

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG v. Advies & Consultancy Almere
Case No. DNL2016-0018

1. The Parties

Complainant is Bayerische Motoren Werke AG of München, Germany, represented by Simmons & Simmons, the Netherlands.

Respondent is Advies & Consultancy Almere of Almere, the Netherlands.

2. The Domain Name and Registrar

The disputed domain name <bmw-accessoires.nl> (the “Domain Name”) is registered with SIDN through Hostnet B.V.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 28, 2016. On April 29, 2016, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On May 3, 2016, SIDN transmitted by email to the Center its verification response confirming that 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 Respondent of the Complaint, and the proceeding commenced on May 4, 2016. In accordance with the Regulations, article 7.1, the due date for Response was May 24, 2016. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 25, 2016.

The Center appointed Dinant T. L. Oosterbaan as the panelist in this matter on June 2, 2016. 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

Complainant has been making high-performance automobiles for a substantial number of years.

According to the evidence submitted by Complainant, Complainant owns a large number of trademark registrations for BMW, including:

- International trademark registration BMW No. 145185, registered January 31, 1950 (protected in the Benelux Countries);
- Community trademark registration BMW No. 000091835, registered February 25, 2000.

The Domain Name, <bmw-accessoires.nl>, was registered by Respondent on April 1, 2015. The Domain Name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

Complainant submits that the Domain Name, <bmw-accessoires.nl>, is identical or confusingly similar to Complainant's well-known and registered BMW marks because it consists of this mark in its entirety, with the addition of the non-distinctive and descriptive word "-accessoires" (accessories in English). The use of this word "accessoires" after the trademark BMW adds to the confusion between the marks and the Domain Name as it emphasizes the availability of the products sold under the trademarks.

According to Complainant the Domain Name is clearly not registered by Respondent in connection with a *bona fide* offering of goods and services. Complainant submits that Respondent is not and has not been commonly known by the Domain Name. There is no evidence in the record, including the Whois information, to demonstrate that Respondent is commonly known by the Domain Name. Respondent is not a licensee of Complainant, and Complainant has never authorized Respondent to register or use the Domain Name or the BMW marks.

Complainant submits that Respondent's registration and use of the Domain Name squarely meets the grounds of bad faith outlined in the Regulations. As is clear from an email dated April 15, 2016, sent by Respondent to Complainant, Respondent has offered the Domain Name for sale to Complainant. Respondent's registration thus constitutes bad faith, because Respondent has registered (or bought) the Domain Name primarily to sell, rent, or otherwise transfer it for valuable consideration in excess of Respondent's out-of-pocket expenses.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Based on article 2.1 of the Regulations, a claim to transfer a 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 mentioned in 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.

As Respondent has not filed a Response, the Panel shall rule on the basis of the Complaint. In accordance with article 10.3 of the Regulations, the Complaint shall in that event be granted, unless the Panel considers it to be without basis in law or in fact.

A. Identical or Confusingly Similar

Pursuant to article 2.1(a) of the Regulations, Complainant must establish that the Domain Name is identical or confusingly similar to a trademark in which Complainant has rights.

Complainant has established that it is the owner of large number of trademark registrations including a Community trademark registration for BMW.

The Domain Name, <bmw-accessoires.nl>, incorporates the entirety of the well-known BMW trademark as its distinctive element. Many decisions under the Regulations have found that a domain name is confusingly similar to a complainant's trademark where the domain name incorporates the trademark in its entirety. The addition of the common, descriptive and non-distinctive element "accessoires" (translated in English: "accessories") is insufficient to avoid a finding of confusing similarity. The Top-Level Domain ".nl" may be disregarded for purposes of article 2.1(a) of the Regulations.

The Panel finds that the Domain Name is confusingly similar to Complainant's BMW trademark.

B. Rights or Legitimate Interests

In the opinion of the Panel, Complainant has made a *prima facie* case that Respondent lacks rights or legitimate interests in the Domain Name. Respondent is not making a legitimate noncommercial or fair use of the Domain Name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark of Complainant. Based on the evidence provided by Complainant, there is no active website to which the Domain Name resolves. Respondent is not commonly known by the Domain Name nor has it acquired trademark rights.

On the record before it, the Panel finds that Respondent has no rights or legitimate interests in the Domain Name.

C. Registered or Used in Bad Faith

In this proceeding Complainant has invoked a trademark with a registration date of January 31, 1950. However, as noted in the Complaint, the BMW trademark has even been used well before, since 1917. Respondent knew or should have known that the Domain Name included Complainant's well-known BMW trademark.

The Panel notes that Respondent in its email of April 15, 2016 pursuant to a cease-and-desist email sent by Complainant replied "[w]hat do you have in mind for compensation". This suggests that Respondent registered the Domain Name primarily to sell, rent, or otherwise transfer it for valuable consideration in excess of Respondent's registration expenses, which constitutes registration or use in bad faith pursuant to article 3.2(a) of the Regulations.

Another possible motivation with regard to future use would likewise indicate bad faith: that Respondent has the intent to attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademark of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product on its website or location, which constitutes registration or use in bad faith pursuant to article 3.2(d) of the Regulations.

Accordingly, in the absence of any documented contestation by Respondent, the Panel concludes that the Domain Name was at least registered in bad faith.

7. Decision

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

Dinant T. L. Oosterbaan

Panelist

Date: June 8, 2016