

## Decision for dispute CAC-UDRP-105614

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| Case number    | CAC-UDRP-105614         |
| Time of filing | 2023-07-12 10:10:54     |
| Domain names   | harleydavidsonshirt.com |

### Case administrator

|      |                             |
|------|-----------------------------|
| Name | Olga Dvořáková (Case admin) |
|------|-----------------------------|

### Complainant

|              |                                    |
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| Organization | Harley-Davidson Motor Company Inc. |
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### Complainant representative

|              |                       |
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| Organization | Stobbs IP (Stobbs IP) |
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### Respondent

|              |                      |
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| Organization | Vin Nguyen (Vin Pre) |
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#### OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

#### IDENTIFICATION OF RIGHTS

The Complainant is the registered proprietor of various trademarks worldwide, including:

- United Kingdom device mark HARLEY-DAVIDSON, with reg. nr. UK00915739352, registered on November 19, 2001 in classes 35, 37 for services rendered by wholesale dealers, and distributors in the fields of, *inter alia*, motorcycles, motorcycle parts and accessories, footwear, clothing, and bags, and motorcycles maintenance and repair; and
- United Kingdom trademark HARLEY-DAVIDSON, with reg. nr. UK00901797018, registered on March 21, 2002 in classes 25, 39 for various clothing items, travel arrangement and motorcycle rental.

The disputed domain name was registered on June 8, 2020 and resolves to a website which features the Complainant's HARLEY DAVIDSON stylized trademark at the top of the webpage, and offers T-shirts with different designs for sale.

#### FACTUAL BACKGROUND

The Complainant is a subsidiary company of Harley-Davidson, Inc., an international motorcycle manufacturer providing leading worldwide manufacture, distribution, and sale of motorcycles, parts, and complementary goods and services thereof. Harley-Davidson, Inc. includes the subsidiary Harley-Davidson Motor Company Inc. The Complainant's parent company has traded on the New York Stock Exchange since 5 November 1987 and as of 18 May 2021, has a market capitalisation value of \$7.9 billion.

The Complainant owns very extensive rights in the HARLEY-DAVIDSON mark, and in addition, the domain name <harley-davidson.com> was registered by the Complainant on 8 November 1994. The Complainant has an active online presence including on “https://www.harley-davidson.com/”

The United States of America (USA) is the Complainant’s domestic market and accounts for a significant portion of sales, with other key markets being Germany, Austria, Switzerland, Japan, China, Canada, France, United Kingdom, Italy, Australia, and New Zealand. The Complainant has a significant reputation and has built up a vast amount of goodwill in the sign HARLEY-DAVIDSON in the USA and abroad in relation to a wide range of goods and services.

The HARLEY-DAVIDSON brand has become iconic in popular culture in part due to the intensity, geographical extent, and long-standing use made of such marks, as evidenced by the extremely high level of awareness of the Complainant’s brand amongst consumers, as indicated by the consistent inclusion of Harley-Davidson within the Interbrand’s “Top 100: Best Global Brands” report.

According to the Complainant the disputed domain name is identical or confusingly similar to the Complainant’s HARLEY-DAVIDSON trademarks, which it incorporates at the beginning of the disputed domain name. The term “shirts” as part of the disputed domain name is not distinctive and does nothing to alter the overall impression in the eyes of the average internet user.

Further, the Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name, as the disputed domain name is used to resolve to a website which offers goods that are competing with those of the Complaint, falsely purporting that the Respondent’s website is affiliated with and/or are the Complainant, when they are not licensed, authorized, or associated with the Complainant. Also, upon the Complainant’s information and belief, the Respondent has never legitimately been known by the name HARLEY-DAVIDSON at any point in time. And the Complainant alleges that nothing suggests that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name.

Furthermore, the Complainant alleges that the Respondent is free riding on the coat tails of the Complainant’s famous HARLEY-DAVIDSON trademarks in a deliberate attempt to trade upon their reputation. According to the Complainant, the Respondent disrupts the Complainant’s business by diverting potential customers to the website under the disputed domain name, selling goods unaffiliated with the Complainant, and such use of confusingly similar domain name, with the inclusion of the Complainant’s trademark on the associated website, in a manner disruptive of a Complainant’s business by trading upon the goodwill of a Complainant for the commercial gain evinces bad faith.

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#### PARTIES CONTENTIONS

Complainant’s contentions are summarised above.

No administratively compliant response has been filed.

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#### RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

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#### NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

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#### BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

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#### PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

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## PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the disputed domain name is confusingly similar to the Complainant's HARLEY-DAVIDSON trademarks, which were registered prior to the registration of the disputed domain name. The disputed domain name wholly incorporates the Complainant's trademarks. The fact that the term "shirt" is added does not eliminate the similarity between Complainant's trademarks and the disputed domain name, and in fact may even enhance the confusing similarity between the Complainant's trademarks and the disputed domain name in view of the Complainant having registered trademarks for, and selling, shirts under the HARLEY-DAVIDSON trademarks.
2. The Complainant must make a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which the Respondent may rebut (e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455). The Panel takes note of the various allegations of the Complainant and in particular, that that the Respondent has never legitimately been known by the dispute domain name and has not been licensed or authorized to use the HARLEY-DAVIDSON trademarks in the disputed domain name. The Panel further finds that the Respondent has made no use of, or demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, nor is it making a legitimate non-commercial or fair use of the disputed domain name. On the contrary, the Respondent's website associated with the disputed domain name undisputedly tries to impersonate the Complainant and offers goods that compete with those of the Complainant. The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.
3. The Panel agrees with several panels which have found that the HARLEY-DAVIDSON trademarks have a considerable reputation (e.g., *H-D Michigan, Inc. v. Metal Horse Motorcycles*, WIPO Case No. D2003-0781; and *H-D U.S.A., LLC v. Privacyguardian.org/ Atomic Art*, WIPO Case No. D2021-1623). Because the disputed domain name resolves to a website which features the Complainant's well-known HARLEY-DAVIDSON stylized trademark on the top of the webpages, the Panel infers that the Respondent must have had the Complainant's trademarks in mind when registering the disputed domain name, which was therefore registered in bad faith. Further, the Panel is satisfied that the Respondent's use of the disputed domain name is in bad faith as the disputed domain name resolves to a website which prominently displays the Complainant's HARLEY-DAVIDSON stylized trademark on its webpages, which website undisputedly offers goods for sale with compete with those of the Complainant, thereby attempting to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of this website.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **harleydavidsonshirt.com**: Transferred

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## PANELLISTS

|      |                 |
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| Name | Alfred Meijboom |
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| DATE OF PANEL DECISION | 2023-08-10 |
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Publish the Decision

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