Decision for dispute CAC-UDRP-102157

Case number	CAC-UDRP-102157
Time of filing	2018-09-17 10:13:20
Domain names	frenchopenlivetv.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	FEDERATION FRANCAISE DE TENNIS (FFT)

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Biswas, Jyotirmoy

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks containing the expression “FRENCH OPEN”, including:

- The International trademark n° 538170 FRENCH OPEN® registered since June 22, 1989;
- The International trademark n° 732452 ROLLAND GARROS FRENCH OPEN® registered since April 17, 2000.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Founded in 1920, the FEDERATION FRANCAISE DE TENNIS (the Complainant) promotes, organizes and develops tennis in France. It counts about 1,018,721 licensees in 2017. The Complainant also provides representation of France in international meetings and organizes major tournaments such as the International of France at Roland Garros.

The International of France of Roland Garros is the biggest tournament of the tennis season on clay and the only Grand Slam still competing on that surface.

In the tennis world with an Anglophone majority, the tournament is also known as the “French Open” since 1968, the first year of the Open era. It is one of the four Grand Slam tournaments, the second in the calendar after the Australian Open in January. The Complainant also sells the TV rights for the whole tournament to selected official and exclusive broadcasters all around the world.

The Complainant is the owner of numerous trademarks containing the expression “FRENCH OPEN”.

The Complainant has also registered numerous domain names including the trademark FRENCH OPEN®, such as:

- <frenchopen.org> registered since April 9, 1996;
- <frenchopen.com> registered since December 17, 1997;
- <myfrenchopen.com> registered since March 21, 2014;
- <rollandgarrosfrenchopen.com> registered since November 20, 2014;
- <parisfrenchopen.com> registered since April 13, 2015;

The Disputed Domain Name was registered on May 27, 2018.

The Disputed Domain Name points to a website displaying information regarding the French Open Tournament, with sentences such as “FRENCH OPEN® LIVE TV” and “Watch French Open Tennis Live Streaming Online Free”.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. Confusing similarity

The Complainant contends that the Disputed Domain Name is confusingly similar to the Complainant’s international trademark FRENCH OPEN®, as the Disputed Domain Name includes in its entirety the above-mentioned trademark.

The addition of the generic terms "LIVE” and “TV" to the trademark FRENCH OPEN® and the use of the gTLD ".COM" are not sufficient elements to escape the finding that the Disputed Domain Name is confusingly similar to the international trademark FRENCH OPEN®.

It is well-established that “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP”. Indeed, when a distinctive trademark is paired with non-distinctive terms, the combination will typically be found to be confusingly similar to the distinctive trademark.

Therefore, the Disputed Domain Name is confusingly similar to the Complainant’s trademark.

2. No rights or legitimate interest

The Complainant asserts that the Respondent is not known by the Disputed Domain Name, but as “BISWAS, JYOTIRMOY”. Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the Disputed Domain Name.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and he is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark FRENCH OPEN®, or apply for registration of the Disputed Domain Name by the Complainant.

The Disputed Domain Name points to a website displaying information regarding the French Open Tournament, with sentences such as “FRENCH OPEN® LIVE TV” and “Watch French Open Tennis Live Streaming Online Free”. There also links to watch the tournament live and a copy of the Complainant’s logo and trademark ROLAND GARROS®.

It is suggest that the Respondent aims to offer live streaming of the tournament. However, it is restricted by the Complainant, which has chosen selected official and exclusive broadcasters all around the world on different supports, like television and internet. The Complainant contends that the Respondent is not an authorized broadcaster. Therefore, the Respondent has registered and used the Disputed Domain Name only in order to create a likelihood of confusion with the Complainant and its trademarks in order to attract internet users by taking an advantage with the use of the Complainant’s trademark FRENCH OPEN® in the Disputed Domain Name, associated with the terms “LIVE” and “TV” in direct relation with the broadcasting of the French Open Tournament, therefore creating a likelihood of confusion.

Thus, the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

3. Registered and used in bad faith

The Complainant contends that the Disputed Domain Name is confusingly similar to its international trademark FRENCH OPEN®. Previous UDRP Panel have stated regarding the Complainant that the “Complainant’s [French Open] trademark is widely known, and, further, that it is therefore highly unlikely that the Respondent was unaware of the Complainant’s trademark when registering the Disputed Domain Name”. Please see for instance WIPO Case No. 2016-0354, Federation Francaise De Tennis v. Mahesh Shaksena, <frenchopen2016livex.com>.

Thus, given the distinctiveness of the Complainant’s trademark and reputation, and the use of the Complainant’s logo and trademarks FRENCH OPEN® and ROLAND GARROS® on the website, the Complainant can state that the Respondent has registered the Disputed Domain Name with full knowledge of the Complainant's trademark FRENCH OPEN® and uses it for the purpose of misleading and diverting Internet traffic.

Indeed, a Google search on the expression FRENCH OPEN® displays several results, all of them being related to the Complainant. Furthermore, the Disputed Domain Name display websites with information related to an unauthorized live stream of the tournament. It seems therefore hardly conceivable that the Respondent did not register the Disputed Domain Name without the intention to create a likelihood of confusion with the Complainant’s trademarks, and therefore unduly benefit from the reputation of the Complainant’s trademarks.

Therefore, the Disputed Domain Name was registered and is being used in bad faith.

RESPONDENT:

No administratively compliant Response was filed.

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).

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).

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).

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.

PRINCIPAL REASONS FOR THE DECISION

As per paragraph 4(a) of the Policy, for the Complaint to succeed in relation to the Disputed Domain Name, the Complainant must prove the following:

(i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and

(iii) The Disputed Domain Name has been registered and is being used in bad faith.

Since in this case, the Respondent failed to produce a Response, the Panel may treat as uncontested the Complainant's factual assertions. The Panel will now turn to review each of these elements.

A. Identical or Confusingly Similar

The Complainant has established its rights in the trademark "FRENCH OPEN" through evidence on record since at least 1989. Furthermore, the Complainant provided evidence showing the trademark is widely-known and has achieved recognition through its use.

Turning now to the second part of the analysis of the first element, we now must turn to determine if the Disputed Domain Name is confusingly similar to the Complainant's trademarks. For this, the Panel notes that the Disputed Domain Name incorporates the entirety of the trademark, namely "FRENCHOPEN", with the addition of "LIVETV". This additional text is composed of two parts, namely "LIVE" and "TV", both of which are commonly used in relation to broadcasting; broadcasting being one of the main channels for exploiting the sporting event known as the "French Open" which is associated to the trademark owned by the Complainant. This fact reinforces the conclusion that the additional text is of secondary importance to the main element of the Disputed Domain Name, namely "FRENCHOPEN". Based on this, and the evidence on record, the Panel finds that the additional text is not enough to dispel the confusing similarity between the Disputed Domain Name and the Complainant's trademark, as contained under paragraph 1.8 of WIPO Overview 3.0.

The Panel therefore finds that the Complaint has satisfied the first element set under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Complainant states that the Respondent is not affiliated to the Complainant nor has the Complainant granted authorization to the Respondent to make any use of the Complainant's trademark. Additionally, the Complainant asserts that it does not carry out any activity for, nor has any business links with the Respondent. In the view of the Panel, these assertions are sufficient to establish a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name (see 2.1 of WIPO 3.0 Overview).

Given that there is no available evidence on record that would otherwise allow the Panel to find any rights or legitimate interests for the Respondent in the Disputed Domain Name and the fact that the Respondent failed to provide any evidence to refute the Complainant's prima facie showing under the second element, the Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Respondent, in failing to reply to the Complainant's contentions has not rebutted such prima facie case.

Weighing the evidence on record, it appears that the Respondent has registered the Disputed Domain Name in order to

create a likelihood of confusion with the Complainant while tarnishing the Complainant's trademark and benefit financially from it. This fact does not justify a finding of Rights or Legitimate Interests in favor of the Respondent.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and therefore the Complainant has fulfilled the second requirement set under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The evidence on record indicate that the Respondent was, at the very least, aware of the Complainant and targeted the Complainant's trademarks when registering the Disputed Domain Name in order to obtain a financial gain by benefiting from the likelihood of confusion. The Panel notes that a presumption of bad faith is justified being that the Complainant's trademark is widely-known, as per paragraph 3.1.4 of WIPO Overview 3.0. More so, the Respondent seems to be actively engaging in conducts that encompass the scope of bad faith activities contained in the indicative list under paragraph 4(b)(iv) of the Policy.

Accordingly, the Panel finds that the Complainant has satisfied the last element required under paragraph 4(a)(iii) of the Policy.

D. Decision

For the aforestated reasons and in accordance with the provisions contained under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transferal of the Disputed Domain Name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **FRENCHOPENLIVETV.COM**: Transferred

PANELLISTS

Name	**Rodolfo Carlos Rivas Rea**

DATE OF PANEL DECISION 2018-10-14

Publish the Decision