

ADMINISTRATIVE PANEL DECISION

Formula One Licensing BV v. 陈明坤 (chen ming kun)
Case No. D2023-0918

1. The Parties

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

The Respondent is 陈明坤 (chen ming kun), China.

2. The Domain Name and Registrar

The disputed domain name <if1shop.com> is registered with Xin Net Technology Corporation (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on March 1, 2023. On March 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 5, 2023, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on March 7, 2023, 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 in English on March 10, 2023.

On March 7, 2023, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On March 10, 2023, the Complainant submitted its request that English be the language of the proceeding. The Respondent did not comment on the language of the 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 in English and Chinese of the Complaint, and the proceedings commenced on March 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 4, 2023.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on April 13, 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 an IP holding company and owns a large trademark portfolio in jurisdictions around the world for the marks F1, FORMULA 1 and related marks. The Complainant's affiliated company, Formula One Asset Management Limited, commercializes and owns all commercial rights in the world-famous FIA Formula One World Championship, also known as the F1 Championship. The F1 Championship was first established in 1950 and each year, approximately twenty-three F1 Championship races are held in many places throughout the world, including China. Each race is usually attended by over 250,000 people, with on average 4.2 million race attendees annually. The races are also televised and have attracted around 425-600 million viewers annually since 2005 with broadcasts in around 189 countries.

The Complainant provides evidence that it owns an international portfolio of trademark registrations for F1 and F1 STORE among many other related marks, including, but not limited to European Union trademark registration number 017494972 for the F1 mark, registered on June 14, 2019; Brazilian trademark registration number 913748820 for the F1 mark, registered on January 8, 2019; and European Union trademark registration number 017970224 for the F1 STORE mark, registered on June 7, 2019.

The relevant registered trademarks adduced by the Complainant were successfully registered prior to the date of registration of the disputed domain name by the Respondent, which is June 16, 2021. The Complainant submits evidence that the disputed domain name directs to an active website, which is operated as an e-commerce website purportedly offering the Complainant's F1-branded products for sale.

5. Parties' Contentions

A. Complainant

The Complainant essentially contends that the disputed domain name is confusingly similar to its trademarks for F1, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith.

The Complainant claims that its products and trademarks are well-known among the relevant consumers, and provides company information, screenshots, site analytics and related documents as well as references to prior UDRP panel decisions which have recognized the Complainant's rights in its F1 marks and the fact that they are well-known trademarks, see for instance *Formula One Licensing BV v. Mary J Frazer*, WIPO Case No. [D2023-0077](#); and *Formula One Licensing BV v. fan cao*, WIPO Case No. [D2022-4965](#). Moreover, the Complainant provides evidence that the disputed domain name is linked to an active website, operating as an e-commerce website. In this context, the Complainant claims that the Respondent is unlawfully using the Complainant's trademarks, thumbnail, typeface and text content likely protected by copyright, and offering unauthorized F1-branded products for sale to Internet users by taking unfair advantage of the Complainant's trademarks. The Complainant essentially contends that such use does not confer any rights or legitimate interests in respect of the disputed domain name and constitutes bad faith.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

According to the Registrar's verification response, the language of the Registration Agreement for the disputed domain name is Chinese. Nevertheless, the Complainant filed its Complaint and its amended Complaint in English, and requests that English be the language of the proceeding. The Panel notes that the Respondent did not comment on the language of the proceeding and did not submit any arguments on the merits of this proceeding.

In considering this request, the Panel has carefully reviewed all elements of this case, and deems the following elements particularly relevant: the Complainant's request that the language of the proceeding be English; the lack of comment on the language of the proceeding and the lack of response on the merits of this proceeding by the Respondent (the Panel notes that the Respondent was invited by the Center in Chinese and in English and in a timely manner to present its comments and response in either Chinese or English, but chose not to do so); the fact that the disputed domain name is written in Latin letters and not in Chinese characters, that the website linked to the disputed domain name is entirely in English; and, finally, the fact that Chinese as the language of the proceeding could lead to unwarranted delays and additional costs for the Complainant. In view of all these elements, the Panel grants the Complainant's request, and decides that the language of this proceeding shall be English.

6.2. Discussion and Findings on the Merits

The Policy requires the Complainant to prove three elements:

- (a) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (b) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (c) the disputed domain name has been registered and is being used in bad faith.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

A. Identical or Confusingly Similar

The Panel finds that the Complainant has provided sufficient evidence that it has valid rights in the mark F1, based on its registration of the same as a trademark in a large number of jurisdictions.

Further, as to confusing similarity of the disputed domain name with the Complainant's marks, the Panel finds that the disputed domain name consists of the combination of three elements, namely the Complainant's F1 trademark preceded by the letter "i" and followed by the term "shop". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7, "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing" (see also *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). The Panel concludes that the disputed domain name contains the entirety of the Complainant's famous trademark F1, which remains easily

recognizable. The Panel accepts that the addition of the letter “i” before, and of the term “shop” after the Complainant’s trademark does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark. The Panel also finds that the applicable generic Top-Level Domain (“gTLD”) (“ .com” in this proceeding) is viewed as a standard registration requirement, and may as such be disregarded by the Panel, see in this regard [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark. The Panel decides that the Complainant has satisfied the requirements of the first element under the Policy.

B. Rights or Legitimate Interests

On the basis of the evidence and arguments submitted, the Panel accepts that the Complainant makes out a *prima facie* case that the Respondent is not, and has never been, an authorized reseller, service provider, licensee, or distributor of the Complainant, is not a good faith provider of goods or services under the disputed domain name and is not making a legitimate noncommercial or fair use of the disputed domain name. The Panel also notes that the Respondent is not commonly known by the disputed domain name. As such, the Panel finds that the burden of production regarding this element shifts to the Respondent (see [WIPO Overview 3.0](#), section 2.1). However, no evidence or arguments have been submitted by the Respondent in reply.

Further, reviewing the facts of this proceeding, the Panel notes that the disputed domain name directs to a website selling F1-branded products which shows a clear intent on the part of the Respondent to wrongly impersonate the Complainant and its licensees (see for instance the following quote in the “About Us” section of the website linked to the disputed domain name: “Welcome to the official Formula One online store”). The Panel accepts that the Respondent attempts to impersonate the Complainant (and/or its official licensee operating the F1 STORE) to obtain commercial gain from misleading Internet users by using the Complainant’s F1 trademarks in the disputed domain name, to offer unauthorized F1-branded products to such Internet users. Furthermore, the Panel has also taken into account the Complainant’s evidence from which it is clear that the Respondent prominently displays the Complainant’s F1 logo and word mark at the website linked to the disputed domain name and uses the Complainant’s own identical thumbnail, a similar typeface and font of the tab banner and the layout and also entirely copies certain text sections of the “About Us” section of the Complainant’s website, likely protected by copyright, without providing any proper disclaimer regarding the lack of relationship between the Respondent and the Complainant. It is clear to the Panel from the foregoing elements that the Respondent is not acting as a good faith provider of goods or services under the disputed domain name (see *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)) and that there are also no other circumstances or factual elements conferring any rights or legitimate interests in the disputed domain name on the Respondent.

Furthermore, the Panel agrees with the Complainant that the nature of the disputed domain name, being confusingly similar to the Complainant’s trademarks and impersonating the F1 STORE website operated by the Complainant’s licensee, carries a risk of implied affiliation and cannot constitute fair use, as it effectively impersonates the Complainant, its licensee the F1 STORE and its products (see [WIPO Overview 3.0](#), section 2.5.1).

On the basis of the foregoing elements, the Panel considers that none of the circumstances of rights or legitimate interests envisaged by paragraph 4(c) of the Policy apply, and that the Complainant has satisfied the requirements of the second element under the Policy.

C. Registered and Used in Bad Faith

Given the fact that the Complainant’s prior registered trademarks for F1 are internationally well-known (see in this regard also earlier UDRP panel decisions such as *Formula One Licensing BV v. Mary J Frazer*, WIPO Case No. [D2023-0077](#)), the Panel finds that by registering the disputed domain name, which contains the F1 trademarks in their entirety, the Respondent consciously targeted the Complainant’s prior well-known

registered trademarks. The Panel finds that this creates a presumption of bad faith. In this regard, the Panel refers to the [WIPO Overview 3.0](#), section 3.1.4, which states “[p]anelists have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith”. Furthermore, the Panel also notes that the Respondent was likely aware of the Complainant’s trademark rights in F1 when it registered a confusingly similar domain name and began operating a website that provides unauthorized F1-branded products in direct competition with the Complainant and its licensees, including clearly displaying the Complainant’s trademarks on the website linked to the disputed domain name. In the Panel’s view, these elements clearly indicate bad faith on the part of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the Complainant provides evidence that the disputed domain name directs to a website used by the Respondent as an e-commerce website for unauthorized F1-branded products. Such website clearly displays the Complainant’s F1 marks and logos on the home page and throughout the rest of the website, without the authorization of the Complainant, and clearly attempts to impersonate the Complainant and its licensees. Furthermore, the Respondent seems to have reproduced on its website the Complainant’s own identical thumbnail, a similar typeface and font of the tab banner and the layout, and also entirely copies certain sections of the “About Us” section of the Complainant’s website, likely protected by copyright, without providing any proper disclaimer regarding the relationship between the Respondent and the Complainant. The Panel also notes that the Respondent uses a misleading copyright notice “© 2021 IF1SHOP. All rights reserved.” which seems to wrongly claim copyright in the content on such website, and which is likely to further mislead Internet users into believing that the Respondent is an affiliate of, licensee, or official distributor of, or at least otherwise connected to the Complainant, which it is not. The Panel concludes from the above elements that the Respondent is intentionally attracting Internet users for commercial gain to the disputed domain name, by creating consumer confusion between the disputed domain name and the Complainant’s trademark (see paragraph 4(b)(iv) of the Policy). This constitutes direct evidence of the Respondent’s bad faith. The Panel therefore finds that it has been demonstrated that the Respondent has used, and is using the disputed domain name in bad faith.

Finally, the Respondent has failed to provide any response or evidence to establish its good faith or absence of bad faith. The Panel therefore finds that the Complainant has satisfied the requirements of the third requirement under 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 <if1shop.com> be transferred to the Complainant.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: April 18, 2023