

ADMINISTRATIVE PANEL DECISION

Formula One Licensing BV v. Mary J Frazer
Case No. D2023-0077

1. The Parties

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

The Respondent is Mary J Frazer, Canada.

2. The Domain Name and Registrar

The disputed domain name <f1-authentic.shop> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 6, 2023. On January 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 9, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 7, 2023.

The Center appointed Taras Kyslyy as the sole panelist in this matter on February 14, 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 in the business of organizing motorsports racing events and providing related services. It owns, among other marks, the trademark F1, which it has registered in many jurisdictions, including, for instance Canadian trademark registration No. TMA699633, registered on October 29, 2007. The Complainant has used its marks around the world for several decades. The Complainant enters into licensing agreements with third parties, authorizing those parties to use the F1 mark and logo, including on websites. Merchandise bearing the Complainant's trademark is sold also at the original online store found at "www.f1authentics.com" authorized by the Complainant.

The disputed domain name was registered on September 19, 2022 and resolves to a website prominently featuring the Complainant's trademark, offering for sale goods bearing the Complainant's trademark and claiming to be "the authority on Formula 1® memorabilia, reimagining sporting goods, offering auctions and immediate purchases". The website at the disputed domain name has design similarities to the website of the original online store authorized by the Complainant.

5. Parties' Contentions

A. Complainant

The disputed domain name is identical or confusingly similar to the Complainant's trademark. The Complainant's well-known and distinctive trademark mark is incorporated into the disputed domain name in its entirety. The generic top-level domain ("gTLD") element is to be disregarded when assessing whether the disputed domain name is identical or confusingly similar to the Complainant's trademark. The term, "authentics" in the disputed domain name, is a descriptive term used to reference the types of memorabilia goods available on the website situated at the disputed domain name. Also, this same term is identical to the original authorized licensee's website "www.f1authentics.com", thus there is a very high likelihood that consumers would confuse the disputed domain name. The addition of the hyphen has no effect at reducing the similarities to the Complainant's trademark.

The Respondent has no rights or legitimate interests in the disputed domain name. There is no relationship, connection or affiliation between the Complainant and the Respondent which provides any rights, licenses and / or permissions of any kind, which would entitle the Respondent to incorporate, and use, the Complainant's trademark in the disputed domain name, or in trading activities. The use of the disputed domain name is not fair, is not authorized by the Complainant, the Complainant's trademark has been used in the disputed domain name (and on the website resolved at the disputed domain name), and have combined this with the word: "authentics" and there is no disclosure as to the relationship, or lack thereof, between the Complainant and the Respondent. The Respondent has not been commonly known by the disputed domain name.

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 by the Respondent to attract, for commercial gain, users to the website, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation and/or endorsement of the website or of a product on the website. The website at the disputed domain name contains unauthorized use of intellectual property rights of the Complainant. The website at the disputed domain name has attempted to replicate the original website "www.f1authentics.com" authorized by the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)") in cases where a domain name incorporates the entirety of a trademark the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing. The Panel finds that in the present case the disputed domain name incorporates the entirety of the Complainant's trademark.

According to section 1.8 of the [WIPO Overview 3.0](#) where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The Panel finds that the addition of a hyphen and word "authentic" in the disputed domain name does not prevent finding it confusingly similar to the Complainant's trademark F1.

The addition of the gTLD ".store" does not impact on the analysis of whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

Considering the above the Panel finds the disputed domain name is confusingly similar to the Complainant's trademark, therefore, the Complainant has established its case under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name.

Furthermore, the Respondent provided no evidence that it holds rights or legitimate interests in the disputed domain name.

The available evidence confirm that the Respondent is not commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent, thus no actual or contemplated *bona fide* or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

The disputed domain name directs Internet users to a website with a logo similar to the Complainant's and designed similarly to the website authorized by the Complainant to make Internet users believe that they actually access the website authorized by the Complainant.

According to section 2.8.1 of the [WIPO Overview 3.0](#) resellers, distributors using a domain name containing complainant's trademark to undertake sales related to the complainant's goods may be making a *bona fide* offering of goods and thus have a legitimate interest in such domain name. Outlined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (the "*Oki Data Test*"), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods at issue;
- (ii) the respondent must use the site to sell only the trademarked goods;
- (iii) the site must accurately and prominently disclose the registrant's relationship with trademark holder;
and
- (iv) the respondent must not try to "corner the market" in domain names reflecting trademark.

The Panel finds that the Respondent failed to satisfy at least the third above requirement and did not in any way disclose its (lack of) actual relationship with the Complainant, and thus failed to pass the *Oki Data Test*.

The Respondent's use of the disputed domain name misleads consumers into thinking that the website is operated by or affiliated with the Complainant. As such, the Respondent's use of the disputed domain name cannot be considered *bona fide*.

Moreover, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant. Given the meaning of the word "authentic" and the Complainant's online presence, the addition of the gTLD ".store" adds confusion as the Internet user may mistakenly believe the website linked to the disputed domain name to be operated by the Complainant as its online store (see, e.g., *Telstra Corporation Limited v. Zhen Yang*, WIPO Case No. [D2016-1680](#)).

Considering the above the Panel finds the Respondent does not have rights or legitimate interests in the disputed domain name. Therefore, the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Respondent's use of the disputed domain name to purport to sell the products branded with the Complainant's trademark shows that at the time of the registration of the disputed domain name the Respondent clearly knew and targeted the Complainant's prior registered and famous trademark, which confirms the bad faith (see, e.g., *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#)).

According to section 3.1.4 of the [WIPO Overview 3.0](#), the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is convinced that the Complainant's trademark is well established through long and widespread use and the Complainant has acquired a significant reputation and level of goodwill in its trademark internationally. Thus, the Panel finds that the disputed domain name confusingly similar to the Complainant's trademark was registered in bad faith.

According to paragraph 4(b)(iv) of the Policy the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location. In this case, the disputed domain name is resolving to a website featuring the Complainant's trademark and designed to make a false impression to be authorized by the Complainant to intentionally attract Internet users by creating likelihood of confusion with the Complainant's trademark as to the source of the website and its products. The Panel finds the above confirms the disputed domain name was registered and used in bad faith.

The Respondent ignored its possibility to comment on the contrary and provide any explanations to prove its good faith while registering and using the disputed domain name.

Considering the above, the Panel finds the disputed domain name was registered and is being used in bad faith. Therefore, the Complainant has established its case under paragraph 4(a)(iii) 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 <f1-authentic.shop> be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: February 16, 2023