondent did not take part in these proceedings.

6. Discussions and Findings

6.1. Rights

As outlined above, the Complainant has exhibited a large number of registered trade marks for the term "BMW" in a number of jurisdictions which long pre-date the registration of the domain names. The Complainant clearly has long-standing Rights in the term BMW.

The domain names differ from these Rights by the addition of the word "VIN" (an acronym for the term Vehicle Identification Number) and the word "updates".

The term "VIN" is clearly one that is closely associated with the Complainant as a manufacturer of vehicles and the additional word does not sufficiently differentiate the domain name bmwvin.co.uk from the Complainant's mark.

The term "updates" is a common dictionary term that, again, does not distinguish the domain name bmwupdates.co.uk from the dominant element of the domain name - the Complainant's BMW mark.

I therefore find that the Complainant has Rights in respect of a mark which is similar to the domain names.

6.2. Abusive Registration

The Complainant has contended that the domain names are Abusive Registrations in terms of the Policy because the domain names have confused or are likely to confuse people or businesses into believing that the domain names are registered to or authorised by or otherwise connected to the Complainant in terms of Paragraph 5.1.2 of the Policy.

Equally, the Complainant contends that the Respondent registered the domain names primarily for the purpose of unfairly disrupting the business of the Complainant in terms of Paragraph 5.1.1.3 of the Policy.

Taking the first contention, I take the view that the domain names will confuse people or businesses given the prominent inclusion of the Complainant's BMW mark. Paragraph 3.3 of the Expert's Overview (a document published on Nominet's website which discusses common issues that arise under the DRS) notes that:

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

Given the prominence of the Complainant's BMW mark in the domain names and the lack of any qualifying words, such as "unofficial", I take the view that web users will expect, from the domain names alone, to find a web site that is operated by, or at least endorsed by or associated with, the Complainant. That they do not renders the domain names Abusive.

Turning to the Complainant's second main contention, that the domain names were registered for the purposes of unfairly disrupting the business of the Complainant, I take the view that the sale of third party products and services via domain names that are similar to the Complainant's well known BMW mark will render both domain names Abusive Registrations.

The Complainant has exhibited screenshots of the websites associated with the domain names which show that third party products and services are being sold via these websites. Furthermore, the Complainant has provided a statement from its Senior Legal Counsel noting that the Respondent has not been authorised to use the Complainant's proprietary data or to offer the Complainant's navigation software and associated codes for sale.

As noted, the Respondent has chosen not to take part in these proceedings and has therefore not come forward with any explanation or justification for registering the domain names and using them to sell third party products and services.

In these circumstances, I find that the Respondent's use of the domain names to sell unauthorised third party products and services will unfairly disrupt the Complainant's business and therefore the domain names are Abusive Registrations in terms of Paragraph 5.1.1.3 of the Policy.

Finally, the Complainant has said that the Respondent cannot demonstrate that the domain names are not Abusive Registrations. In the absence of any answer from the Respondent to these contentions, I take the view that this is further evidence of an abusive intent on the Respondent's part.

7. Decision

Having determined that the Complainant has Rights in respect of a mark that is similar to the domain names and that the domain names, in the hands of the Respondent, are Abusive Registrations, I order that the domain names are transferred to the Complainant.

Signed

Tim Brown
Dated: 31 July 2017