Decision for dispute CAC-UDRP-105995

Case number	CAC-UDRP-105995
Time of filing	2023-11-22 10:07:46
Domain names	storeliverpoolfc.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	The Liverpool Football Club and Athletics Grounds Limited

Complainant representative

Organization	Stobbs IP

Respondent

Name	Tran Luong

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 several trademarks bearing “LIVERPOOL FOOTBALL CLUB”, “LIVERPOOL FC” and “LFC”, such as the European trademark “LIVERPOOL FC” – Reg. No 007024565 – registered on May 22, 2009.

The Complainant is also the owner of the domain name <LIVERPOOLFC.COM> and other domain names containing the term Liverpool FC.

FACTUAL BACKGROUND

The Complainant is one of the most widely supported professional football clubs in the world. The club was founded in 1888 and is based in Liverpool, United Kingdom. To date, the club has won nineteen league titles, seven FA Cups, a record eight League Cups and fifteen FA Community Shields. In international club competitions, the club has won six European Cups, more than any other English football club, three UEFA Cups, four UEFA Super Cups and one FIFA Club World Cup.

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 trademarks 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. Aside from <LIVERPOOLFC.TV> and <LIVERPOOLFC.COM>, the Complainant owns various other domain names comprising of the LIVERPOOL FC term, which stem back to as early as 1996.

The Complainant's internet presence can thus be traced back over 20 years, the <LIVERPOOLFC.CO.UK> domain having been registered within less than a decade of the inception of the domain name infrastructure of the late 1980s. The Complainant's significant internet presence under the LIVERPOOL FC name is further demonstrated by a variety of social media accounts acquired and registered under handles "@liverpoolfc". These accounts have generated a substantial fan following, with over 18 million followers on Twitter, 33 million on Instagram, and over 40 million on Facebook.

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 has been registered by the Respondent on December 22, 2022.

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

As the Respondent did not file an administratively compliant Response, pursuant to paragraph 14(b) of the Rules, the Panel may

draw such inferences therefrom as it considers appropriate. Thus, the Panel accepts the contentions of the Complainant as admitted by the Respondent.

1. The disputed domain name is confusingly similar to the trademark “LIVERPOOL FC” of the Complainant.

The Complainant has, to the satisfaction of the Panel, shown that it has valid rights for the trademark “LIVERPOOL FC”.

The disputed domain name includes the Complainant's trademark in its entirety.

Also, the addition of a descriptive term is not sufficient to distinguish the domain name from the trademark. In fact, the word "STORE" accurately describes a big part of the business operated by the Complainant.

Furthermore, the addition of the gTLD suffix “.COM” is not sufficient to escape the finding that the domain name is confusingly similar to the Complainant's trademark and does not change the overall impression of the designation as being connected to the trademark of the Complainant.

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name within the meaning of the Policy.

The Complainant has established a prima facie proof that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not a licensee of the Complainant nor has the Complainant granted any permission or consent to use its trademark in a domain name.

Also, the disputed domain name at stake does not correspond to the name of the Respondent and he is not commonly known as “LIVERPOOL FC”. The mere registration of the domain name is not sufficient to establish rights or legitimate interests within the meaning of paragraph 4(a)(ii) of the Policy (Vestel Elektronik Sanayi ve Ticaret AS v. Kahveci. D2000-1244).

Summarised, there is no evidence for a use of the disputed domain name for any bona fide offer of goods or services or a legitimate non-commercial or fair use.

3. The disputed domain name has been registered and is being used in bad faith within the meaning of the Policy.

The Complainant’s trademark “LIVERPOOL FC” is widely known. Given the distinctiveness of the Complainant's trademark and reputation, it can be concluded that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. This is also indicated by the fact that the trademark "LIVERPOOL FC" and the commercial and business activities of the Complainant's company clearly predate the registration of the disputed domain name. This shows that the Respondent must have been aware of the trademark.

The use of the logo of the Complainant and the offering of services of the Complainant's business shows that the Respondent was fully aware of the reputation of the Complainant's trade mark and the association with it. This also shows that by registering the disputed domain name, he is exploiting the reputation of these trade marks by redirecting internet users searching for the Complainant's products to his own commercial website. In other words, the Respondent has deliberately sought to attract Internet users to its website for commercial purposes by creating a likelihood of confusion with the Complainant's trade mark.

Finally, the website does not contain a disclaimer indicating that the Respondent is not affiliated with the Complainant. The website therefore gives the impression that it is authorised by the Complainant. Such a deliberate likelihood of confusion is also evidence of bad faith in the registration and use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **storeliverpoolfc.com**: Transferred

PANELLISTS

Name	**Dominik Eickemeier**

DATE OF PANEL DECISION 2024-01-10

Publish the Decision