Decision for dispute CAC-UDRP-106543

Case number	CAC-UDRP-106543
Time of filing	2024-05-17 10:28:08
Domain names	canalfootball.club

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	GROUPE CANAL +

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	Domain Name Privacy Inc

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 has demonstrated ownership of rights in the trademark CANAL FOOTBALL CLUB for the purposes of standing to file a UDRP complaint.

In particular, the Complainant is the owner of trademark registrations for CANAL FOOTBALL CLUB, including the following:

- International trademark registration No. 1005878 for CANAL FOOTBALL CLUB (word mark), registered on December 15, 2008, duly renewed and covering goods and services in classes 9, 16, 35, 38 and 41;

- French trademark registration No. 3584437 for CANAL FOOTBALL CLUB (word mark), registered on June 25, 2008, duly renewed and covering goods and services in classes 9, 16, 28, 35, 38 and 41.

The Complainant also refers to ownership over the domain name <canalfootballclub.com> that incorporates its CANAL FOOTBALL CLUB trademark, and which is registered since June 24, 2008.

FACTUAL BACKGROUND

The Complainant is the French audiovisual media group and it is very active in the field of production of pay-TV and theme channels

and bundling and distribution of pay-TV services. According to the Complainant, it is active in over 40 countries, with 26,4 million subscribers worldwide and its revenue in 2023 amounts to 6.058 million euros.

The Complainant also produces and broadcasts a show dedicated to football called "CANAL FOOTBALL CLUB". This TV show was created in 2008 and it is broadcasted weekly on the French channel “CANAL+”.

The disputed domain name was registered on May 24, 2023 and it currently resolves to a parking page with sponsored links (pay-per-click links or PPC links). According to the Complainant, at the time of filing of the complaint, the disputed domain name redirected to various pornographic websites or parking pages with commercial links.

PARTIES CONTENTIONS

The Complainant contends that all 3 UDRP elements are establish in the present case. In particular, the Complainant argues that the disputed domain name is confusingly similar to its CANAL FOOTBALL CLUB trademark, since the use of the terms “CANAL” and “FOOTBALL” as a second-level portion of the disputed domain name is likely to create a risk of confusion with the Complainant's services. Furthermore, the Complainant underlines that the combination of second-level portion of the disputed domain name "CANAL FOOTBALL" with the new gTLD ".club" increases the likelihood of confusion, since it reproduces the Complainant’ trademark CANAL FOOTBALL CLUB in its entirety.

Regarding the second UDRP element, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name and it is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark, or apply for registration of the disputed domain name by the Complainant. To the best of the Complainant’s knowledge, the Respondent did not either apply for or obtained any trademark registration related to the sign CANAL FOOTBALL CLUB. Also, the Respondent is not commonly known under the disputed domain name. Finally, the Complainant underlines that use of the disputed domain name for redirection to various pornographic websites indicates neither a bona fide offering of goods or services under paragraph 4(c)(i) of the Policy, nor a non-commercial or fair use pursuant to paragraph 4(c)(iii) of the Policy.

With respect to the third UDRP element, the Complainant holds that its CANAL FOOTBALL CLUB trademark is well-known in the field of football television content and that the TV show with the same name has been broadcasted on French "Canal+" since 2008, i.e. long before the Respondent has registered the disputed domain name. The combination of the words "CANAL" and "FOOTBALL" and its association with the new gTLD ".club" cannot be fortuitous. The Respondent, therefore, could not have ignored the Complainant’s CANAL FOOTBALL CLUB trademark at the moment of the registration of the disputed domain name. Regarding the use of the disputed domain name in bad faith, the Complainant contends that use of the disputed domain name for redirection to various pornographic websites or parking pages with commercial links cannot be observed as the use in good faith. Furthermore, the Complainant also contends that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or of a product or service on the Respondent’s website or location in accordance with paragraph 4(b)(iv) of the Policy.

No administratively compliant response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to a trademark 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 the 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 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy stipulates that the complainant must prove each of the following:

i. that the disputed domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
ii. that the respondent has no rights or legitimate interests in respect of the disputed domain name; and
iii. that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name, as stipulated in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("WIPO Overview 3.0").

The Complainant has shown rights in respect of the CANAL FOOTBALL CLUB trademark for the purposes of the Policy (WIPO Overview 3.0, section 1.2.1).

Previous UDRP panels have consistently held that the applicable Top Level Domain ("TLD") in a domain name (eg, ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (WIPO Overview 3.0, section 1.11.1).

However, there are some limited circumstances, where as part of a holistic review of the facts, it may be appropriate to "span the dot" and consider the TLD relevant for establishing the first UDRP element (see, for example, Société des Produits Nestlé SA v. Boris Postolov , WIPO Case No. D2023-0212 related to the domain name <nes.cafe> and Bayerische Motoren Werke AG v. Living By Blue Co. , WIPO Case No. DMW2015-0001, related to the domain name <b.mw>). The same is also confirmed under section 1.11.3 of WIPO Overview 3.0: Where the applicable TLD and the second-level portion of the domain name in combination contain the relevant trademark, panels may consider the domain name in its entirety for purposes of assessing confusing similarity (eg, for a hypothetical TLD ".mark" and a mark "TRADEMARK", the domain name <trade.mark> would be confusingly similar for UDRP standing purposes).

In the case at hand, the Panel finds that the disputed domain name contains CANAL FOOTBALL portion of CANAL FOOTBALL CLUB trademark as the second-level domain ("SLD") of the disputed domain name and CLUB portion of the same trademark as TLD. Therefore, the combination of SLD and TLD of the disputed domain name forms the CANAL FOOTBALL CLUB trademark in its entirety and consequently the Panel considers the disputed domain name to be confusingly similar to this trademark.

In accordance with the above, the Panel finds that the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

In particular, the Panel notes that there appears to be no relationship between the Respondent and the Complainant and that the Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's CANAL FOOTBALL CLUB trademark. There appears to be no element from which the Panel could infer the Respondent's rights and legitimate interests in the disputed domain name, or that the Respondent might be commonly known by the

disputed domain name.

The Panel also finds that the use of the disputed domain name for a parking page with pay-per-click links does not represent a bona fide offering having in mind that links in this case are related to football and therefore they compete with and capitalize on the reputation and goodwill of the Complainant's trademark and mislead Internet users (see section 2.9 of WIPO Overview 3.0).

Having in mind the above, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith (see WIPO Overview 3.0, section 3.2.1).

Regarding the registration of the disputed domain name in bad faith, the Panel holds that the Respondent had the Complainant in mind when registering the disputed domain name. Although the Complainant's CANAL FOOTBALL CLUB trademark consists of dictionary words, when these words are taken together, they make a distinctive combination, especially since word CANAL in this case is actually French word for "channel" (see Global Car Group Pte Ltd., Cars24 Services Private Limited v. Scott Simmons, ilearnProject, WIPO Case No. D2022-0445). Although word "canal" also exists in English language, it has completely different meaning (primarily duct or artificial waterway) which is in no way related to football and it would be rather difficult to imagine that the Respondent had the English meaning of the word "canal" in mind when registering the disputed domain name. In that sense, it seems rather unplausible that the Respondent has chosen this particular domain name under ".club" TLD without the Complainant's trademark in mind and without intent to target it.

It should be also borne in mind that the Complainant uses CANAL FOOTBALL CLUB trademark since 2008, which is 15 years before the registration of the disputed domain name. Therefore, it also seems unlikely that the Respondent could not be aware of the Complainant's trademark at the time of the registration of the disputed domain name.

Due to the above, the Panel finds that the disputed domain name has been registered in bad faith.

The Complainant argues that the disputed domain name used to redirect to various pornographic websites and quotes several prior UDRP decisions where such use manifestly implies bad faith. However, the Complainant has only provided one screenshot from the adult website without any additional evidence that there was indeed redirection from the disputed domain name to this website (such as various "redirection check" services available online). In order to confirm the Complainant's allegation, the Panel has performed limited factual research in accordance with general powers granted to the Panel under paragraphs 10 and 12 of the Rules (see, in particular, section 4.8 of WIPO Overview 3.0). The Panel was not able to confirm that there is or that there was any redirection of the disputed domain name to any website with adult content. Instead, the disputed domain name appears to resolve to a parking page with sponsored links (PPC page) which are predominantly related to football tickets.

Nonetheless, in Panel's view, even the current use of the disputed domain name for parking page with PPC links in combination with other circumstances of this case would not prevent the finding of bad faith. As mentioned above, the disputed domain name resolves to a parking page with PPC links related to football, meaning that they compete with and capitalize on the reputation and goodwill of the Complainant's trademark. Therefore, the Panel deems that by such use of the disputed domain name, the Respondent has intentionally attempted to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its website according to paragraph 4(b)(iv) of the Policy. This constitutes bad faith use of the disputed domain name.

The Panel finds that the disputed domain name has been both registered and is being used in bad faith, and consequently that the Complainant has established the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **canalfootball.club**: Transferred

PANELLISTS

Name	**Stefan Bojovic**

DATE OF PANEL DECISION 2024-06-26

DATE OF PANEL DECISION

Publish the Decision