

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG v. Privacy Service provided by Withheld for Privacy ehf / Constantin Busuioceanu
Case No. D2022-0095

1. The Parties

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

The Respondent is Privacy Service provided by Withheld for Privacy ehf, Iceland / Constantin Busuioceanu, Romania.

2. The Domain Name and Registrar

The disputed domain name <bmw.bond> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 12, 2022. On January 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 12, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on January 14, 2022, 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 amended Complaint on January 15, 2022.

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 January 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 9, 2022. The Respondent sent an informal email communication on January 20, 2022. The Center sent to the Parties a possible settlement email the same day. The

Complainant did not request a suspension of the proceedings for settlement discussions. The Center therefore informed the Parties of its commencement of Panel Appointment process on February 14, 2022.

The Center appointed Jeremy Speres as the sole panelist in this matter on February 17, 2022. 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 has, since 1917, traded as an automobile and motorcycle manufacturer under its BMW mark. The Complainant sells its goods globally and its BMW mark is widely acknowledged as one of the most recognisable brands in the world.

The Complainant owns trade mark registrations for its BMW mark in over 140 countries. Importantly for this matter the Panel has independently established that the Complainant owns European Union Trade Mark registration number 000091835 BMW in virtually all classes, which proceeded to registration on February 25, 2000. That registration covers the Respondent's territory of Romania. The Complainant also owns many BMW-incorporating domain names, with its primary website being located at <bmw.com>.

The Domain Name was registered on September 25, 2021. The Complainant presented evidence that the Domain Name has resolved to a website offering unauthorised versions of the Complainant's diagnostic and navigation software, prominently featuring the Complainant's BMW products and BMW logo.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to its BMW mark, that the Respondent has no rights or legitimate interests in it, and the Domain Name was registered and used in bad faith given that it has been used to advertise unauthorised, counterfeit versions of the Complainant's products.

B. Respondent

Apart from an informal response in which the Respondent merely asked the Center to "change the bmw.bond owner and DNS servers", the Respondent did not participate in these proceedings.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Domain Name is plainly identical to the Complainant's registered trade mark. The Complainant has satisfied the requirements under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant's evidence establishes that its mark was registered and well known long prior to registration of the Domain Name. The Domain Name is identical to the Complainant's mark and the Complainant has certified that the Domain Name is unauthorised by it.

The Complainant's un rebutted contention is that the Domain Name has been used to advertise counterfeit versions of the Complainant's diagnostic and navigation software. Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods) can never confer rights or legitimate interests (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 2.13). Even if the Respondent were to be a reseller of genuine BMW software, the Respondent's conduct does not meet the requirements of the well-known Oki Data test given that the Respondent's site did not accurately and prominently disclose the Respondent's relationship with the Complainant (*Oki data Americans, Inc. v. ADD, Inc*, WIPO Case No. [D2001-0903](#); and [WIPO Overview 3.0](#) at section 2.8). Moreover, the Panel finds that the Domain Name carries a high risk of implied affiliation with the Complainant ([WIPO Overview 3.0](#) at section 2.5.1).

There is no evidence that any of the circumstances set out in paragraph 4(c) of the Policy pertain.

The Complainant has satisfied paragraph 4(a)(ii) of the Policy by virtue of having made out an un rebutted *prima facie* case ([WIPO Overview 3.0](#) at section 2.1).

C. Registered and Used in Bad Faith

Given the immense repute of the Complainant's mark and considering the manner in which the Respondent has used the Domain Name, including obvious references to the Complainant and its products on the website to which the Domain Name has resolved, the Respondent clearly had the Complainant in mind when it registered and subsequently used the Domain Name.

The Respondent's use of the Domain Name is such that it is likely to confuse users, for the Respondent's commercial gain, into thinking that the Respondent is authorised to sell the Complainant's diagnostic and navigation software. This is a clear indicator of bad faith under paragraph 4(b)(iv) of the Policy.

The word "bond" relates to a financial instrument, and the Complainant's BMW vehicles are often purchased through financing options. The choice of the Top-Level Domain ".bond" therefore supports the conclusion that the Respondent targeted the Complainant ([WIPO Overview 3.0](#) at section 3.2.1).

The Complainant has satisfied paragraph 4(a)(iii) 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 Domain Name <bmw.bond> be transferred to the Complainant.

/Jeremy Speres/

Jeremy Speres

Sole Panelist

Date: February 22, 2022