

Decision for dispute CAC-UDRP-105579

Case number	CAC-UDRP-105579
Time of filing	2023-07-04 22:44:15
Domain names	liverpoolfctoken.live, lfctoken.live

Case administrator

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

Complainant

Organization	The Liverpool Football Club and Athletics Grounds Limited
--------------	---

Complainant representative

Organization	Stobbs IP
--------------	-----------

Respondent

Name	Thomas Morado
------	---------------

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

The Complainant bases its Complaint on several trademark registrations:

Trademark: LIVERPOOL FC

Reg. No.: 007024565

Territory for protection: European Union trademark

Filing date: June 30, 2008

Registration date: May 22, 2009

Classes: 6, 18, 21, 24, 25

Trademark: LIVERPOOL FOOTBALL CLUB

Reg. No.: 005232053

Territory for protection: European Union trademark

Filing date: July 31, 2006

Registration date: August 28, 2008

Classes: 6, 9, 14, 16, 18, 24, 25, 28, 32, 36, 41

Trademark: LFC

Reg. No.: 2027743

Territory for protection: United Kingdom

Filing date: July 19, 1996

Registration date: July 20, 1995

Classes: 14, 16, 18, 21, 24, 25, 28

FACTUAL BACKGROUND

PRELIMINARY ISSUE:

According to the Rules for Uniform Domain Name Dispute Resolution Policy, a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

In this case, the complaint relates to two domain names, <liverpoolfctoken.live> and <lfctoken.live>, that have the same registrant, according to the information received from the registrar of these two domain names.

The Panel agrees that the complaint is receivable as a single one for both disputes domain names.

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.

The Complainant owns several trademark registrations that include the denominations LIVERPOOL FC, LIVERPOOL FOOTBALL CLUB, LFC.

The Complainant also owns several domain names that include the denomination LIVERPOOL FC, among which <liverpoolfc.tv>, <liverpoolfc.com>, <liverpoolfc.co.uk>, <liverpoolfc.co.uk 4>, <liverpoolfc.net>, <liverpoolfc.com.au>, <liverpoolfc.eu>, all of which predate the registration of the Disputed Domain Names.

The disputed domain name <liverpoolfctoken.live> has been registered on June 22, 2023, while <lfctoken.live> has been registered on June 21, 2023 and such have been used, according to the evidences filed by the Complainant in this file, to facilitate a scam activity, whereby content has been posted on the Complainant's official Facebook account directing users to a link promoting cryptocurrency fan tokens. The website listed on the post was www.lfctoken.live. Following this, another post was submitted, this time, pointing users to the website www.liverpoolfctoken.live. Further, the websites www.lfctoken.live and www.liverpoolfctoken.live, according to the evidences filed by the Complainant in this file, appear to reveal phishing, malware and spam capabilities.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant's contentions are the following:

The disputed domain names <liverpoolfctoken.live> and <lfctoken.live> are confusingly similar to the Complainant's earlier trademarks LIVERPOOL FC and LFC, that the Respondent has no rights or legitimate interests in respect of the disputed domain names and that the disputed domain names were registered and are being used in bad faith.

RESPONDENT:

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).

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).

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).

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. Confusing Similarity

The Panel agrees that the disputed domain names <liverpoolfctoken.live> and <lfctoken.live> incorporates the Complainant's earlier LIVERPOOL FC and LFC trade marks in their entirety, and the addition of the term 'token' is not sufficient to escape the finding that the domain names are confusingly similar to the earlier trademarks LIVERPOOL FC and LFC.

Moreover, the extension ".live" is not to be taken into consideration when examining the similarity between the Complainant's trademarks and the disputed domain names (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as ".live" is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, L'Oréal v Tina Smith, WIPO Case No. D2008-0820 Titoni AG v Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

2. Lack of Respondent's rights or legitimate interests

The complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Based on the available evidence, the Respondent is not commonly known by the disputed domain names. The Complainant has never authorised the Respondent to make use of its trademarks, nor of a confusingly similar trademark in the disputed domain names.

Also, the Respondent has registered the disputed domain names much later after the registration Complainant's LIVERPOOL FC and LFC trade marks. Based on the evidences provided by the Complainant, the Respondent have used the disputed domain names, to facilitate a scam activity, whereby content has been posted on the Complainant's official Facebook account directing users to a link promoting cryptocurrency fan tokens. The website listed on the post was www.lfctoken.live. Following this, another post was submitted, this time, pointing users to the website www.liverpoolfctoken.live. Further, the websites www.lfctoken.live and www.liverpoolfctoken.live, according to the evidences filed by the Complainant in this file, appear to reveal phishing, malware and spam capabilities, as identified by specialist threat profiling searches.

The Panel notes that the Respondent had an opportunity to comment on the Complainant's allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

3. Bad Faith

Based on the filed evidence, 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.

The Complainant owns several earlier LIVERPOOL FC and LFC trade marks.

Therefore, the Panel concludes that at the time of registration of the disputed domain names, the Respondent was well aware of the Complainant's LIVERPOOL FC and LFC trade marks and has intentionally registered the domain names <liverpoolfctoken.live> and <lfctoken.live> in order to benefit from the reputation of the Complainant's previous trade marks.

In the present case, the following factors should be considered:

- (i) the Complainant's LIVERPOOL FC and LFC trade marks, which are earlier rights, are highly distinctive;
- (ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain names;
- (iii) the Respondent registered the disputed domain names containing LIVERPOOL FC and LFC trademarks in their entirety, trademarks which are highly distinctive;
- (iv) the Respondent has no business relationship with the Complainant, nor was ever authorised to use domain names similar to the Complainant's trade marks;
- (v) the disputed domain names seem to be used to facilitate a scam activity. The Respondent is thus, attempting to create a likelihood of confusion as to the source, sponsorship, affiliation and/or endorsement of the disputed domain names by making use of Complainant's LIVERPOOL FC and LFC marks without authorization, and using such marks to refer directly to Complainant.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain names in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **liverpoolfctoken.live**: Transferred
2. **lfctoken.live**: Transferred

PANELLISTS

Name	Delia-Mihaela Belciu
------	-----------------------------

DATE OF PANEL DECISION **2023-08-17**

Publish the Decision
