

Decision for dispute CAC-UDRP-105507

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| Case number | CAC-UDRP-105507 |
| Time of filing | 2023-06-12 11:24:46 |
| Domain names | liverpoolfclegends.com |

Case administrator

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| Name | Olga Dvořáková (Case admin) |
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Complainant

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| Organization | The Liverpool Football Club and Athletics Grounds Limited |
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Complainant representative

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| Organization | Stobbs IP |
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Respondent

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| Name | Lin Ming Zhao |
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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

The Complainant is the proprietor of numerous domain name registrations and trademark registrations including the terms Liverpool, Football Club, or FC, such as e.g.:

- EUTM 007024565 LIVERPOOL FC registered on 22-05-2009 in classes 06, 18, 21, 24 and 25;
- UKTM 907024565 LIVERPOOL FC registered on 22-05-2009 in classes 06, 18, 21, 24 and 25.

FACTUAL BACKGROUND

The Complainant is a professional football club based in Liverpool, United Kingdom. The club was founded in 1888 and is now one of the most widely supported football clubs in the world. It had established itself as a major force in English and European football in the 1970s and 1980s. During these years, it secured eleven League titles and four European Cups. The club won two further European Cups in 2005 and 2019, the latter leading the club to a nineteenth League title in 2020, the club's first during the Premier League era.

The Complainant jointly owns the company LiverpoolFC.TV Ltd alongside Granada Media plc, who are the largest company in the United Kingdom within the commercial television sector, and who have been licensed by the Complainant to utilise the Complainant's trade marks and brand online since the early 2000s. The domain name <liverpoolfc.tv> had been used for the purposes of a website at www.liverpoolfc.tv since as early as 2000, serving as the official website for the Complainant at the time, and which provides news,

statistics and other information on the club, as well as selling match tickets and club merchandise.

In 2002, the Complainant began to utilise the domain name <liverpoolfc.com> as its primary website for the club, initially as a redirect to www.liverpoolfc.tv, and then as a website at www.liverpoolfc.com in its own right. Based on website traffic analysis made available for period April 2021 – September 2021, www.liverpoolfc.com generates an average 7.8 million visitors every month, from various locations worldwide, and almost half of all visits originating from United Kingdom based internet users.

The Complainant's business and brand has partnered and collaborated with a variety of household names over the years, which include: Standard Chartered, Nike, Axa, Expedia, Carlsberg, EA Sports and Cadbury.

The Complainant's brand has a variety of revenue streams. In 2018/2019, the club earned approximately 299.3 million euros from broadcasting. The commercial revenue stream is the second largest, amounting to 210.9 million euro in 2018/2019, and 243.4 million in 2019/2020, and includes revenue generated from the sale of sport clothing and other branded merchandise. These goods are predominantly being offered and sold via the Complainant's main website at www.liverpoolfc.com and via other authorised merchants and online outlets.

The disputed domain name <liverpoolfclegends.com> was registered on 13 June 2022.

PARTIES CONTENTIONS

The Complainant submits that the requirements of the Policy have been met and that the disputed domain name should be transferred to it. The Complainant makes a number of legal arguments (referenced below) and also supplies a set of annexes providing evidence of its activities and of the Respondent's use of the disputed domain names.

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

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

- (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.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three

elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS AND SIMILARITY

The Complainant has established rights in the name LIVERPOOL FC. The disputed domain name <LIVERPOOLFCLEGENDS.COM> is found to be confusingly similar to the Complainant's trademarks. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of:

- a) disregarding the top-level suffix in the domain names (i.e. ".com") in the comparison, and
- b) finding that the simple combination of a trademark and a nondistinctive generic term such as "legends", which would be considered descriptive of many of the famous football players who have played and are playing for the Complainant and even for some of its managers such as the current incumbent by the Complainant's fans in particular and the wider public in general, would by no means be considered sufficient to distinguish a domain name from a trademark.

The disputed domain name is therefore found to be confusingly similar to the earlier rights in the name LIVERPOOL FC and the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such a prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant and the Respondent have never had a previous relationship, nor has the Complainant ever granted the Respondent with any rights or license to use the LIVERPOOL FC trademark in any form, including in the disputed domain name.

The disputed domain name is being used to facilitate gambling content and betting content and claims to facilitate first deposit bonus schemes relating to various sporting events. Neither the disputed domain name nor its content has in any way been authorized by the Complainant and operates outside of the network of any licensed partners. The Website is also displayed as "Not Secure", indicative that it exists vulnerable to cyber threats, including malware and cyberattacks. Further the disputed domain name promotes the services of the website. Specialist threat profiling searches on the Other Site reveal indicators of phishing. On this basis, the Complainant submits that the disputed domain name has been registered and is being utilised with malicious intent.

In the past, it has consistently been found that using domain names for illegal activity (in this case phishing) is highly evident of illegitimate intent.

In light of the above, there are no indicators of the disputed domain name being used in any way which may be seen as connected with services or goods which are bona fide. As such, the Respondent cannot claim a defence under this part of the Policy.

The Respondent never appears to have been known or acted as "LIVERPOOL FC". The registration of the distinctive mark within the disputed domain name, which is an indicator of trade origin of the Complainant, and the Complainant alone, leads to the conclusion that the only reason for the registration of the disputed domain name was to take advantage of the Complainant's goodwill and valuable reputation. No other logical or reasonable conclusion can be gleaned.

Nothing about the disputed domain name suggests a legitimate non-commercial or fair use of it. The disputed domain name is connected to a website promoting gambling and lottery services and further promotes third party services such as FIFA. The Respondent is using the reputation of the Complainant for personal gain, and banking on the trust internet users hold towards the name LIVERPOOL FC, as a means of misleading them towards alternative online content, which in itself holds evidence of being malicious and dangerous to even speculative users.

The Panel therefore concludes that the Respondent did not refute the Complainant's prima facie case and has not established any rights or legitimate interest in the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith.

The LIVERPOOL FC trademark as well as the trading and commercial activities of the business, significantly pre-date the registration of the disputed domain name in 2022. At the time of registration of the disputed domain name, the LIVERPOOL FC brand had widespread global recognition, supported by various worldwide news commentary, fan sites, social media activity, endorsements, collaborations, and partnerships. Indeed, a simple check on any of the most commonly used Internet search engines would have revealed the Complainant's LIVERPOOL FC brand and business.

No other explanation for registering a combination of the trademark of the Complainant together with generic terms as a domain name than the Respondent's actual knowledge of the Complainant's LIVERPOOL FC brand before and at the time of the registration appears even remotely feasible. In view of the worldwide recognition of the Complainant's LIVERPOOL FC brand, there is no plausible reason that the Respondent could have had for registering the disputed domain name.

The disputed domain name was registered with the sole purpose of creating an association with the Complainant.

The Panel therefore concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **liverpoolfclegends.com**: Transferred

PANELLISTS

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| Name | Udo Pfleggar |
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DATE OF PANEL DECISION 2023-07-21

Publish the Decision