

ADMINISTRATIVE PANEL DECISION

Paris Saint-Germain Football v. Edmund Pham

Case No. D2023-3126

1. The Parties

The Complainant is Paris Saint-Germain Football, France, represented by Plasseraud IP, France.

The Respondent is Edmund Pham, United States of America.

2. The Domain Name and Registrar

The disputed domain name <soccerparissaintgermainshop.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 20, 2023. On July 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 20, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 21, 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 amendment to the Complaint on August 7, 2023.

The Center verified that the Complaint together with the amendment to 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 August 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 30, 2023.

The Center appointed Alfred Meijboom as the sole panelist in this matter on September 6, 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 a French professional football (soccer) club established in 1970 and based in Paris, France. The Complainant enjoys a considerable global reputation in the area of professional football. The Complainant's official website and online shop have a high visit rate. In addition, the Complainant has opened 175 soccer academies in 22 different countries around the world as part of its Paris Saint-Germain Academy program, which accompany more than 30,500 registered players each season.

The Complainant is the owner of different registered trademarks (the "PARIS SAINT-GERMAIN trademark") for, *inter alia*, clothing, footwear, and headgear, including

- European Union trademark PARIS SAINT-GERMAIN with registration number 016666836, which was registered on January 18, 2018;
- International trademark PARIS SAINT-GERMAIN with registration number 1410110, which was registered on November 27, 2017 for designated countries which include Switzerland, China, India, Japan, Mexico, and Türkiye; and
- United States of America device mark PARIS SAINT-GERMAIN with registration number 5116366, which was registered on January 10, 2017.

The disputed domain name was registered on April 10, 2023 and resolves to a parking page with sponsored links.

5. Parties' Contentions

A. Complainant

The Complainant alleges that the disputed domain name is confusingly similar to the Complainant's rights in the PARIS SAINT-GERMAIN trademark, which the disputed domain name identically reproduces. The addition of the elements "soccer" and "shop" in the disputed domain name do not prevent a finding of confusing similarity.

According to the Complainant the Respondent has no rights or legitimate interests in respect of the disputed domain name, which neither corresponds to the name of the Respondent, nor to any trademark registered in the name of the Respondent or trade name corresponding to the disputed domain name. To the best of the Complainant's knowledge, the Respondent is not known under the disputed domain name, and the Complainant never permitted the Respondent to use the PARIS SAINT-GERMAIN trademark in any way in the disputed domain name. The Complainant further alleges that there is no evidence of any fair or non-commercial or *bona fide* use of the disputed domain name. The disputed domain name rather redirects to a parking page containing sponsored links which redirects to third party online shops promoting football jerseys, mostly Paris Saint-Germain jerseys, but also jerseys of French soccer clubs who are the Complainant's rivals in French "Ligue 1" championship, which capitalizes on the reputation and goodwill of the PARIS SAINT-GERMAIN trademark. The Complainant also alleges that the nature of the disputed domain name, which identically reproduces the Complainant's well-known mark with terms directly referring to its activity, carries a high risk of implied affiliation with the Complainant, and therefore cannot constitute fair use, as it effectively impersonates or suggests sponsorship or endorsement by the Complainant.

The Complainant claims that the Respondent could not have been unaware of the existence of the PARIS SAINT-GERMAIN trademark at the time of registration of the disputed domain name as the PARIS SAINT-GERMAIN trademark was at that time already enjoying a well-known reputation, and the disputed domain name comprises the PARIS SAINT-GERMAIN trademark in its entirety with the additional term “soccer”, which refers to the Complainant’s main activity. Further, the Complainant alleges that the fact that the disputed domain name redirects toward a parking page containing sponsored links redirecting to online shops which sell soccer jerseys is, since the PARIS SAINT-GERMAIN trademark has a reputation, sufficient evidence of bad faith registration and use of the disputed domain name. Moreover, the Complainant alleges that Internet users visiting the website to which the disputed domain name redirects expect to visit an online store offering the Complainant’s products, which constitutes an improper use of the PARIS SAINT-GERMAIN trademark to attract Internet users to the Respondent’s website for commercial gain by creating a likelihood of confusion as to source, sponsorship, affiliation or endorsement of the website. The Complainant asserts that MX records have been set up on the disputed domain name, together with a SPF record, so that the Respondent may use the disputed domain name to send fraudulent emails such as messages containing spam, or phishing attempts. In addition, the technical configuration of the disputed domain name shows that the Respondent which allow the receiving mail server to check, during mail delivery, that a mail is submitted by an IP address and/or email server authorized by that domain name’s administrators.

B. Respondent

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

6. Discussion and Findings

The Respondent did not file a response. However, as set out in section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), the Respondent’s default does not automatically result in a decision in favor of the Complainant. The Complainant must still establish each of the three elements required by paragraph 4(a) of the Policy. Although the Panel may draw appropriate inferences from the Respondent’s default, paragraph 4 of the Policy requires the Complainant to support its assertions with actual evidence in order to succeed in these proceedings. Paragraph 14(b) of the Rules provides that, in the absence of exceptional circumstances, the Panel shall draw such inferences, as it considers appropriate from a failure of a party to comply with a provision or requirement of the Rules. The Panel finds that in this case there are no such exceptional circumstances.

Under the Policy, the Complainant must prove that:

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

A. Identical or Confusingly Similar

It is well established that the generic Top-Level Domains (“gTLDs”) may typically be disregarded in the assessment under paragraph 4(a)(i) of the Policy (e.g., *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the disputed domain name is confusingly similar to the PARIS SAINT-GERMAIN trademark. The disputed domain name incorporates the PARIS SAINT-GERMAIN trademark in its entirety, and merely adds the terms “soccer” and “shop”, which does not prevent a finding of confusing similarity between the disputed domain name and the PARIS SAINT-GERMAIN trademark under the Policy (e.g., *Swarovski Aktiengesellschaft v. WhoisGuard, WhoisGuard Protected Phily Helen*, WIPO Case No. [D2012-0889](#); *Paris Saint-Germain Football v. MHP Private*, WIPO Case No. [D2019-0036](#)). Consequently, the first element of paragraph 4(a) of the Policy is met.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the PARIS SAINT-GERMAIN trademark, and the first element is met.

B. Rights or Legitimate Interests

The Complainants must show a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, which the Respondent may rebut (e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel takes note of the Complainant's various allegations and more specifically that the Respondent is not known by the disputed domain name, and no authorization has been given by the Complainant to register the disputed domain name which includes the PARIS SAINT-GERMAIN trademark, and to use the disputed domain name for a parking page with sponsored links. The allegations of the Complainant remain unchallenged. There is no evidence before the Panel to show that the Respondent has rights or legitimate interests in the disputed domain name.

The Panel therefore finds that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy

C. Registered and Used in Bad Faith

The Complainant showed that it has registered the PARIS SAINT-GERMAIN trademark before the Respondent registered the disputed domain name, and the Complainant undisputedly alleged that the PARIS SAINT-GERMAIN trademark had a reputation at the time the Respondent registered the disputed domain name, which reputation was confirmed by different UDRP panels (e.g., *Paris Saint-Germain Football v. Relativ Hosting*, WIPO Case No. [D2020-2356](#); *Paris Saint-Germain Football v. Contact Privacy Inc. Customer 1248956775*, *Contact Privacy Inc. Customer 1248956775 / Ismail Bulut Gonulalan*, WIPO Case No. [D2021-1321](#)). The Panel in the proceedings at hand shares the opinion that the PARIS SAINT-GERMAIN trademark has a reputation, and infers from the term "soccer" at the beginning of the disputed domain name that the Respondent must have had the Complainant and the PARIS SAINT-GERMAIN trademark in mind when he registered the disputed domain name. Therefore, the Panel is satisfied the disputed domain name was registered in bad faith.

With respect to the Respondent's alleged use of the disputed domain name in bad faith, the Panel concludes that the Respondent has attempted to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's PARIS SAINT-GERMAIN trademark through displaying sponsored links on the website to which the disputed domain name resolves. In this respect "(n)either the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith" (section 3.5 [WIPO Overview 3.0](#)). The Panel further infers from the fact that the Respondent has undisputedly set up five MX records, together with a SPF record, and also noting the nature of the disputed domain name, that the Respondent must have been using the disputed domain name to send emails, and, as the Complainant's allegation was not challenged by the Respondent, likely has been using the disputed domain name for illegal activities such as phishing and/or sending spam. This is further indicative of use of the disputed domain name in bad faith.

Consequently, the Panel finds that the Complainant has also satisfied the third requirement of paragraph 4(a) 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 <soccerparissaintgermainshop.com> be transferred to the Complainant.

/Alfred Meijboom/

Alfred Meijboom

Sole Panelist

Date: September 10, 2023