

## **ADMINISTRATIVE PANEL DECISION**

### **Bayerische Motoren Werke Aktiengesellschaft v. Quispel Motoren Case No. DNL2013-0026**

#### **1. The Parties**

The Complainant is Bayerische Motoren Werke Aktiengesellschaft of Munich, Germany, represented by Simmons & Simmons, the Netherlands.

The Respondent is Quispel Motoren of Deurne, the Netherlands, represented by Louwers IP | Technology Advocaten B.V., the Netherlands.

#### **2. The Domain Name and Registrar**

The disputed domain name <bmwmotorenshop.nl> (the “Domain Name”) is registered with SIDN through AutoDNS.

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 10, 2013. On June 11, 2013, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On June 12, 2013, SIDN transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Dispute Resolution Regulations for .nl Domain Names (the “Regulations”).

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 14, 2013. In accordance with the Regulations, article 7.1, the due date for Response was July 4, 2013. The Response was filed with the Center on July 4, 2013.

On July 9, 2013, SIDN commenced the mediation process. On August 9, 2013, SIDN extended the mediation process until September 7, 2013. On August 14, 2013, SIDN informed parties that the dispute had not been solved in the mediation process.

The Center appointed Willem Hoorneman as the panelist in this matter on September 2, 2013. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

#### **4. Factual Background**

The Complainant is a manufacturer of high-performance automobiles, motorcycles and accessories, with a worldwide reputation. Since 1917, the Complainant has manufactured, marketed and sold its products under its well-known trademark BMW.

The Complainant is holder of, *inter alia*, the following registrations for its BMW trademark (the "Trademark"):

- the International Registration, designating the Benelux, of the word mark BMW, with registration no. 663925, registered on December 22, 1995 for goods in classes 1 to 18, 20 to 30 and 32 to 42, including cleaning products, industrial oils and accessories for motorcycles;
- the Community word mark BMW, with registration no. 91835, registered on February 25, 2000 for goods in classes 1 to 18, 20 to 30 and 32 to 42, including cleaning preparations, industrial oils, accessories for motorcycles, vehicles and parts thereof and automobile accessories; and
- the Benelux word mark BMW, with registration no. 27206, registered on April 23, 1971 for goods in classes 7 and 12, including vehicles, automobiles and motorcycles.

The Domain Name was first registered on June 18, 2002. The Respondent became the current registrant of the Domain Name by change of registrant on March 7, 2012.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the Domain Name is confusingly similar to its Trademark, as the Domain Name incorporates the Trademark in its entirety. The addition of such generic terms as the Dutch word "motoren" ("motorcycles" in English) and the English word "shop" to the Domain Name does not prevent confusion.

The Complainant claims that the Respondent has no rights to or legitimate interests in the Domain Name. The Complainant has never licensed or otherwise authorized the Respondent to use its Trademark in the Domain Name. The Respondent not only offers original goods under the Trademark, but also and mostly identical goods that originate from other companies in competition with the Complainant. The website operated by the Respondent therefore serves as a "bait and switch"-site: attracting customers by making use of the Trademark in order to subsequently persuade them to mainly purchase goods from the Complainant's competitors. This implies that the Respondent is not using the Domain Name in connection with a *bona fide* offering of goods. The Respondent is not commonly known by the Domain Name.

The Complainant asserts that the Domain Name has been registered or is being used in bad faith. Given the repute of the Trademark, the Respondent must have been well aware of the Complainant's Trademark when registering the Domain Name. Also, on the website operated under the Domain Name the Respondent has made unauthorized use of original BMW promotional materials and has offered counterfeit BMW branded goods.

The use of the Domain Name cannot be described as legitimate noncommercial or fair use without intent for commercial gain. To the contrary: with the use of the Domain Name the Respondent simply seeks to ride on the coat-tail of the famous Trademark in order to benefit from the power of attraction, the reputation and the prestige of the Trademark, which clearly constitutes bad faith.

##### **B. Respondent**

The Respondent contends that the Domain Name is not confusingly similar to the Complainant's Trademark, as the Domain Name consists of three elements, namely the Trademark, the word "motoren" and the word "shop", and therefore the Domain Name differs from the Trademark.

According to the Respondent, it is making a *bona fide* offering of goods, absent any associated deception. The Respondent claims it only uses the website under its Domain Name to sell and promote BMW products or products intended for BMW motorcycles. The other trademarks mentioned on the website are not (direct) competitors of the Complainant. As only non-competitive products are being offered, the website does not constitute a "bait and switch"-site. In addition, the website contains a disclaimer that accurately discloses the (lack of) relationship of the Respondent with the Complainant. Considering all this, the Respondent in its view has legitimate interests in the Domain Name.

Given the foregoing, the Respondent has not registered and is not using the Domain Name in bad faith. The Respondent does not attract Internet users to the website by creating a likelihood of confusion, nor are users which visit the website likely to believe they are dealing with an authorized agent of the Complainant due to the clear disclaimer on the website and the fact that only products for BMW motorcycles are offered.

## 6. Discussion and Findings

Pursuant to article 2.1 of the Regulations, the Complainant's request to transfer the Domain Name must meet three cumulative conditions:

- a. The Domain Name is identical or confusingly similar to a trademark or trade name protected under Dutch law in which the Complainant has rights, or other name by means of article 2.1(a) under II of the Regulations; and
- b. The Respondent has no rights to or legitimate interests in the Domain Name; and
- c. The Domain Name has been registered or is being used in bad faith.

The Respondent may demonstrate such rights or legitimate interests on its part, *inter alia*, through the circumstances mentioned in article 3.1 of the Regulations. The Complainant may provide evidence that the Domain Name has been registered or is being used in bad faith, *inter alia*, through the circumstances mentioned in article 3.2 of the Regulations.

### A. Identical or Confusingly Similar

The Complainant has based its Complaint on the Trademark and has submitted copies of its Benelux, Community and International trademark registrations demonstrating that it is the holder of the Trademark. The Trademark qualifies as a trademark protected under Dutch law.

It is established case law that the country code top-level domain (ccTLD) ".nl" may be disregarded in assessing the similarity between the relevant trademark on the one hand, and the domain name on the other hand (see: *Taylor Made Golf Company, Inc. v. Lotom Group S.A.*, WIPO Case No. DNL2010-0067; *Roompot Recreatie Beheer B.V. v. Edoco LTD*, WIPO Case No. DNL2008-0008).

The Domain Name is confusingly similar to the Complainant's Trademark, because the Domain Name incorporates the Trademark in its entirety. The Domain Name differs from the Trademark only in that the Trademark is followed by two generic or descriptive terms, namely "motoren" (in English "motorcycles") and "shop". The addition of such generic or descriptive terms does not eliminate the confusing similarity with the Trademark (see, in particular: *Seiko EPSON Corporation v. ANEM Computers / ANEM*, WIPO Case No. DNL2010-0024, in which case the word "shop" was considered descriptive and generic. See also: *Caterpillar Inc. v. H. van Zuylen Materieel*, WIPO Case No. DNL2011-0073; *LEGO Juris A/S v. Nick Terlouw*, WIPO Case No. DNL2011-0023; *Taylor Made Golf Company, Inc. v. Lotom Group S.A.*, WIPO Case No. DNL2010-0067; and *Boels Verhuur B.V. v. Edoco LTD.*, WIPO Case No. DNL2010-0020). Rather, the additional term "motoren" adds to the confusion as it describes a type of products manufactured

and sold by the Complainant under its Trademark (see: *Aktiebolaget Electrolux v. Buisman-Rosbergen V.O.F.*, WIPO Case No. DNL2012-0004).

Therefore, the Panel finds that the Domain Name is confusingly similar to the Trademark.

## **B. Rights or Legitimate Interests**

The Complainant must demonstrate that the Respondent has no rights to or legitimate interests in the Domain Name. This condition is met if the Complainant makes a *prima facie* case that the Respondent has no such rights or interests, and the Respondent fails to rebut this (see: *Technische Unie B.V. and Otra Information Services v. Technology Services Ltd.*, WIPO Case No. DNL2008-0002).

The record does not include any indication that the Respondent has any relevant trademark or trade name rights regarding the term “bmwmotorenshop”. The Complainant has not licensed or otherwise permitted the Respondent to use the Trademark. The Respondent is not an authorized sales or services agent or dealer of goods under the Trademark, but may be considered a reseller of the products of the Complainant.

Only under specific circumstances may a reseller of trademarked goods have a legitimate interest in a domain name incorporating the trademark. Pursuant to the panel decision in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903, the use of a trademark in a domain name by an authorized sales agent of trademarked goods may be considered a *bona fide* offering of goods, constituting a legitimate interest, if several requirements are met. In later panel decisions, the same has been acknowledged in respect of such use by an (unauthorized) reseller, such as the Respondent (see, amongst others: *Maison Louis Latour v. Jos Beeres Wijnkoperij*, WIPO Case No. DNL2011-0074; and *Seiko EPSON Corporation v. ANEM Computers / ANEM*, WIPO Case No. DNL2010-0024).

The referenced requirements include, at minimum, the following: (1) the Respondent must actually offer the goods and services at issue; (2) the website must sell only the trademarked goods; (3) the website must accurately and promptly disclose the registrant’s relationship with the trademark holder; and (4) the Respondent must not try to “corner the market” in domain names that reflect the Trademark.

Indeed, the Respondent actually offers the goods at issue. Also, the website contains a clear disclaimer at the top of each page indicating that the Respondent is not an official dealer of nor otherwise affiliated to the Complainant. The Respondent cannot be said to corner the market, as the Complainant and/or its group company BMW Nederland B.V. hold various BMW domain names such as <bmw.com>, <bmw.nl>, <bmwshop.nl> and <bmw-motorrad.nl>.

However, it appears from the evidence brought before the Panel that the second criterion has not been met. Although the website appears to offer mainly trademarked goods, the Respondent has admitted – and its website clearly shows – that it also sells a number of other products. In this respect, the Respondent has argued that these other products are all intended for BMW motorcycles, and that the other trademarks mentioned on its website are not (direct) competitors of the Complainant. However, it cannot be denied that on the website linked to the Domain Name the Respondent not only offers goods under the Trademark, but also products of other companies, which are identical and/or similar to the goods for which the Trademark has been registered, therefore qualifying such companies as being in competition with the Complainant and its trademarked goods. As the Complainant has correctly indicated, the offering of such other products, including through the alphabetical overview of all (other) trademarks available on the website (headed “Find Your Favorite Brand”, which appears when a visitor clicks on the link “Brands” in the menu on the home page), makes it easy for Internet users to switch to such other products than identical ones produced by the Complainant. These circumstances indicate that the Respondent was – perhaps not primarily, but not insignificantly also – using the Trademark in the Domain Name to divert the attention of Internet users to competing goods, which implies that the Domain Name is not (only) used for the *bona fide* offering of goods or services (see: *Seiko EPSON Corporation v. ANEM Computers / ANEM*, WIPO Case No. DNL2010-0024).

Based on the foregoing, the Panel is of the opinion that the Respondent has no rights to or legitimate

interests in the Domain Name under the Regulation.

### **C. Registered or Used in Bad Faith**

The registrations of the Trademark predate the Domain Name's registration by several years, even decades. As the Respondent has indicated to be a former employee of BMW (in its letter to the Complainant, submitted as Annex 6 to the Complaint), the Panel deems it certain that the Respondent was aware of the Complainant's (well-known) Trademark when registering the Domain Name. Moreover, the Trademark of the Complainant is a well-known trademark and the Complainant owns rights thereto effective and enforceable in the Netherlands, while the Domain Name is in the ".nl" domain, the website linked to it is in the Dutch language, the Respondent is established and runs its business in the Netherlands and the website concerned also offers goods under the Trademark.

Indeed, the Panel notes that the Respondent has indicated to have never acted in bad faith and apparently has, upon receipt of the warning letter(s) on behalf of the Complainant indicating its rights and concerns, made efforts to bring its website in conformity with the (minimum) requirements for use of a Domain Name incorporating the Trademark, in an attempt to meet the criteria mentioned above under Section 6 B. (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903). That said, despite its disclaimer on the website, the fact remains that the Domain Name incorporates the Trademark thereby attracting Internet users to the website that also offers products other than trademarked goods. Therefore, the Panel must conclude that the Domain Name is being used by the Respondent for commercial gain, by intentionally attracting Internet users to its website where the Respondent is also offering goods of competitors of the Complainant, through the likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website. This constitutes evidence of bad faith in terms of the Regulations (article 3.2(d)) (see: *Seiko EPSON Corporation v. ANEM Computers / ANEM*, WIPO Case No. DNL2010-0024; and *Taylor Made Golf Company, Inc. v. Lotom Group S.A.*, WIPO Case No. DNL2010-0067).

On the above grounds, the Panel finds that the requirements of registration or use in bad faith of the Domain Name pursuant to article 2.1(c) of the Regulations have been met.

### **7. Decision**

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the Domain Name <bmwmotorenshop.nl> be transferred to the Complainant.

**Willem Hoorneman**

Panelist

Date: September 23, 2013