Decision for dispute CAC-UDRP-102158

Case number	CAC-UDRP-102158
Time of filing	2018-09-17 10:10:06
Domain names	frenchopenlivefree.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	MD ABDULLAH AL MUKTADIR

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it is the owner of certain trademark registrations that consist of or contain the mark FRENCH OPEN (the "FRENCH OPEN Trademark"), including Int'l Reg. No. 538,170 for the mark FRENCH OPEN (registered June 22, 1989).

FACTUAL BACKGROUND

Complainant states that it was founded in 1920 and "promotes, organizes and develops tennis in France" and "provides representation of France in international meetings and organizes major tournaments such as the International of France at Roland Garros," which is also known as the "French Open" since 1968.

The disputed domain name was created on May 13, 2018, and is being used in connection with a website that is "offering live streaming services, with sentences such as 'Watch French Open 2018 Live Stream Online FREE' and 'Access your favorite French Open Championship 2018 Live Events from anywhere'." However, Complainant states that "Respondent is not an authorized broadcaster."

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i) of the Policy: Complainant states that the disputed domain name is confusingly similar to the FRENCH OPEN Trademark because, inter alia, the disputed domain name "includes in its entirety" the FRENCH OPEN Trademark and "[t]he addition of the generic terms 'LIVE' and 'FREE' 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®."

Paragraph 4(a)(ii) of the Policy: Complainant states that Respondent has no rights or legitimate interests in respect of the disputed domain name because, inter alia, "Respondent is not known as the disputed domain name"; Respondent "is not related in any way with the Complainant" and "does not carry out any activity for, nor has any business with the Respondent"; "[n]either licence 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"; and by offering live streaming services in connection with the disputed domain name, "Respondent has registered and used the disputed domain name only in order to create a likelihood of confusion with the Complainant and its trademarks."

Paragraph 4(a)(iii) of the Policy: Complainant states that the disputed domain name was registered and is being used in bad faith because, inter alia, "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…, 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."

PARTIES CONTENTIONS

No administratively compliant response has been 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

Identical or Confusingly Similar

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the FRENCH OPEN Trademark.

As to whether the disputed domain name is identical or confusingly similar to the FRENCH OPEN Trademark, the relevant comparison to be made is with the second-level portion of the disputed domain name only (i.e., "frenchopenlivefree") because "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard

registration requirement and as such is disregarded under the first element confusing similarity test." WIPO Overview 3.0, section 1.11.1.

Here, the disputed domain name contains the FRENCH OPEN Trademark with the addition of the two words "live" and "free." As set forth in section 1.7 of WIPO Overview 3.0, "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing." Further, section 1.8 of WIPO Overview 3.0 states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

Accordingly, the Panel finds that Complainant has proven the first element of the UDRP.

Rights or Legitimate Interests

Complainant states that Respondent has no rights or legitimate interests in respect of the disputed domain name because, inter alia, "Respondent is not known as the disputed domain name"; Respondent "is not related in any way with the Complainant" and "does not carry out any activity for, nor has any business with the Respondent"; "[n]either licence 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"; and by offering live streaming services in connection with the disputed domain name, "Respondent has registered and used the disputed domain name only in order to create a likelihood of confusion with the Complainant and its trademarks."

WIPO Overview 3.0, section 2.1, states: "While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the Policy.

Registered and Used in Bad Faith

Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the Policy: (i) circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

As a previous panel wrote in a proceeding also involving the FRENCH OPEN Trademark and multiple domain names that were associated with a website that "purported to provide information about the French Open tournament, including an invitation to 'Tennis TV Live streaming'," : "The use which has been made of each of the disputed domain names has clearly

been commercial in character and reliant upon the reputation of the Complainant's trade marks to attract Internet users to the websites to which the disputed domain names resolve. That use has been made without the license or authority of the Complainant. This conduct falls squarely within paragraph 4(b)(iv) of the Policy." This Panel finds that the same reasoning applies here.

Accordingly, the Panel finds that Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **FRENCHOPENLIVEFREE.COM**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2018-10-22

Publish the Decision