

## **DISPUTE RESOLUTION SERVICE**

**D00019362**

**Decision of Independent Expert**

**Bayerische Motoren Werke AG**

and

**Mr Adrian Dumitrescu**

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

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

Respondent: Mr Adrian Dumitrescu  
Iuliu Maniu  
RO  
Bucharest  
061233  
Romania

### **2. The Domain Name(s):**

bmwnavi.co.uk

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

I can 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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

30 September 2017 01:44 Dispute received

03 October 2017 12:19 Complaint validated

03 October 2017 12:22 Notification of complaint sent to parties

20 October 2017 02:30 Response reminder sent

25 October 2017 08:12 No Response Received

25 October 2017 08:12 Notification of no response sent to parties

27 October 2017 14:09 Expert decision payment received

01 November 2017 Keith Gymer appointed as Expert wef 6 November 2017

### **4. Factual Background**

The Complainant is the German car and motorcycle manufacturer, Bayerische Motoren Werke AG, whose vehicles bear the familiar BMW brand. The Complainant has been in business since 1916 and its vehicles are sold worldwide. Its earliest trade mark registration for a BMW & design mark is German registration 221388 dating from 1917, and it holds a BMW letter mark as German registration 410579 dating from 1929. It has many other BMW registrations worldwide, including EUTM registration 91835 for the mark BMW in block letters, dating from 1996.

The Complainant uses its BMW mark in connection with its network of websites dedicated to advertising, promoting, and/or offering its automobiles, motorcycles, and related products and services, including updates for its BMW vehicle navigation software.

The Respondent is named evidently as a Romania-based, private individual.

The disputed Domain Name is recorded on the Nominet WhoIs record as first registered on 20 September, 2009. At the time of the Complaint, the Respondent operated a website marketing software upgrades and access codes for BMW GPS navigation systems.

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

#### **Complainant**

The Complainant makes its case in the following terms:

The Complainant is one of the most successful manufacturers of automobiles and motorcycles in the world. It owns the trademark BMW. Under this mark, the Complainant manufactures, sells, and distributes an array of automobiles and motorcycles, and provides numerous services including maintenance and repair services, financing, leasing, insurance, and warranty services, among others. It also uses and licenses its mark on a wide variety of automobile and motorcycle parts and accessories and numerous collateral products.

Over the years the Complainant has extensively and widely advertised and promoted its products and services under the BMW mark. BMW has become one of the most recognized brands in the world. Interbrand, one of the world's leading branding firms, has ranked the BMW brand in its "Top 100" report for global brands for many years, and in 2016, ranked the BMW mark 11th of the "Best Global Brands" with a value of more than \$41.5 billion.

The Complainant has also used its BMW mark in connection with its network of websites. Its online network, which it has operated since at least as early as 1996, receives many millions of hits each month, and its websites are accessible via domain names comprising the BMW mark alone and combined with relevant geographic and/or descriptive terms. For example, the Complainant's international portals include websites using the domain names BMW.COM and BMWGROUP.COM. These portal websites provide information regarding the Complainant's products and services, and allow users to select their country or region to go to country-specific or region-specific websites for detailed and geographically relevant information regarding BMW products and services.

As a result of these longstanding naming traditions, persons encountering domain names consisting of the BMW mark combined with terms relating to the Complainant's business will believe that the domain name and/or corresponding website is owned, operated, and/or authorized by BMW.

The Complainant offers, and has offered for years, navigation software and systems for its BMW automobiles. The navigation software and systems are offered under the BMW mark and formative marks, including BMW CONNECTEDDRIVE. Updates and activation/FSC codes for the navigation software are offered via authorized dealers and on various official BMW websites.

#### The Domain Name Is Similar To The BMW Mark

The Complainant has continuously used BMW as a trademark and service mark since 1917, and owns numerous registrations for the BMW mark and variations thereof in more than 140 countries around the world. Examples include those marks identified in Section 4 above. Its trademark rights in the BMW mark, based on its trademark registrations and its common law rights acquired through use, long predate Respondent's registration of the Domain Name.

The Domain Name is similar to Complainant's BMW mark because it contains the Complainant's BMW mark in its entirety and, on its face, immediately communicates a connection to the Complainant that does not exist. Further, the addition of the generic or descriptive abbreviation "navi" for "navigation," which describes products offered by Complainant under its BMW mark, heightens the similarity of the Domain Name to Complainant's BMW mark.

Numerous DRS decisions have held that a domain name comprised of a trademark and a generic term or descriptive term is similar to the mark at issue. See, e.g.:  
D00019045 BMW v. Balog (bmwvin.co.uk; bmwupdates.co.uk);  
D00015755 BMW v. Redshaw (bmwcarclub.org.uk; bmwforum.org.uk;  
bmwmotorcycleclub.co.uk; bmwownersclub.co.uk; bmwownersclub.org.uk  
and others).

### The Domain Name Is An Abusive Registration

The Respondent registered the domain name BMWNAVI.CO.UK (the "Domain Name") long after the Complainant began using its BMW mark; long after the BMW mark became internationally famous; and long after the Complainant registered its mark in Germany, the European Union, the U.S., and elsewhere.

The Domain Name is used for a commercial website advertising and offering unauthorized, counterfeit "BMW" navigation software and activation/FSC codes. As noted above, the Complainant offers its BMW navigation software, including updates and codes, through its authorized dealers and directly. The Respondent is not and has never been an authorized reseller of BMW navigation software and codes. In addition to the Respondent's unauthorized use of the Complainant's BMW mark in the Domain Name, the Respondent's website uses (a) the famous BMW Logo, and (b) the BMW mark in the product names "2017-2 BMW PREMIUM, MOVE and NEXT Sat Nav UPDATES including the FSC Activation Code" and "2017-2 BMW SAT NAV UPDATE."

The Respondent's website displays a false statement claiming that it is "a private enthusiast site" in a transparent and meritless attempt to legitimize its activities. However, the record shows that Respondent's website is a commercial website offering counterfeit "BMW" branded products to the general public.

The Domain Name constitutes an abusive registration under the DRS because the Respondent registered and uses the Domain Name in a manner that takes unfair advantage of and which is unfairly detrimental to the Complainant's rights in its famous BMW mark.

The Respondent's registration interferes with the Complainant's ability to control use of its registered BMW mark. Given the fame of and the Complainant's longstanding use of its BMW mark in domain names across its own online network, there is no question but that the Respondent registered the Domain Name to misappropriate the Complainant's goodwill in its BMW mark and to attract and

divert Internet users searching for the Complainant's website or a website authorized by the Complainant. The Respondent's unauthorized use of the BMW mark in the Domain Name is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorized by, or otherwise connected with Complainant, and especially because the Respondent uses the Domain Name to offer unauthorized, counterfeit "BMW" products.

The false statement on the Respondent's website that it is an enthusiast site does not mitigate the likelihood of confusion created by the unauthorized use of the BMW mark or the abusive registration and use of the Domain Name.

The Respondent's use of the Domain Name to offer unauthorized, counterfeit products also unfairly disrupts Complainant's business and unfairly damages the Complainant's BMW brand.

The Respondent cannot demonstrate that the Domain Name is not an abusive registration. The Domain Name is not used in connection with a genuine offering of goods or services. The Respondent has not been commonly known by the Domain Name nor legitimately connected with a mark which is identical or similar to the Domain Name. The Respondent has not made a legitimate non-commercial or fair use of the Domain Name. Rather, the Respondent has used the Domain Name to advertise and offer unauthorized, counterfeit products and to unfairly compete with the Complainant's own offering of genuine BMW products. *[The Complaint included a formal Declaration given by the Complainant's Senior Legal Counsel confirming that a test purchase had been made from the Respondent's website and the goods supplied were found to be counterfeit products.]*

#### Remedy Requested

Transfer of the Domain Name to the Complainant.

#### **Respondent**

The Respondent did not offer any Response to the Complainant's allegations.

## **6. Discussions and Findings**

### **General**

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name(s); and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration

Under Paragraph 18.1 of the Policy, the Expert is required to decide a complaint on the basis of the Parties' submissions and the Policy.

### **Complainant's Rights**

The Complainant has provided ample evidence of its longstanding registered trade mark rights in the BMW mark, in both plain letter and device forms.

Additionally, the Complainant has asserted that their extensive and worldwide use of the BMW mark since 1917 means that they have also established unregistered common law rights.

The disputed Domain Name is "bmwnavi.co.uk".

The Complainant clearly has enforceable rights in BMW, which long predate the registration of the Domain Name. It is evident that the relevant components of the Domain Name will naturally be recognised and perceived by English readers as "BMW-navi", with the distinctive element BMW being identical to the Complainant's mark, and "navi" being read as a recognisable abbreviation for "navigation" in relation to Satnav systems.

The Expert therefore finds that the Complainant has relevant Rights in a name or mark, which is at least similar to the Domain Name. The requirement of Paragraph 2.1.1 of the Policy is met.

### **Abusive Registration**

The Complainant also must show that the disputed Domain Name is an Abusive Registration. Paragraph 1 of the Policy defines "Abusive Registration" as a Domain Name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR
- ii. is being or has been used in a manner, which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

A non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration are set out in Paragraph 5 of the Policy. The following examples appear pertinent to the present dispute:

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

...

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

Conversely, Paragraph 8 of the Policy provides observations on “How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration”, of which the following might have been pertinent:

8.1.1 Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

8.1.1.1 used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

8.1.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; or

8.1.1.3 made legitimate non-commercial or fair use of the Domain Name.

8.1.2 The Domain Name is generic or descriptive and the Respondent is making fair use of it;

8.2 Fair use may include sites operated solely in tribute to or in criticism of a person or business.

The factors listed in Paragraphs 5 and 8 of the Policy are only intended to be exemplary and indicative. They are not definitive either way. It is Paragraph 1 of the Policy, which provides the applicable definition as indicated above.

In the present case, no submissions have been made by the Respondent to rebut or deny the allegations made by the Complainant.

The Complainant has presented convincing and unchallenged arguments, supported by a formal Declaration from Senior Legal Counsel, that the Respondent had no authority to register or use the BMW mark in relation to the Domain Name, and that the Respondent's use has been for the illegitimate purpose of selling counterfeit BMW branded navigation software updates and activation codes.

In the Expert's opinion, in these circumstances, it is unsurprising the Respondent has failed to enter any Response, as there is no reason to doubt that the Domain Name

was deliberately contrived and registered by the Respondent with the clear intention of taking unfair advantage of the fame and reputation of the BMW mark in order to divert, deceive and exploit potential customers for BMW software updates and activation codes for personal profit to the obvious detriment of the Complainant's business and brand reputation.

There is no evidence whatever to support any potential grounds (e.g. the examples given above from Paragraph 8 of the Policy) for not finding the Domain Name to be an Abusive Registration.

The Expert notes that the Domain Name was first registered in 2009, but no evidence has been provided as to when the Respondent first operated a website using the Domain Name, and the Complainant's eight year delay in bringing its Complaint has not been explained or called into question, and has not required consideration in this case. However, even had the issue been raised, the fact that the manifestly abusive use was continuing would have rendered any delay irrelevant.

The Expert holds that the Domain Name is an Abusive Registration beyond any reasonable doubt. The requirement of Paragraph 2.1.2 of the Policy is met.

## **7. Decision**

Having found that the Complainant has relevant Rights and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert orders that the Domain Name be transferred to the Complainant.

**Signed .....**      **Dated    16 November, 2017**  
**Keith Gymer**