Decision for dispute CAC-UDRP-103690

Case number	CAC-UDRP-103690
Time of filing	2021-03-25 10:05:41
Domain names	rolandgarros2021.com, rolandgarros2022.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	Augustine Sanchez

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 names.

IDENTIFICATION OF RIGHTS

Founded in 1920, the FEDERATION FRANCAISE DE TENNIS (the Complainant) promotes, organizes and develops tennis in France. It counts nearly 1 million licensees in 2019. 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, also called “French Open”, is the biggest tournament of the tennis season on clay and the only Grand Slam still competing on that surface.

The Complainant is the owner of numerous trademarks containing the expression “ROLAND GARROS”, such as:

- the international trademarks ROLAND GARROS® n°459517 registered since April 1, 1981;

- the French trademark ROLAND GARROS n° 1351529 registered since February 2, 1986;

- the international trademark RG ROLAND GARROS® n° 1370730 registered since January 24, 2017.

The Complainant has also registered numerous domain names including the trademark ROLAND GARROS®, such as <rolandgarros.com> registered since April 21, 1999 and <roland-garros.com> registered since April 22, 1997.

The disputed domain names have been registered on May 28, 2019 and resolve to a parking page with commercial links.

FACTUAL BACKGROUND

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

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”. See WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin.

The Complainant refers to several prior panel decisions:- Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> (“Here, the WHOIS information of record identifies Respondent as “Chad Moston / Elite Media Group.” The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).”);

- Forum Case No. FA 699652, The Braun Corporation v. Wayne Loney;

- Forum Case No. FA 970871, Vance Int’l, Inc. v. Abend (concluding that the operation of a pay-per-click website at a confusingly similar domain name does not represent a bona fide offering of goods or services or a legitimate noncommercial or fair use, regardless of whether or not the links resolve to competing or unrelated websites or if the respondent is itself commercially profiting from the click-through fees);

- WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe ("Respondent’s use of a domain name confusingly similar to Complainant’s trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use.");

- WIPO Case No. D2017-1045, Federation Francaise De Tennis (FFT) v. WhoisGuard Protected, WhoisGuard, Inc. / Md Rubel Hossain (“The French Open tournament and its venue at the Roland Garros Stadium have been widely publicised in print, radio and television media throughout the world. The trade marks FRENCH OPEN and ROLAND GARROS are not names which would be likely to be chosen at random and without an intended reference to the Complainant’s trade marks. It is not credible therefore that the Respondent might innocently have chosen to register any of the disputed domain names.”);

- CAC Case No. 101242, FEDERATION FRANCAISE DE TENNIS (FFT) v. Real James (“Given the reputation of the Complainant’s trademark, it seems implausible that the Respondent did not have such trademark in mind when registering the disputed domain name.”);

- WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC (“In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolve […] so the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith.”).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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).

The addition of the years “2021” or “2022” is not sufficient to escape the finding that the disputed domain names are confusingly similar to the trademark ROLAND GARROS®. It does not change the overall impression of the designations as being connected to the Complainant’s trademark ROLAND GARROS®. It does not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademark and domain names associated.

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” (WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin).

Moreover, the Complainant asserts that the addition of the generic Top-Level Domain suffix “.COM” does not change the overall impression of the designations as being connected to the trademark ROLAND GARROS®. It does not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademarks and its domain names associated.

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 names (within the meaning of paragraph 4(a)(ii) of the Policy).

The Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use his trademarks in a domain name or on a website. The Complainant does not carry out any activity for, nor has any business with the Respondent.

BAD FAITH

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

Past panels have held that the ROLAND GARROS trademark is well-known. For instance:

- WIPO Case No. D2017-1045, Federation Francaise De Tennis (FFT) v. WhoisGuard Protected, WhoisGuard, Inc. / Md Rubel Hossain (“The French Open tournament and its venue at the Roland Garros Stadium have been widely publicised in print, radio and television media throughout the world. The trade marks FRENCH OPEN and ROLAND GARROS are not names which would be likely to be chosen at random and without an intended reference to the Complainant’s trade marks. It is not credible therefore that the Respondent might innocently have chosen to register any of the disputed domain names.”);

- CAC Case No. 101242, FEDERATION FRANCAISE DE TENNIS (FFT) v. Real James (“Given the reputation of the Complainant’s trademark, it seems implausible that the Respondent did not have such trademark in mind when registering the disputed domain name.”).

Consequently, given the distinctiveness of the Complainant's trademarks and its reputation, it is reasonable to infer that the Respondent has registered and used the disputed domain names with full knowledge of the Complainant's trademark.

Moreover, the disputed domain names resolve to a parking page with commercial links. The Panel agrees with the Complainant's contentions that the Respondent thereby attempts to attract Internet users for commercial gain to his own websites thanks to the Complainant’s trademarks for its own commercial gain, which is an evidence of bad faith.

For instance WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC (“In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolve […] so the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith.”).

Based on these findings the Panel finds that the disputed domain names were registered and are being used in bad faith.

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

1. The three essential issues under the paragraph 4(a) of the Policy are whether:

i. the 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 with respect to the domain name; and

iii. the domain name has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the disputed domain names, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel therefore came to the following conclusions:

a) The Complainant states and proves that the disputed domain names are confusingly similar to its trademarks and its domain names. Indeed, the trademark is partially incorporated in the disputed domain names.

The disputed domain names are therefore deemed identical or confusingly similar.

b) The Respondent is not generally known by the disputed domain names and have not acquired any trademark or service mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainant to use or register the disputed domain names.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain names.

c) It is clear that the Complainant's well-known trademarks and website(s) were used by the Complainant long time before the disputed domain names were registered and that the disputed domain names must have been registered in bad faith. The disputed domain names resolve to a parking page with commercial links which cannot be considered a bona fide offering of goods or services or legitimate non-commercial or fair use. It is concluded that the Respondent makes bad faith use of the disputed domain names.

The Panel therefore finds that the disputed domain names have been registered and are being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ROLANDGARROS2021.COM**: Transferred
2. **ROLANDGARROS2022.COM**: Transferred

PANELLISTS

Name	**Lars Karnoe**

DATE OF PANEL DECISION 2021-05-03

Publish the Decision