

Decision for dispute CAC-UDRP-105994

Case number	CAC-UDRP-105994
Time of filing	2023-11-23 10:08:47
Domain names	rolexparismaster.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	FEDERATION FRANCAISE DE TENNIS
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Organization	Fundacion Comercio Electronico
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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 owner of French trademark registration no. 4355167 for "TENNIS PARIS MASTERS", registered on April 18, 2017.

The Complainant has registered the domain name <rolexparismasters.com> on July 27, 2017.

The Respondent registered the disputed domain name on November 15, 2023. Currently, the disputed domain name resolves to a parked webpage containing commercial links.

FACTUAL BACKGROUND

The Complainant, Federation Francaise De Tennis was established in France and promotes, organizes and develops tennis in France. Founded in 1920, the Complainant has more than 1.1 million licensees as of 2023. The Complainant also provides representation of France in international meetings and organizes major tournaments such as the International of France at Roland Garros (The French

Open, A.K.A Roland-Garros).

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a complainant to show that a domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns the trademark registration of the TENNIS PARIS MASTERS mark.

In this case, the disputed domain name contains the “PARIS MASTERS” portion of the Complainant’s trademark with the addition of the prefix “rolex”. For the record, the prefix “rolex” refers to the well-known registered trademark of Rolex SA or another entity affiliated with Rolex SA. In the present case, it also refers to the name of an annual tennis tournament managed by the Complainant, the Rolex Paris Masters. It is well-established that where the complainant’s trademark is recognizable within the disputed domain name, the addition of other third-party marks is insufficient in itself to avoid a finding of confusing similarity to the complainant’s mark under the first element. (see WIPO Overview 3.0, section 1.12).

Administratively, this Complaint has been brought by a single complainant. The trademark owner of the ROLEX trademark is not a party to this proceeding. The complaint may include evidence of Rolex’s consent to file the case, and request that any transfer order may be issued in favor of the filing complainant only. Here, absent such consent any order to transfer of the domain name will be issued without prejudice to Rolex’s rights. (see WIPO Overview 3.0, section 1.12).

In addition, the disputed domain name comprises “PARIS MASTERS” portion of the Complainant’s trademark and the generic Top-Level Domain (“gTLD”) “.com”. It is well established that the addition of a gTLD “.com” does not avoid confusing similarity between the Complainant’s trademark and the disputed domain name (see WIPO Overview 3.0, section 1.11.1).

Consequently, the Panel finds that the Complainant has shown that the disputed domain name is confusingly similar to a trademark in

which the Complainant has rights.

B. Rights or Legitimate Interests

Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the disputed domain name (see WIPO Overview 3.0, section 2.1).

In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant has provided evidence that it owns trademark registrations of the TENNIS PARIS MASTERS mark long before the date that the disputed domain name was registered and that it is not licensed or otherwise authorised the Respondent to use the Complainant's trademark.

The Complainant also provided evidence that the Respondent is not commonly known by the disputed domain name. See WIPO Overview 3.0, section 2.3. The Complainant has not consented to the use of its TENNIS PARIS MASTERS trademark, or part thereof, in the disputed domain name.

It is noted that the disputed domain name resolves to a parking page containing what appear to be Pay Per Click ("PPC") links, purporting to offer goods and/or services competing with the offerings of the Complainant. Past panels have held that such use of a domain name cannot amount to any bona fide offering of goods or services, or legitimate non-commercial fair use.

Further, the Respondent did not submit a Response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain name which would be sufficient to rebut the Complainant's prima facie case.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant must also show that the respondent registered and is using the disputed domain name in bad faith (see Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant provided evidence that the disputed domain name resolves to a parking page containing commercial, presumably, PPC links.

Further, the disputed domain name incorporates the Complainant's trademark with the addition of the ROLEX trademark. The Panel finds that this is an attempt by the Respondent to confuse and/or mislead Internet users seeking or expecting the Complainant. Given that the TENNIS PARIS MASTERS mark and the ROLEX mark are highly distinctive, it is unlikely that the Respondent was not aware of the Complainant prior to the registration of the disputed domain name.

Previous UDRP panels ruled that in such circumstances "a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from the Complainant's site to the Respondent's site" (see *Edmunds.com, Inc v. Triple E Holdings Limited*, WIPO Case No. D2006-1095). Past UDRP panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users. (See WIPO Overview 3.0, section 2.9).

Further, the Complainant has submitted evidence which shows that the Respondent registered the disputed domain name long after the Complainant registered the TENNIS PARIS MASTERS trademark. Given the evidence presented to the Panel, the Panel finds that it is highly likely that the Respondent was aware of the Complainant and its TENNIS PARIS MASTERS trademark at the time of registering the disputed domain name and specifically targeted the Complainant and its goodwill.

Moreover, the Respondent failed to submit a response and did not provide any explanation for registering the disputed domain name not evidence of good-faith use. The Panel finds that under the specific circumstances of this case, it is also implausible that the Respondent could put the disputed domain name into a good faith use.

Accordingly, given the particular circumstances of this case, the reputation of the Complainant's trademark, and based on the evidence presented to the Panel, including (1) the registration of the disputed domain name long after the registration of the Complainant's trademark, (2) the incorporation of the Complainant's trademark together with another famous trademark in the disputed domain name, (3) the reputation of the Complainant in the TENNIS PARIS MASTERS trademark, and, (4) the failure of the Respondent to submit a response, the Panel draws the inference that the disputed domain name was registered and is being used in bad faith.

Accordingly, having regard to the circumstances of this particular case, the Panel finds that the Complainant has met its burden under paragraph 4(a)(iii) of the Policy.

Given that the disputed domain name also includes the name/mark of ROLEX and absent consent therefrom to this proceeding, the Panel's order of transfer of the disputed domain name to the Complainant is without prejudice to the rights of Rolex SA, or such owner of the ROLEX trademark.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **rolexparismaster.com**: Transferred

PANELLISTS

Name	Jonathan Agmon
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DATE OF PANEL DECISION	2024-01-05
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Publish the Decision