

## **ADMINISTRATIVE PANEL DECISION**

UP COOP v. Carl Burnett / International Pickleball Federation  
Case No. D2023-3893

### **1. The Parties**

The Complainant is UP COOP, France, represented by Casalonga Avocats, France.

The Respondent is Carl Burnett / International Pickleball Federation, United States of America (“United States”).

### **2. The Domain Name and Registrar**

The disputed domain name <upcooperative.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 18, 2023. On September 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 19, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 20, 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 on September 25, 2023.

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 September 26, 2023. In accordance with the Rules, paragraph 5, the initial due date for Response was October 16, 2023. On October 16, 2023, the Center received an email communication from the Respondent requesting a four calendar day extension for response under paragraph 5(b) of the Rules, which was granted by the Center in accordance with the Center’s communications to the Parties on the same date. On October 19, 2023, the Center received

another email communication from the Respondent requesting an additional 30 day extension for the Response. On October 24, 2023, the Complainant informed the Center of its agreement to grant the Respondent seven days extension to file the Response. On October 25, 2023, the Center notified the Parties of the granting of the additional 7 days for the filing of the Response. The due date for the Response was therefore extended to November 1, 2023.

The Response was filed with the Center on November 2, 2023.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on November 10, 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 legal entity of the form Société coopérative de production à forme anonyme et capital variable, registered in the Nanterre trade and company register under number 642 044 366. According to the Complainant, it was created in 1964, serves 21.3 million people around the world, and is the third largest group worldwide in the service voucher market, with a presence in 22 countries and 2,951 employees. In 2022, the Complainant reported turnover of EUR 640 million. The Complainant's services include the provision of prepaid meal voucher cards, gift vouchers for employees, and a universal employment service voucher. The Complainant promotes its services on the Internet via a range of domain names, the earliest of which appears to be <up.coop>, registered on December 4, 2014. The Complainant lists large numbers of followers on social media, including 247,000 on Facebook, with 249,000 "likes", and 1,099 on YouTube, with 3,765,842 "views".

The Complainant owns a portfolio of registered trademarks for the UP mark, the earliest of which appears to be European Union Registered Trademark No. 008460339 for the word mark UP, registered on May 18, 2010 in Classes 9, 16, 36 and 38. Broadly speaking, the goods and services to which the Complainant's said mark relates include payment cards or systems, printed cheques and cards, the issuing of loyalty cards and employee benefits, and the provision of telecommunications/Internet services. The Complainant also owns French Registered Trademark No. 4976649 for a figurative mark consisting of the words "Up Coop" rendered in a white typeface centered within an orange colored square, where the word "Up" is in a larger size and is placed directly above the smaller word "Coop", registered on July 11, 2023 in Classes 9, 16, 35, 36, 38, and 42.

The disputed domain name was registered on October 16, 2022. The website associated with the disputed domain name (visited by the Panel in accordance with its general powers under paragraph 10 of the Rules) is a web server default and login page. The Respondent is the Vice President and Chief Technology Officer of International Pickleball Federation, Inc., which appears to the Panel to be a governing body, or proposed governing body, of the sport of pickleball. According to the Respondent, its organization is in active merger negotiations with various pickleball organizations, and has registered various domain names to be used for a consolidated merged organization under the umbrella "UP", an abbreviation for "United Pickleball".

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that it is likely that the Respondent's identity has been usurped by a third party which is concealing its own identity in order to register the disputed domain name. The Complainant

also submits that it has no relationship with the Respondent, and has never consented to the Respondent's use of the Complainant's trademark in any manner. The Complainant notes that its trademarks are widely known in France and were registered long before the disputed domain name, concluding that there is no doubt that the Respondent knew or should have known of the Complainant's trademarks and prior rights. The Complainant asserts that the disputed domain name targets the Complainant and its corporate structure, and that Internet users may believe that the disputed domain name is the Complainant's official website, and that any attempt to use it would lead to the intentional misdirection of users seeking the Complainant's online presence by creating a likelihood of confusion with the Complainant's marks. The Complainant submits that its UP trademark is distinctive and that it is implausible that it would be used in good faith.

## **B. Respondent**

The Respondent contends as follows:

The Respondent does not challenge the Complainant's standing to file the Complaint.

The Respondent has developed marketing and branding material for the term UP, which is an abbreviation for United Pickleball, and has a legitimate right to use the disputed domain name because it is being used in commerce for the United Pickleball Consortium. The Consortium will include the United Pickleball Federation, the United Pickleball Cooperative Tournament Corporation, and the United Pickleball Investment Corporation. The Respondent acquired eight domain names using the UP term, including the disputed domain name, during merger negotiations with various pickleball organizations to demonstrate to the negotiating parties that the new rebranded consortium would have the requisite names. The Respondent has as much right as anyone else to use the UP term as an acronym provided it is not copying the Complainant's mark, using it to trade off such mark, or using it to target or act inappropriately towards the Complainant. The disputed domain name does not duplicate the Complainant's design marks. The term "coop" cannot be equated to the term "cooperative", and also has an alternative dictionary meaning, namely "continuity of operations planning".

The Respondent's use of the UP acronym should not be considered to be in bad faith. There is no website associated with the disputed domain name and it cannot have caused any confusion. The Respondent has not concealed its identity and its use of a privacy service was legitimate. The Respondent is not passively holding the disputed domain name but is engaged in active negotiations to use the disputed domain name for legitimate purposes.

## **6. Discussion and Findings**

### **A. Preliminary Matter: Respondent's late Response**

The Panel notes that the Response was late by one day beyond the extended due date. The Panel understands this to have resulted from a technical failure at the Respondent's end in delivering an email to the Center. The Respondent appears to have experienced a technical failure on two separate occasions. In any event, the Panel considers that the Respondent's delay is minimal in extent and is not material in this particular case. The Panel is also of the view that the Complainant will suffer no prejudice by the Response being admitted in these circumstances. Accordingly, the Panel admits the Respondent's late Response.

### **B. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark UP is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. While the addition of other terms, here, “cooperative”, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It should also be noted that the Respondent concedes that the Complainant has standing to file the present Complaint.

Based on the available record, the Panel finds the first element of the Policy has been established.

### **C. Rights or Legitimate Interests**

The requirements of paragraph 4(a) of the Policy are conjunctive. A consequence of this is that failure on the part of a complainant to demonstrate one element of the Policy will result in failure of the complaint in its entirety. Accordingly, in light of the Panel’s finding in connection with registration and use in bad faith, discussed below, it is unnecessary for the Panel to address the issue of the Respondent’s rights or legitimate interests in the disputed domain name.

### **D. Registered and Used in Bad Faith**

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent is not currently using the disputed domain name and the Complainant’s submissions focus on this fact. Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (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 (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3.

With regard to factor (i) above, the Panel notes that the Complainant’s trademark bears a substantial reputation, particularly in France, where the Complainant’s principal place of business is situated. The extract from the Complainant’s website indicates that it also has an international presence in 23 countries, predominantly in Western and Eastern Europe. However, there is no evidence on the record that the Complainant has any presence in the United States, where the Respondent is based, or that its mark is registered or otherwise used in commerce there. It would not be unreasonable to infer that the Complainant might have a substantial globally accessible Internet presence, although no direct evidence of this is to be found on the record with the exception of a significant presence on social media. The Complainant owns various domain names but had not registered and did not use domain names consisting of the term “up” with the term “cooperative” before the disputed domain name was registered. In short, there is no indication before the Panel that the Respondent is more likely than not to have had knowledge of the Complainant and/or had the Complainant’s trademark in mind when it registered the disputed domain name.

With regard to factor (ii), the Respondent has provided a Response in which it has set out plausible details of a contemplated good faith use of the disputed domain name. Specifically, the Respondent’s case is that it intends to represent a cooperative of bodies engaged in the sport of pickleball, in respect of which the letters

“UP” will be an acronym for “United Pickleball”, and that the disputed domain name was registered along with others in the pursuit of that plan. There is no evidence before the Panel to indicate any bad faith intent on the Respondent’s part to free ride on or otherwise benefit unfairly from association with the Complainant’s trademark in this particular endeavor.

With regard to factor (iii), the Respondent has not concealed its identity, other than making use of a privacy service in the first instance, which is not on its own an indicator of bad faith, in the absence of other features such as those discussed in section 3.6 of the [WIPO Overview 3.0](#). The Respondent’s true identity as underlying holder of the disputed domain name was revealed at the point of Registrar verification. There is no suggestion that any false contact details have been supplied by the Respondent, and the Respondent has come forward with a Response in which its identity and motivation for registering the disputed domain name is addressed in detail.

With regard to factor (iv), the Complainant’s case proceeds on an apparent misunderstanding that the Respondent’s identity had been in some way usurped and that this demonstrated bad faith intent on the part of the holder of the disputed domain name. The Respondent’s identity has not been usurped, and the named Respondent states that it is the genuine holder of the disputed domain name. The Panel finds on the balance of probabilities that the Respondent intentionally registered the disputed domain name for the purposes which it asserts. The Panel is of the view that the Respondent’s proposed use does not constitute abusive cybersquatting, and amounts to plausible good faith use as far as the passive holding doctrine under the Policy is concerned.

The Panel is conscious however of the fact that the record contains only limited information regarding the Respondent’s alleged plans and that, in particular, the only supporting evidence provided consists of a copy of the United Pickleball Marketing and Public Relations Logo, which in itself does not use the “UP” acronym. In other words, none of the Respondent’s other assertions have been independently evidenced in any way, including in particular its alleged ongoing negotiations with various governing bodies to reorganize the sport of pickleball under various names which would include the disputed domain name. Accordingly, while the Panel is prepared to accept the Respondent’s *ex facie* plausible assertions for the purposes of the present administrative proceeding, it is not impossible that subsequent events could shed a different light upon the Respondent’s case and might support grounds for a possible refiling.

In the totality of the circumstances of this case, however, the Panel finds that it is not established on the basis of the passive holding doctrine or otherwise that the disputed domain name has been registered and is being used in bad faith. In making this determination, the Panel notes that it makes no finding as to whether the disputed domain name, if used for the alleged intended purpose, would constitute trademark infringement in the jurisdictions where the Complainant operates and/or where it holds its various registered trademarks, noting in particular the fact that the Respondent intends to use the disputed domain name as part of a revised global governance scheme for the sport of pickleball that would presumably extend to most or all jurisdictions. While there may be some conceptual overlap, the question of trademark infringement is beyond the scope of the Policy. However, given the strong reputation of the Complainant’s mark, this is a matter to which the Respondent may prefer to address its mind before using the disputed domain name.

Based on the available record, the Panel finds the third element of the Policy has not been established.

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Andrew D. S. Lothian/*

**Andrew D. S. Lothian**

Sole Panelist

Date: November 24, 2023