

ADMINISTRATIVE PANEL DECISION

Groupe Go Sport v. Farhang Fanaei
Case No. DIR2022-0014

1. The Parties

The Complainant is Groupe Go Sport, France, represented Nameshield, France.

The Respondent is Farhang Fanaei, Iran (Islamic Republic of).

2. The Domain Name and Registrar

The disputed domain name <go-sport.ir> is registered with IRNIC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 12, 2022. On July 12, 2022, the Center transmitted by email to IRNIC a request for registrar verification in connection with the disputed domain name. On July 13, 2022, IRNIC transmitted by email to the Center its verification response confirming that:

- (a) the disputed domain name is registered with it;
- (b) the language of the registration agreement is English; and
- (c) the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .ir Domain Name Dispute Resolution Policy (the “Policy” or “irDRP”), the Rules for .ir Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .ir Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 14, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was August 3, 2022. On August 4, 2022, the Center notified the Respondent’s default.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on August 11, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant was established in France in 1979. It specialises in the distribution of sporting goods. Since it was founded, the Complainant has expanded substantially using the master franchise model. It expanded first into Poland in 1999 and subsequently around the world including in particular the Middle East.

The Complainant registered and has been using the domain name <go-sport.com> since September 28, 1997.

The Complaint includes evidence that the Complainant owns a number of registered trademarks for GO SPORT:

- (a) International Registration Number 523820 which has been registered since February 29, 1988 in respect of a fancy or stylized version of the trademark in respect of goods in International Classes 9, 25 and 28;
- (b) International Registration Number 910072, which has been registered since November 24, 2006 in respect of a range of goods and services in International Classes 9, 12, 18, 22, 25, 28, and 35. Amongst the countries designated in this international registration is Iran (Islamic Republic of);
- (c) International Registration Number 1221297 which has been registered since June 19, 2014 in respect of a range of retail services in International Class 35. Amongst the countries designated in this international registration is Iran (Islamic Republic of).

The disputed domain name was registered on October 24, 2017.

It appears that for some time the Respondent was a franchisee of the Complainant through an entity that entered into an agreement with the Complainant, although it is not clear from the Complaint if it was a master franchisee or franchisee (nor the exact relationship between the Respondent, and such entity).

In a cease and desist letter sent to the Respondent on May 18, 2022, the Complainant pointed out that the Respondent's position as a franchisee had been terminated and, consequently, it no longer had rights to use the Complainant's trademark. In its response to the cease and desist letter, the Respondent informed the Complainant that it had ceased its cooperation with the entity that entered into the agreement with the Complainant at the beginning of 2019. The Respondent continued using the disputed domain name, however, and, as confirmed by the Registry, the Respondent remains the registrant for the disputed domain name.

Notwithstanding the termination, the disputed domain name continued being used for a website promoting sports goods using the Complainant's trademark or a trademark confusingly similar to the Complainant's trademark. After the Complainant sent a cease and desist letter to the Respondent, the website was taken down but the Respondent has not otherwise responded to the Complainant's demands.

5. Discussion and Findings

No response has been filed. The Complaint and Notification of Complaint have been sent, however, to the Respondent at the electronic coordinates confirmed as correct by the Registry.

When a respondent has defaulted, paragraph 14(a) of the Rules requires the Panel to proceed to a decision on the Complaint in the absence of exceptional circumstances. Accordingly, paragraph 15(a) of the Rules

requires the Panel to decide the dispute on the basis of the statements and documents that have been submitted and any rules and principles of law deemed applicable.

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (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 or is being used in bad faith.

In view of the similarities between these requirements and the corresponding requirements under paragraph 4(a) of the Uniform Domain Name Dispute Resolution Policy (the “UDRP”), the Panel will apply the approaches to these requirements established under the UDRP where appropriate.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of the International Registrations identified in section 4 above including the registration for GO SPORT in block capitals alone.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See *e.g. Barry Callebaut AG and Barry Callebaut Belgium NV v Ali Davoodi*, WIPO Case No. [DIR2021-0012](#) and WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the country code Top Level Domain (“ccTLD”) component as a functional aspect of the domain name system. See *e.g. Walmart Inc. v. Payam Avarane Khorshid Co.*, WIPO Case No. [DIR2021-0004](#) and [WIPO Overview 3.0](#), section 1.11.

Disregarding the ccTLD, the disputed domain name consists of the Complainant’s registered trademark with a hyphen separating the two words. Such an addition can be disregarded as, apart from anything else, a “space” cannot be represented in a domain name. As this requirement under the Policy is essentially a standing requirement, therefore, the inclusion of the hyphen does not preclude a finding of (at least) confusing similarity and, given the insubstantiality of a hyphen in this context, arguably identity. See *e.g. Barry Callebaut AG and Barry Callebaut Belgium NV v Ali Davoodi*, WIPO Case No. [DIR2021-0012](#). Apart from anything else, the Complainant’s trademark remains visually and aurally recognisable within the disputed domain name.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is identical with or confusingly similar to the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g. *Deutsche Telekom AG v. Kaweh Kalirad*, WIPO Case No. [DIR2008-0002](#) and [WIPO Overview 3.0](#), section 2.1.

As it appears the Respondent was a franchisee, it is not clear whether the Respondent was initially authorised to register and use the disputed domain name. However, it is clear from the unchallenged allegations in the Complaint that whatever rights the Respondent may have had have been terminated and, accordingly, the Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent's name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. Further, from the available record, the Respondent does not appear to hold any trademarks for the disputed domain name.

The Respondent registered the disputed domain name after the Complainant began using its trademark and also after the Complainant had registered its trademark.

In addition, the use of the disputed domain name (which is almost identical to the Complainant's trademarks) to offer for sale goods falling within the scope of the Complainant's trademark rights after the termination of the rights as a franchisee does not qualify as a good faith offering of goods or services for the purposes of paragraph 4(c)(i).

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent, however, has not sought to rebut the *prima facie* case at all or otherwise advance any claimed entitlement. In particular, the Respondent has not sought to dispute the claimed termination of the franchise arrangement nor to claim some entitlement to continue using the disputed domain name or the trademarks in question. On the contrary, the Respondent took the website down following receipt of the cease and desist letter.

Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered or Used in Bad Faith

In contrast to the Uniform Dispute Resolution Policy, the Complainant must establish that the disputed domain name has been either registered or subsequently used in bad faith by the Respondent under the third requirement of the Policy. See e.g. *Deutsche Telekom AG v. Kaweh Kalirad*, WIPO Case No. [DIR2008-0002](#).

Generally speaking, a finding that a domain name has been registered or is being used in bad faith requires an inference to be drawn that the respondent in question has registered or is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

As at least so far as the record in this proceeding reveals, the Respondent has been a franchisee of the Complainant and so well aware of the Complainant and its trademark.

Whether or not the Respondent registered the disputed domain name with permission from the Complainant, the continued use of the disputed domain name after the (undisputed) termination of that relationship to sell sports goods by reference to the Complainant's trademark, or one confusingly similar to it, constitutes use in bad faith. That is not affected by the taking down of the website after the cease and desist letter. Moreover and in any event, the passive holding of the disputed domain name in these circumstances qualifies as use in bad faith also. See e.g. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Google, Inc. v. Mohammad Jabbari*, WIPO Case No. [DIR2005-0001](#).

Accordingly, the Complainant has established all three requirements under the Policy.

6. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <go-sport.ir> be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: August 25, 2022