

ADMINISTRATIVE PANEL DECISION

Formula One Licensing BV v. fan cao
Case No. D2022-4965

1. The Parties

The Complainant is Formula One Licensing BV, Netherlands, represented by Sheridans Solicitors, United Kingdom.

The Respondent is fan cao, China.

2. The Domain Name and Registrar

The disputed domain name <f1authentics.shop> is registered with Dynadot, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 23, 2022 including the disputed domain name and another domain name (which was removed in the amended Complaint). On December 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 26, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on December 28, 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 January 4, 2023 and removed another domain name from this proceeding.

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 January 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 27, 2023.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on February 2, 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 is part of a group of companies that operates a motor vehicle racing business concerning the F1 Championship, which was established in 1950 by the Federation Internationale de l'Automobile ("FIA"). The Complainant's group operates under the trademarks F1, FORMULA 1, FORMULA ONE, and other related word and figurative marks, which have been used worldwide since 1950 to identify the F1 Championship and related goods and services.

The Complainant owns numerous trademark registrations around the world for its brands, including:

- European Union Trademark Registration No. 003934387, F1, figurative, registered on November 17, 2005, in classes 9, 14, 16, 18, 25, 28, 39, 41, and 43; and
- International Trademark Registration No. 1398403, F1, figurative, registered on November 17, 2017, in classes 3, 4, 6, 8, 9, 11, 12, 14, 16, 18, 21, 25, 28, 30, 32, 33, 35, 36, 37, 38, 39, 41, 42, and 43, which designates, among many other jurisdictions, China, (collectively the "F1 mark").

Prior decisions under the Policy have recognized the well-known character of the F1 mark.¹

The Complainant and its group further own various domain names corresponding to the F1 mark, including <f1authentics.com> (registered on June 14, 2019), which resolves to its official online retail store, operated by an approved third party that offers merchandise and memorabilia related to the F1 Championship worldwide.

The disputed domain name was registered on June 24, 2022, and it resolves to a website, in the English language, that offers merchandise and memorabilia related to the F1 Championship. This website includes the Complainant's F1 logo at the top left-hand corner of its heading, within a red banner, as well as in its tab interface, and the F1 mark is prominently included within the content of the site. This website does not include any information about the provider of the site and/or the owner of the disputed domain name, identifying itself as "Cheap F1 Authentics Store", and it does not include any information about the lack of relationship of with the Complainant and its group. The copyright note of this website indicates, "Copyright 2023 © www.f1authentics.shop", and the "About Us" section indicates, "We are proud of the quality and consistency of the product and service provided to our customers and we are here to make your online shopping experience excellent. Our Cheap F1 Authentics Store, there is a great selection. With many years of experience in the direct relationship with the manufacturer's supplier and our customers, we always show our profession so that you can feel better when you shop here. [...]".

¹ See, among others, *Formula One Licensing BV v. Hyeongjeon, Gim*, WIPO Case No. [D2004-0210](#); *Formula One Licensing B.V. v. Holding Theunisse*, WIPO Case No. [D2008-1631](#); *Formula One Licensing B.V. v. Louis Theunisse*, WIPO Case No. [D2008-1633](#); *Formula One Licensing B.V. v. N/A*, WIPO Case No. [D2009-0217](#); *Formula One Licensing B.V. v. Holding Theunisse*, WIPO Case No. [D2009-0760](#); *Formula One Licensing B.V. v. H. Altun*, WIPO Case No. [D2009-1772](#); *Formula One Licensing B.V. v. Domains by Proxy, Inc., Crown Group International, -Protected -*, WIPO Case No. [D2011-1106](#); and *Formula One Licensing B.V. v. Privacy service provided by Withheld for Privacy ehf / Basit Ali*, WIPO Case No. [D2021-3215](#).

5. Parties' Contentions

A. Complainant

Key contentions of the Complaint may be summarized as follows:

The Complainant attempted to contact the Respondent through the online submission form of the website associated with the disputed domain name, and, on December 1, 2022, it sent a cease and desist communication via an email address found on the website linked to the disputed domain name, but no response was received. The Complainant further contacted the Registrar and the Police IP Crime Unit, but they were unable to resolve this issue.

The F1 mark enjoy substantial goodwill and reputation throughout the world. Third parties pay significant sums of money to be associated with the F1 mark, and the official online store at "www.f1authentics.com" has high traffic (with a total number of website visitors prior to the registration of the disputed domain name of 4.9 million users, and a current average number of daily visitors of 7,900 users and 11,758 sessions). The Complainant and its group maintain control over the use of the F1 mark; all its licensees must obtain written approval before using the mark with any goods or services, and with all related sales and marketing materials, including on websites, ensuring that the F1 mark is used in connection with only high quality goods and services.

The disputed domain name is confusingly similar to the F1 mark. The disputed domain name incorporates the well-known F1 mark, and the generic Top-Level Domain ("gTLD") is to be disregarded when assessing whether a domain name is identical or confusingly similar to a mark.

The Respondent has no rights or legitimate interests in the disputed domain name. There is no relationship between the Parties and the Respondent is not authorized to use the F1 mark. The disputed domain name and its associated website have not been set up for legitimate noncommercial or fair use purpose, but for commercial gain. The goods offered on the website associated with the disputed domain name are not authorized, and the Complainant is not aware of their source. The requirements set out by *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), for resellers or distributors making a *bona fide* offering of goods and services, are not met in this case. The Respondent's website does not indicate the lack of relationship with the Complainant and its group, it provides limited contact information (contact form and an email address), and the address listed on the "Contact Us" page does not exist. This site is apparently fraudulent, as it provides fake contact details so that consumers cannot contact the business other than a submission form. Additionally, the contact details in relation to the disputed domain name are hidden on the Whois. The disputed domain name is almost identical to the Complainant's official online store associated with the domain name <f1authentics.com>, which was registered and used about three years before the registration of the disputed domain name; and the Respondent's website reproduces the design of the Complainant's official online store.

The disputed domain name was registered and is being used in bad faith. The use and registration of the disputed domain name is an intentional attempt to attract, for commercial gain, users to the Respondent's website, by creating a likelihood of confusion with the F1 mark as to the source, affiliation and/or endorsement of the site or of the products on the site. The F1 mark was first used more than 60 years ago, and the Complainant's related authorized website ("www.f1authentics.com") was registered three years prior to the registration of the disputed domain name. The disputed domain name incorporates the F1 mark, the website associated with the disputed domain name prominently includes the F1 mark and reproduces the layout and trade dress of the Complainant's official online store at an almost identical domain name (<f1authentics.com>). The Respondent's website further incorporates the same IP notices that are included in the Complainant's official online store at "www.f1authentics.com", and provides fake contact details. The email address provided on the Respondent's website has been also included in a ring of other online shopping sites, corroborating a pattern of bad faith consisting of replicating well-known businesses and infringing their intellectual property rights. Some (if not all) of these websites are operated out of China.

The Complainant has cited previous decisions under the Policy as well as various sections of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)") that it considers supportive of its position, and requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material and allegations, and performing some limited independent research under the general powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules.

A. Identical or Confusingly Similar

The Complainant indisputably has rights in the registered trademark F1, both by virtue of its trademark registrations and as a result of its continuous use over more than 60 years, its global goodwill and reputation.

The disputed domain name incorporates this trademark in its entirety followed by the term "authentic", which does not avoid a finding of confusing similarity. The F1 mark is recognizable in the disputed domain name, and the gTLD ".shop" is a technical requirement, generally disregarded for the purpose of the analysis of the confusing similarity under the Policy. See sections 1.7, 1.8, and 1.11.1 of the [WIPO Overview 3.0](#).

Accordingly, this Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, and the first element of the Policy under paragraph 4(a)(i) has been satisfied.

B. Rights or Legitimate Interests

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is primarily if not exclusively within the Respondent's knowledge. Thus, the consensus view is that paragraph 4(c) of the Policy shifts to the Respondent the burden of production to come forward with relevant evidence of rights or legitimate interests in the disputed domain name, once the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, [WIPO Overview 3.0](#).

The Complainant's assertions and evidence effectively shift the burden to the Respondent of producing evidence of rights or legitimate interests in the disputed domain name, providing the circumstances of paragraph 4(c) of the Policy, without limitation, in order to rebut the Complainant's *prima facie* case. However, the Respondent has not replied to the Complainant's contentions, not providing any explanation or evidence of rights or legitimate interests in the disputed domain name.

Resellers or distributors using a domain name containing the complainant's trademark to undertake sales related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a right or legitimate interest in such domain name, if the following cumulative requirements are met:

- (i) the respondent must actually be offering the goods or services at issue;

- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

The analysis of these requirements is commonly known as the "Oki Data test" (referring to *Oki Data Americas, Inc. v. ASD, Inc.*, *supra*). See section 2.8, [WIPO Overview 3.0](#).

However, the Panel finds that these cumulative requirements are not met in this case. In this respect, the Panel notes that the disputed domain name is linked to a website that commercializes alleged F1 merchandising products and memorabilia related to the F1 Championship, which, according to the Complainant's allegations, have not been authorized; their origin is unknown and their authenticity is questionable. Furthermore, the Respondent's website does not disclose the lack of relationship with the Complainant and its group, and its lack of authorization to use the F1 mark. Rather, the Panel further notes that the content of the Respondent's website suggests an affiliation with the Complainant and/or its group, and with the F1 mark: i) including the F1 figurative mark (with the same graphic representation used and registered by the Complainant) at its heading and within its tab interface, common locations for the indications related to the website provider or the origin of the site; and ii) prominently including numerous references to the F1 mark in its content, as well as references to a long and continuous use of the F1 mark, which suggests an affiliation to the Complainant, its group and/or one of its authorized retailers.

The Panel further notes that the disputed domain name incorporates the F1 mark followed by a term ("authentic") that also points to the Complainant, its genuine F1 products, and its official online store that is associated with an almost identical domain name (<f1authentic.com>) including the same terms "f1" and "authentic". In this respect, the Panel, under its general powers, has further corroborated through the Internet archive WayBackMachine, that, according to the Complainant's allegations, the Complainant's official online store at "www.f1authentic.com" is been continuously used on the Internet since at least September 12, 2019.

The Panel, under its general powers articulated, *inter alia*, in paragraph 10 of the Rules, has further consulted the Complainant's official website at "www.f1authentic.com", and notes that the Respondent's website imitates the Complainant's official website layout or look and feel, using a similar design, combination of colors, and composition. Circumstances that may contribute, in the Panel's view, to generate a risk of confusion and association, giving the impression that the Respondent is affiliated to the Complainant or it is one of its official distributors/retailers.

All these circumstances lead the Panel to consider that the Respondent's use of the disputed domain name cannot be considered a *bona fide* offering of goods under the Policy.

It is further remarkable that the Respondent has not replied to the Complainant's cease and desist communication or to the Complaint, not providing any explanation connected to any of the circumstances included in paragraph 4(c) of the Policy or any other circumstance that may be considered as a right or legitimate interest in the disputed domain name.

All the above-mentioned circumstances lead the Panel to conclude that the Respondent has not produced evidence to rebut the Complainant's *prima facie* case, and lacks any rights or legitimate interests in the disputed domain name. Therefore, the second element of the Policy under paragraph 4(a)(ii) has been established.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(a)(iii), requires that the Complainant establish that the disputed domain name has been registered and is being used in bad faith.

The applicable standard of proof is, likewise, the “balance of probabilities” or “preponderance of the evidence”, being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, [WIPO Overview 3.0](#).

The Panel considers that all cumulative circumstances of this case point to bad faith registration and use of the disputed domain name:

- (i) the F1 mark is well known and internationally used for over 60 years, including in China where the Respondent is apparently located according to the Registrar verification;
- (ii) the F1 Championship has worldwide press coverage, and the merchandising and memorabilia related to the F1 Championship are globally commercialized;
- (iii) the disputed domain name incorporates the F1 mark followed by the term “authentic” related to the Complainant’s products and its official online store that it is associated with an almost identical domain name (<f1authentic.com>), which enhances the risk of confusion or implied association;
- (iv) the website linked to the disputed domain name includes prominently the F1 mark (with the same graphic representation used and registered by the Complainant) at its heading and within its tap interface, as well as in its content, and it reproduces the layout or look and feel of the Complainant’s official website at “www.f1authentic.com”; and
- (v) the Respondent has not offered any explanation of any rights or legitimate interests in the disputed domain name and has not come forward to deny the Complainant’s assertions of bad faith, choosing not to reply to the Complaint.

Therefore, on the balance of probabilities, taking into consideration the cumulative circumstances of this case, the Panel considers that the disputed domain name was registered targeting the Complainant and its trademarks with the intention of obtaining a free ride on their established reputation. The disputed domain name was registered and is being used to mislead Internet users into believing that there is a connection between the disputed domain name and the Complainant to increase the traffic of the Respondent’s site for commercial gain, which constitutes bad faith under the Policy.

The Panel further notes that, according to the Complainant’s allegations, the email address included on the website associated with the disputed domain name has also been included on other websites related to third parties.

All of the above-mentioned circumstances lead the Panel to conclude that the disputed domain name was registered and is being used in bad faith. Accordingly, the Panel concludes that the Complainant has met its burden of establishing that the Respondent registered and is using the disputed domain name in bad faith under the third element of the Policy.

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 <f1authentic.shop> be transferred to the Complainant.

/Reyes Campello Estebarez/

Reyes Campello Estebarez

Sole Panelist

Date: February 16, 2023