

ADMINISTRATIVE PANEL DECISION

Television Francaise 1 v. Gilmore Thompson Case No. D2022-4442

1. The Parties

The Complainant is Television Francaise 1, France, represented by AARPI Scan Avocats, France.

The Respondent is Gilmore Thompson, United States of America.

2. The Domain Name and Registrar

The disputed domain name <tf1home.com> (the “Disputed Domain Name”) is registered with CloudFlare, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 21, 2022. On November 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 22, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent (DATA REDACTED) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 22, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on November 23, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 20, 2022.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on January 5, 2023. 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 founded in 1974 and operates the first and oldest television channel in France. In 1987, the Complainant became part of the TF1 Group, which includes several television channels, such as French Television 1 ("TF1"), as well as production and distribution companies for the film and television industries. The Complainant produces and broadcasts original TV programs in the fields of entertainment, current affairs, and fiction, and has been developing for several years its digital services on its online platforms, notably "MYTF1".

The Complainant is the owner of a large number of trademark registrations for the TF1 trademark including, *inter alia*, French Trademark Registration No. (84)1290436 for TF1, registered on November 22, 1984; French Trademark Registration No. (88)1489724 for TF1, registered on November 30, 1988; International Trademark Registration No. 556537 for TF1, registered on July 30, 1990; International Trademark Registration No. 1452572 for TF1 SÉRIES FILMS, registered on July 13, 2018 (the "Complainant's Trademark").

The Complainant's Trademark has been continuously used to promote its business through the official websites "www.tf1.fr" and "www.groupe-tf1.fr/en". The Complainant has thus obtained an exclusive right to the Complainant's Trademark through extensive use.

In addition, the Complainant is also the owner of several domain names including, <tf1.com>, registered on April 2, 1998; <tf1.fr>, registered on December 3, 1995; and <tf1.eu>, registered on March 9, 2006.

The Disputed Domain Name was registered on September 12, 2022 and is not currently linked to an active website.

5. Parties' Contentions

A. Complainant

The Complainant's primary contentions can be summarized as follows:

- (a) The Disputed Domain Name is identical or confusingly similar to the Complainant's Trademark. The Complainant's Trademark is reproduced in its entirety in the Disputed Domain Name. The only element which differentiates the Disputed Domain Name from the Complainant's Trademark is the addition of the generic term of "home" and the Top-Level Domain ("gTLD") ".com" to read <tf1home.com>.
- (b) The Respondent does not have any rights or legitimate interests in the Disputed Domain Name. There is no evidence to show that the Respondent is commonly known by the Disputed Domain Name. The Complainant does not know of the Respondent and confirms that the Respondent is not in any way related to its business, is not one of its distributors and does not carry out any activity for or has any business with it. The Complainant has never licensed, authorized, or otherwise permitted the Respondent to register a domain name incorporating the Complainant's Trademark, nor to make any use of the Complainant's Trademark.
- (c) Both the Respondent's registration and its use of the Disputed Domain Name establish the Respondent's bad faith. Given the reputation and the distinctive character of the Complainant's Trademark, the Respondent's registration of the Disputed Domain Name, which completely incorporates the Complainant's Trademark cannot be considered accidental, and is in itself an act of bad faith by someone with no legal connection to the Complainant's business.

Although the Disputed Domain Name is not currently linked to an active website, the passive holding of the Disputed Domain Name does not prevent a finding of the Respondent's bad faith, which is fully characterized by the well-known nature of the Complainant's Trademark and the configuration of MX servers on the Disputed Domain Name. Furthermore, the Respondent's masking of his personal information when registering the Disputed Domain Name is further confirmation of his bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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 and is being used by the Respondent in bad faith.

A. Identical or Confusingly Similar

The Panel accepts that the Complainant has rights in the Complainant's Trademark, based on its various trademark registrations listed above in Section 4.

It is well established that in making an enquiry as to whether a trademark is identical or confusingly similar to a domain name, the gTLD extension, ".com" in this case, may be disregarded. See Section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Disputed Domain Name incorporates the Complainant's Trademark in its entirety with the addition of the term "home". UDRP panels have consistently found that the addition of other terms to a mark (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not alter the fact that the domain name at issue is confusingly similar to the mark in question. See Section 1.8 of the [WIPO Overview 3.0](#).

The Panel therefore finds that the mere addition of the term "home" does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant's Trademark.

As such, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's Trademark, and accordingly, paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

The Panel accepts that the Complainant has not authorized the Respondent to use the Complainant's Trademark, and there is no relationship between the Complainant and the Respondent which would otherwise entitle the Respondent to use the Complainant's Trademark. Accordingly, the Panel is of the view that a *prima facie* case has been established by the Complainant and it is for the Respondent to show rights or legitimate interests in the Disputed Domain Name.

Once a complainant establishes a *prima facie* case in respect of the lack of rights or legitimate interests of a respondent in a disputed domain name, the respondent then carries the burden of production of

demonstrating that it has rights or legitimate interests in the domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See Section 2.1 of the [WIPO Overview 3.0](#).

The Respondent did not submit a Response. The fact that the Respondent did not submit a formal Response does not automatically result in a decision in favor of the Complainant. However, the Respondent's failure to file a Response may result in the Panel drawing appropriate inferences from such default. The Panel may also accept all reasonable and supported allegations and inferences flowing from the Complainant as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. [D2009-1437](#); and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#)).

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (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 was in connection with a *bona fide* offering of goods or services;
- (ii) the Respondent has been commonly known by the Disputed Domain Name, even if it 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.

There is no evidence to suggest that the Respondent's (non) use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name was in connection with a *bona fide* offering of goods or services. The Panel finds that the Respondent's registration and use of the Disputed Domain Name cannot be regarded as legitimate noncommercial or fair use, noting in particular that the Complainant's Trademark would not likely be adopted by the Respondent other than for the purpose of creating an impression that the Disputed Domain Name is associated with the Complainant or otherwise taking advantage of the goodwill of the Complainant's Trademark. In this regard, the Panel also notes the nature of the Disputed Domain Name, being identical or confusingly similar to the Complainant's Trademark, carries a high risk of implied affiliation. See Section 2.5.1 of the [WIPO Overview 3.0](#).

In addition, no evidence has been provided to prove that the Respondent has trademark rights corresponding to the Disputed Domain Name, or that the Respondent has become known by the Disputed Domain Name.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar to a widely-known trademark by an unaffiliated entity (particularly domain names which incorporate a mark plus a descriptive term) can already by itself create a presumption of bad faith. See Section 3.1.4 of the [WIPO Overview 3.0](#).

After reviewing the supporting evidence submitted by the Complainant, the Panel agrees with the Complainant that the Complainant's Trademark appears to be fairly well-known. A quick Internet search conducted by the Panel shows that the top search results returned for the keyword "TF1" are the Complainant's websites and third party's websites providing information relating to the Complainant's TV programs and entertainment business. Therefore, taking the Complainant's reputation and the distinctive character of the Complainant's Trademark into consideration together with the fact that the Disputed Domain

Name incorporates the Complainant's Trademark in its entirety with the addition of the term "home", the Respondent must have been aware of the Complainant and the rights in the Complainant's Trademark when registering the Disputed Domain Name.

The Panel considers that the lack of active use of the Disputed Domain Name cannot prevent a finding of bad faith under the doctrine of passive holding (see *TELEVISION FRANCAISE 1 v Julienne (Technologies Futures 1)*, WIPO Case No. [D2000-1589](#)). In particular, the following factors have already been considered relevant in applying the passive holding doctrine: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (the Panel notes that the address provided by the Respondent to the Registrar is that of a STAPLES office supply store), and (iv) the implausibility of any good faith use to which the domain name may be put (see section 3.3. of the [WIPO Overview 3.0](#)).

In the present case, the Panel finds that the following factors further support a finding that the Disputed Domain Name was registered and is being used by the Respondent in bad faith:

(i) The Respondent failed to respond to the Complainant's contentions and has provided no evidence of any actual or contemplated good faith use by it of the Disputed Domain Name.

(ii) It is difficult to conceive of any plausible use of the Disputed Domain Name that would amount to good faith use, given that the Disputed Domain Name contains the Complainant's Trademark in its entirety (with the addition of the term "home"). The evidence that the Disputed Domain Name is set up with MX servers suggests that the Respondent may use the Disputed Domain Name for email communications. Under these circumstances, the Panel considers there is a risk that the Respondent intended to use the Disputed Domain Name to support a potential fraudulent email scheme to impersonate the Complainant and extract personal or financial data from individuals who may believe that the communication comes from the Complainant.

In the circumstances, the Panel finds that the Respondent registered and has been using the Disputed Domain Name in bad faith, and paragraph 4(a)(iii) of the Policy has been satisfied.

7. 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, <tf1home.com> be transferred to the Complainant.

/Gabriela Kennedy/

Gabriela Kennedy

Sole Panelist

Date: January 18, 2023