Decision for dispute CAC-UDRP-103323

Case number	CAC-UDRP-103323
Time of filing	2020-10-02 08:56:51
Domain names	rolandgarros.online

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	Golam Muktadir Risan

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

Complainant has submitted evidence that it owns the following trademark registrations:

- ROLAND GARROS, International Trademark Registration No. 459517 dated April 1, 1981;

- RG ROLAND GARROS, International Trademark Registration No. 1370730 dated January 24, 2017.

FACTUAL BACKGROUND

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

The Complainant was founded in 1920 and it promotes and develops the game of tennis in France. It also organizes major tennis tournaments such as the International of France (also known as the “French Open”) at Roland Garros stadium. A number of trademark registrations are owned by the Complainant for the trademark ROLAND GARROS and it also owns the domain name <rolandgarros.com> which resolves to a website providing tennis news, ticket sales, and video content related to tennis and tennis players.

The disputed domain name <rolandgarros.online> was registered on September 27, 2020 and resolves to a website displaying an image of a tennis player and the header “Watch French Open Live Online For Free”.

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

A. The disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant owns the ROLAND GARROS trademark for a wide range of goods and services including the organization of famous tennis tournaments such as the French Open at a stadium bearing the name of the trademark. The Complainant has submitted into evidence printouts from the WIPO.int website displaying details of two registrations for this trademark. The Complainant also hosts its main website at <rolandgarros.com>. The Panel finds that the Complainant has demonstrated its ownership of trademark rights in the phrase ROLAND GARROS for purposes of paragraph 4(a)(i) of the Policy.

The disputed domain name contains the entirety of the ROLAND GARROS trademark and adds only the “.online” TLD. Where the second level of a domain name consists entirely of an identical copy of a complainant’s trademark, panels have held that this satisfies the requirements of paragraph 4(a)(i) of the Policy. Deutsche Lufthansa AG v. REDACTED FOR PRIVACY et al., FA 1827553 (FORUM Feb. 14, 2019) (“Given the addition of the .blog TLD to the famous LUFTHANSA mark, consumers will expect that Complainant is the owner of the blog and responsible for any content on the site” at the <lufthansa.blog> domain name). As reasoned in the Deutsche Lufthansa decision, even if those who encounter the disputed domain eventually discover that it is not owned by the Complainant, they may nevertheless be led to believe that the Complainant has endorsed, sponsored or affiliated itself with activities carried out using the domain name.

Finally, the top-level extension “.online” does not avoid confusion with the Complainant’s trademark here. Walgreen Co. v. Imagebyme / Loraine Simpson, FA 1899372 (FORUM July 10, 20200 (“The gTLD ‘.online’ does not serve to prevent confusing similarity between the Domain Name and the Complainant’s mark.”) Rather, this TLD may serve to increase confusion by conveying the message to users that the disputed domain name is a resource by which they may access the Complainant’s products and services online. Rheem Manufacturing Company v. WhoisGuard, Inc. / Gabriella Garlo, D2020-2115 (WIPO Oct. 8, 2020) (in relation to the domain name rheem.support, the Panel noted that “the gTLD ‘.support’, a relatively new extension and indicative of the online location of a business’ customer support page will, if anything, enhance the risk of confusion amongst Internet users and of them being misled.”).

In view of the evidence presented, the Panel holds that the Complainant has satisfied paragraph 4(a)(i) of the Policy because the disputed domain name is identical or confusingly similar to the Complainant's trademark.

B. The Respondent has no rights or legitimate interests in respect of the disputed domain name

Paragraph 4(c) of the Policy sets out certain circumstances which, if proven by the evidence presented, may demonstrate a respondent's rights or legitimate interests in respect of a domain name.

The Respondent is using the disputed domain name to resolve to a page that contains a photograph of a tennis player in mid-stroke with a stadium crowd visible in the background. The words "Watch French Open Live Online For Free" appear above the photo and there are "Watch Now" and "Create Free Account" links prominently featured on the page. When one of these links is clicked the user is brought to a different website at which the user is invited to register by entering their e-mail address and creating a password. The creation of a page that seeks to provide unauthorized broadcasts of a complainant's video services is not bona fide under the Policy. Cable News Network, Inc. v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Vitalii Yuhimyuk, D2018-2099 (WIPO Oct. 30, 2018) (the disputed <cnnlivestream.com> "website carried a live stream of the Complainant's broadcasting content as well as similar content from the Complainant's competitors."). The Respondent has filed no Response or made any other submission in this case to explain its actions and so, the Panel finds, on the basis of the Complainant's evidence and undisputed contentions, that the Respondent's offer to display video of one of the Complainant's tennis tournaments is not a bona fide offering of goods or services under paragraph 4(c)(i) of the Policy.

Next, the Complainant states that the Respondent has not been authorized to use the Complainant's trademark, either as a domain name or in any other way. Further, there is no evidence before this Panel to suggest that the Respondent is commonly known by the disputed domain name or that it has any trademark rights associated with the name "Roland Garros" under paragraph 4(c)(ii) of the Policy. The Registrar for the disputed domain name has identified the Respondent as "Golam Muktadir Risan" and so this also provides no support for a defense under paragraph 4(c)(ii) of the Policy.

Finally, the Complainant has made a prima facie case that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name without intent for commercial gain as set out in paragraph 4(c)(iii) of the Policy. Although the website claims to offer users the ability to view video for free, it does not appear that the disputed domain name and its resulting website are referring to the Complainant's trademark in a purely nominative or other classic fair use manner such as for the purpose of commentary, news reporting, grievance, education, or the like. Rather, the site appears to be offering video that infringes on the copyright of the Complainant and perhaps others or it may offer no video at all but use the offer thereof as a means to gather e-mail addresses, passwords, and perhaps other information from users. In any event, the Respondent has not rebutted the Complainant's prima facie case and its use does not appear to be non-commercial or to fit within the parameters of paragraph 4(c)(iii) of the Policy.

In light of the evidence presented, the Panel finds that the Complainant has made an unrebutted prima facie case that satisfies paragraph 4(a)(ii) and of the Policy and so the Panel concludes that no evidence has been presented to show that the Respondent has rights or legitimate interests in the disputed domain name.

C. The disputed domain name was registered and is being used in bad faith

In order to prevail in this dispute, paragraph 4(a)(iii) of the Policy requires that a Complainant prove that the disputed domain name has both been registered and is being used in bad faith.

The Complainant asserts that the Respondent registered the disputed domain name with actual knowledge of its trademark rights. It states that its trademark has become well-known and, in support thereof, it has submitted screenshots of an internet search for the phrase ROLAND GARROS in which the results refer exclusively to the Complainant, its tennis

tournaments, and the eponymous stadium. The Panel further notes that the submitted registrations for the Complainant's trademark date back to 1980. These facts, combined with the composition of the disputed domain name and its unambiguous reference to the French Open tennis tournament which is organized by the Complainant, leads this Panel to the conclusion that the Respondent registered the disputed domain name with actual knowledge of the Complainant's trademark. It has been held in prior decisions that such activity can form the basis upon which to build a finding of bad faith domain name registration. 7-Eleven, Inc. v. charles rasputin, FA 1829082 (FORUM Mar. 9, 2019) (in relation to the domain name 7elevendelivered.com and others, "Respondent had actual knowledge of Complainant's rights in the 7 ELEVEN mark at the time of registering the infringing domain names. Actual knowledge of a complainant's rights in a mark prior to registering a confusingly similar domain name can evince bad faith under Policy 4(a)(iii).").

As for use, the Complainant has submitted evidence that the disputed domain name resolves to a page claiming to offer an unauthorized livestream of the Complainant's famous tennis tournament. Such activity has been held to demonstrate bad faith use of a domain name that is confusingly similar to a complainant's trademark. In Pilgrim Films and Television, Inc. v. Nikola Pesic a/k/a Home, FA 1236018 (FORUM Jan. 20, 2009), the domain name <ghosthuntersepisodes.com> resolved to a website "that depicts Complainant's marks and logos and allows Internet users to view streaming videos of Complainant's television episodes." The Panel found that the "Respondent's use of the disputed domain name to offer unauthorized viewings of Complainant's television shows supports an inference that Respondent receives some form of material gain by this unauthorized use. The Panel therefore finds that Respondent registered and is using a disputed domain name in bad faith under Policy 4(b)(iv)…" Under similar facts, and in accordance with paragraph 4(b)(iv) of the Policy, the Panel finds that the disputed domain name has been used in bad faith as it creates a likelihood of confusion with the Complainant's trademark, offers to display the Complainant's copyrighted video, and resolves to a website that redirects users to another site where they are asked for their email addresses, passwords, and perhaps other personal information. Despite use of the word "free" on the Respondent's website, this action appears to be for the commercial gain of either the Respondent or of a third-party entity to whose website users of the disputed domain name are brought. In Focus Do It All Group v. Athanasios Sermbizis, D2000-0923 (WIPO Oct. 12, 2000), the Panel found that "[I]t is enough that commercial gain is being sought for someone" for a use to be commercial.

Finally, it is noted that the Respondent uses a WHOIS privacy shield to hide its identity. Although use of a privacy or proxy registration service is not in itself an indication of bad faith, the manner in which such service is used can in certain circumstances constitute a factor indicating bad faith. Beijing Qunar Information Technology Co., Ltd. v. Premium Registration Service / Zheng ZhongXing, D2013-0281 (WIPO Apr. 24, 2013) ("the fact that the disputed domain name was registered anonymously and protected by Premium Registration Service is consistent with bad faith in this Panel's view"). Taking into account all of the circumstances of this case, the Respondent's shielding of its identity suggests that its motive has been to increase the difficulty for the Complainant of identifying the Respondent and this further supports a finding of bad faith registration and use of the disputed domain name.

In light of the above, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) of the Policy and that the disputed domain name has been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ROLANDGARROS.ONLINE**: Transferred

PANELLISTS

Name	**Steven M. Levy, Esq.**

DATE OF PANEL DECISION 2020-10-26

Publish the Decision