

## DISPUTE RESOLUTION SERVICE

D00010093

### Decision of Independent Expert

H-D Michigan, LLC

and

Ravi Murji

#### 1. The Parties:

##### Lead Complainant:

H-D Michigan, LLC  
315 W. Huron Street, Suite 400  
Ann Arbor  
Michigan  
48103  
United States

##### Respondent:

Ravi Murji  
5 Forum Place  
Herts  
Hatfield  
AL10 0RN  
United Kingdom

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

*www.harleyinsurance.co.uk*

#### 3. Procedural History:

On 18 July 2011 at 17:10 p.m., the Dispute was received.

On 19 July 2011 at 10:31 a.m., the Complaint was validated.

On 19 July 2011 at 12:03 p.m., the Notification of the Complaint was sent to the parties.

On 05 August 2011 at 02:30 a.m., the Response reminder was sent.

By the 10 August 2011, no Response had been received.

On 10 August 2011 at 08:47 a.m. the Notification of no Response was sent to the parties.

On 17 August 2011 at 09:00 a.m., the Expert decision payment was received for a full decision.

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

- 4.1 The Complainant is a U.S. company which uses a network of authorised dealers to market and offer for sale - the motorcycles, motorcycle parts and accessories it manufactures, and related products and services, including insurance services.
- 4.2 The Complainant owns a number of trade mark registrations for the name HARLEY (the 'Name', or when referring to the trade mark, the 'Mark') or with that word in another trade mark, such as for HARLEY-DAVIDSON.
- 4.3 For example, the Complainant owns: CTM Registration No. 3530219 for the Mark, registered on 18 December 2007; and, CTM Registration No. 001485010, for the HARLEY-DAVIDSON mark, registered on 11 June 2001. Both the aforementioned trade marks cover the provision of: insurance services relating to motorcycles, insurance brokerage, insurance consultancy, and insurance information services (Nice classification 36).
- 4.4 In addition, the Complainant owns CTM Registration No. 001524487 for the Mark, registered on 28 June 2001. This registration covers the online advertising of retail sales of services and goods in the field of motorcycles and parts/accessories (Nice classification 35).
- 4.5 The Complainant also owns U.K. Registration No. 658028 for the mark HARLEY-DAVIDSON, which was filed on 9 April 1947, and has been renewed through to 9 April 2016, which covers motorcycles and related parts (Class 12).
- 4.6 The Respondent registered the Domain Name on 2 January 2009, and uses the website affiliated with the Domain Name (the 'Website') to offer insurance broker services specifically for those who want to insure Harley-Davidson motorbikes.

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

##### **Complainant:**

- 5.1 In summary, the Complainant argues that the Domain Name should be transferred to it because:
  - it has Rights in respect of a name and the Mark which is similar to the Domain Name (for the reasons below).

- As described at paragraphs 4.2 to 4.5 above, the Complainant owns the Mark and other trademarks that incorporate the Mark, such as HARLEY-DAVIDSON (collectively, the “Marks”), in numerous countries and jurisdictions all over the world, including the UK and US.
- The Complainant has generated goodwill and reputation in the Name/Mark. In the U.S. and U.K., the Complainant has manufactured, advertised, and sold motorcycles under the HARLEY-DAVIDSON name and trade mark for many decades (in the UK, as early as 1924). The Complainant has offered an array of motorcycle-related products and services under the Mark since at least as early as 1982.
- The Complainant has more than 1,500 authorised dealers throughout the world, including approximately 40 authorised dealers in the U.K. (where the Respondent is located). In the U.K., the Complainant sold in excess of £24 million worth of products and services in 2000; rising steadily to £51 million in 2008.
- The Complainant has extensively advertised and promoted its products and services under the Name/Marks, and on the Internet since 1996. The Complainant’s website, which features special versions for different countries including the U.K. and the U.S., receives tens of millions of hits each month.<sup>1</sup>
- The Complainant and its products/services have for many years received substantial publicity in U.K. publications such as: The Times, The Scotsman, The Guardian, Daily Mail, The Observer, The Independent, and Scottish Daily Record. (The Complainant provided samples of articles from these media sources published during a sample time period of 1993 - 1997.)
- Also, and as reported in a 2009 article from *Business Week Online*, the HARLEY-DAVIDSON mark was ranked by Interbrand in its “100 Best Global Brands” report at number 73. It was at number 50 in the previous year’s report.
- In the U.K., insurance services are provided through licensed third-party providers under the umbrella name *Harley-Davidson Insurance Services*, as well as the product mark and name HARLEY | RIDER INSURANCE. The Complainant also uses domain names comprised of its Marks and the term INSURANCE to advertise its insurance services.<sup>2</sup>

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<sup>1</sup> The Complainant’s website is accessible via the domain names: HARLEY-DAVIDSON.COM, as well as numerous additional domain names including domain names comprised of the Mark and a descriptive term such as HARLEYCREDIT.COM, HARLEYLEASES.COM, and HARLEYDEALERS.COM.

<sup>2</sup> For example, the Complainant owns the domain names HARLEY-DAVIDSONINSURANCE.COM and H-DINSURANCE.COM, and uses those domain names for a website advertising the Complainant’s insurance services in the U.S. (The Complainant provided WHOIS and website printouts to support the above.)

- Thus, the Mark has been known internationally for many years - based on the significant sales of its products and services (including the provision of insurance services), the widespread publicity the Marks have received, and the widespread consumer use of the Marks.
- The Domain Name is similar to the Mark because it incorporates the Mark in its entirety combined with the descriptive/generic word INSURANCE. The similarity of the Domain Name and the Mark is heightened by the fact that the term INSURANCE describes services offered by the Complainant under the Mark.
- The registration of the Domain Name constitutes an Abusive Registration under Nominet's DRS Policy (the 'Policy'), in that the Respondent registered and now uses the Domain Name in a manner that takes unfair advantage of and which is unfairly detrimental to the Complainant's Rights in the Mark (for the reasons below).
  - First, the Respondent uses the Mark in the Domain Name and on the Website to advertise and/or offer directly competing motorcycle insurance services. The Respondent uses the Complainant's Marks in many places on the Website to identify the Complainant, all of which suggest that the Respondent is part of or affiliated with the Complainant.

For example, all pages of the Website prominently display the tag line "*No1 FOR HARLEY DAVIDSON INSURANCE!*". The home page states that "*Harley Davidson Bike Insurance is a website...*" and the "contact" page invites consumers to contact "*the Harley Davidson Insurance team.*" The "about-us" page invites users to call "*a member of the Harley Insurance team.*"

Such numerous uses of the Complainant's Marks in the Domain Name and/or on the Website to identify with the Respondent's own directly competing insurance business and services creates a likelihood of confusion, and will likely confuse users into mistakenly believing that the Respondent's activities are offered, authorised, sponsored by, or otherwise connected/affiliated with the Complainant.

- Second, the Domain Name was registered by the Respondent on the 2 January 2009; long after the Complainant began using the Mark for a wide array of motorcycle-related products and services, including insurance services, and long after the registration of the Marks. As such, the Respondent registered and now uses the Domain Name for the purpose of disrupting the Complainant's business: to divert web-users away from the Complainant's websites to the Website.

- Third, the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which correspond to well-known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern. For example, the Respondent has also registered the domain name KAWASAKI-INSURANCE.COM which incorporates the well-known third-party mark KAWASAKI.
- Lastly, the Respondent cannot demonstrate that the Domain Name is not an abusive registration under DRS Policy paragraph 4.a. In particular, the Respondent's misappropriation of the Mark in the Domain Name and use of the Domain Name to offer directly competing insurance services does not constitute a genuine offering of goods and/or services.

In addition, the Respondent has not been commonly known by the Domain Name or legitimately connected with a mark which is identical or similar to the Domain Name, and is not making legitimate non-commercial or fair use of the Domain Name.

**Respondent's response:**

5.2 No response to the Complaint was provided by the Respondent.

**6. Outstanding formal/procedural issues**

6.1 Although Nominet sent the Complaint to the Respondent as mentioned in paragraph 3 above, no response has been provided by the Respondent. As no exceptional circumstances have been raised by the Respondent as to why no response has been received, the Expert has proceeded to a Decision (as per paragraph 15 b. of the Nominet DRS Procedure (the 'Procedure')).

6.2 While noting paragraph 15 c. of the Procedure (which states that in such circumstances, the Expert will draw such inferences as he considers appropriate), the Expert has drawn no inferences from the Respondent's failure to respond in this case, and has based his Decision on the facts and evidence before him.

6.3 It is important to note that the Complainant does not automatically receive the remedy it has requested merely because the Respondent has not responded to the Complaint (see, for example, Nominet decision *equazen.co.uk* DRS 02735).

**7. Discussions and Findings**

*General*

7.1 To succeed the Complainant has to prove pursuant to paragraph 2 of the Policy that, on the balance of probabilities (that is, the Complainant's case is more likely than not to be the true version<sup>3</sup>):

*“(i) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and,*

*(ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration.”*

7.2 Addressing each of these limbs in turn:

*i) Complainant's Rights*

7.3 Paragraph 1 of Nominet's Policy defines 'Rights' as:

*“[...] rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;”*

7.4 The Complainant must have the Rights at the time of the complaint.

7.5 The Expert notes that, as referred to at paragraphs 4.2 to 4.5 above, the Complainant is the proprietor of a number of trade marks in respect of the name HARLEY, and through longevity in the market place, reputation and considerable sales (see paragraph 5.1) has developed considerable goodwill and reputation in the Mark (and also in the Name).

7.6 Further, and in agreement with the Complainant, on the balance of probabilities, the suffix "Insurance" does not sufficiently distinguish the Domain Name from the Mark/Name and should be discounted from the consideration of whether the Domain Name is identical or similar to the Complainant's Mark/Name.

7.7 Given those factors, as well as the fact that the requirement to demonstrate 'Rights' is not a particularly high threshold (Nominet appeal panel decision, *Seiko-shop* DRS 00248), the Expert considers that at the time of the Complaint, the Complainant had Rights in the Mark/Name, which is similar to the Domain Name. In concluding the above, the Expert has also disregarded the domain suffix 'co.uk'.

*ii) Abusive Registration*

7.8 The Expert has considered whether the Domain Name, in the hands of the Respondent, is an Abusive Registration as understood by Paragraph 2 a. ii. of the Policy.

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<sup>3</sup> <http://www.nominet.org.uk/disputes/drs/legalissues/>

7.9 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. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights;”*

7.10 In relation to (i) above – the Expert considers there was an Abusive Registration at the time the Domain Name was registered.

7.11 The Policy at Paragraph 3, sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Specifically, Paragraph 3 a. C. includes reference to circumstances indicating that the Respondent registered the Domain Name primarily: “*for the purpose of unfairly disrupting the business of the Complainant.*”

7.12 While it may be helpful to consider the Respondent’s intentions at the time he registered the Domain Name (or indeed in relation to his subsequent use of the Domain Name), as the Respondent has not replied to the Complaint, the evidence available to the Expert is that provided by the Complainant.

7.13 Given the goodwill and reputation in the Mark/Name, as described for example at paragraph 5.1 above and summarised at paragraph 7.5 above, and that the Respondent registered the Domain Name specifically to sell insurance for the Complainant’s motorcycles (see paragraph 7.19 below), the Expert agrees with the Complainant: the Respondent would have been aware of the Complainant and its Mark/Name at the time of his registration of the Domain Name in 2009.

7.14 On that basis, the Expert considers that the Respondent specifically chose the Domain Name in order to attract web-users, who were looking for the Complainant’s insurance services, to the Website: so that the Complainant’s potential customers would access the Website in the initial mistaken belief it was somehow connected to the Complainant and its business.

7.15 This is sometimes referred to as ‘initial interest’ confusion and is discussed further in relation to the Complaint at paragraphs 7.21 *et seq.* below.<sup>4</sup> Such confusion would mean that potential Complainant insurance customers might then browse on the Website and through the Respondent request a Harley-Davidson insurance quote/take a policy out; thereby depriving the Complainant of a potential sale.

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<sup>4</sup> For a discussion of this concept and recent case-law, please see the English High Court judgment in *OCH-ZIFF MANAGEMENT EUROPE LIMITED and others v OCH CAPITAL LLP and others* [2010] EWHC 2599 (Ch).

- 7.16 In this way, the Expert considers that such action took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.
- 7.17 In relation to (ii) above – the Expert considers there was an Abusive Registration through the use by the Respondent of the Domain Name.
- 7.18 The Policy sets out at Paragraph 3 (a) (ii) that:
- “[there may be evidence of an Abusive Registration if there are] Circumstances indicating that the Respondent is using [...] 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;”*
- 7.19 As evidenced by the Website print-outs provided to the Expert by the Complainant, the Respondent has used the Website to offer insurance brokerage services for Harley-Davidson motorbikes. Such services compete directly with the Complainant's affiliated insurance providers.
- 7.20 While the Expert notes that the Respondent sets out clearly on the Website's home page that his insurance services are not affiliated or endorsed by the Complainant, those accessing the Website initially would do so on the basis that it was affiliated with the Complainant.
- 7.21 In such circumstances, it does not matter that those accessing the Website would soon read on the Website's homepage that the Respondent is not connected with the Complainant. What is important in this context is that those accessing the Website would only have done so because of the Respondent's use of the Mark in the Domain Name i.e. web-users would initially think that the Complainant was the true owner of the Domain Name and Website.
- 7.22 The Expert considers that using the Domain Name in this way has taken unfair advantage of the Complainant's Rights by seeking to rely on the Complainant's goodwill and reputation in the Mark/Name to generate web traffic to the Website; diverting potential Complainant customers to a competitor.
- 7.23 For the reasons set out at paragraphs 7.21 above, the Expert does not consider that the Respondent's clear statements that the Website is not affiliated with the Complainant change this conclusion; the damage to the Complainant would already have been done by the initial confusion for the reasons previously mentioned.
- 7.24 Such use of the Domain Name is also unfairly detrimental to the Complainant for reasons previously mentioned; that the use of the Website described above would divert Internet traffic away from the Complainant's affiliated insurance websites, and the Complainant has lost possible sales income in this way.



7.25 Finally, in its submission that the Domain Name is an Abusive Registration, the Complainant also refers in substance to the factor set out at paragraph 3 (a) (iii) of the Policy in the Complaint, which states that:

*“[there may be evidence of an Abusive Registration if the] Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;”*

7.26 In support of this claim, the Complainant gives the Respondent’s registration of the domain name KAWASAKI-INSURANCE.COM (which it claims incorporates “the well-known third-party mark KAWASAKI”) as an example. However, the Complainant has only provided evidence of one registration, and the Expert does not consider this sufficient to show the necessary *pattern* of registrations (i.e. there is a link between that registration and the registration of the Domain Name).<sup>5</sup> Therefore, the Expert does not consider this argument relevant to the Complaint.

7.27 The Expert has considered whether there is evidence before him to suggest that any of the factors listed at Paragraph 4 of the Policy demonstrate that the Domain Name is not an Abusive Registration but does not consider any are relevant.

## **8. Decision**

8.1 Accordingly, the Expert finds, on the balance of probabilities, that the Complainant has Rights in a Name and Mark that are similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

**Signed** Dr Russell Richardson

**Dated** 14 September 2011

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<sup>5</sup> For further discussions on this issue, see Nominet Appeal Panel decision in DRS 04884 (*maestro.co.uk*).