

## **ADMINISTRATIVE PANEL DECISION**

Télévision Française 1 v. Domain Administrator / chen xiansheng,  
chenxiansheng  
Case No. D2022-2472

### **1. The Parties**

The Complainant is Télévision Française 1, France, represented by AARPI Scan Avocats, France.

The Respondent is Domain Administrator, United Kingdom / chen xiansheng, chenxiansheng, Singapore.

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

The disputed domain name <tf1vr.com> is registered with Atak Domain Hosting Internet ve Bilgi Teknolojileri Limited Sirketi d/b/a Atak Teknoloji (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 7, 2022. On July 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 14, 2022, 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 July 15, 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 July 18, 2022.

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 July 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 10, 2022.

The Center appointed Antony Gold as the sole panelist in this matter on August 16, 2022. 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 was founded in 1974 and is a French-based producer and broadcaster of television programs in the fields of entertainment, current affairs and fiction, for consumption in both domestic and international markets. It has submitted evidence which suggests that its “TF1” channel is among the most watched television channels in Europe. The Complainant has additionally developed a number of digital services, most notably MYTF1, which allow online access to replays as well as video-on-demand services.

The Complainant’s primary brand is “TF1” and it owns many trade marks to protect this trading style. These include, by way of example only, the French trade mark, registration number 1290436 for TF1, in multiple classes, registered on November 22, 1984. The Complainant also owns and operates domain names which include its TF1 mark, including <tf1.com>, <tf1.fr> and <tf1.eu>.

The disputed domain name was registered on May 23, 2022. It has previously resolved to a website containing pornographic content. It does not presently resolve to an active website.

#### **5. Parties’ Contentions**

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

The Complainant says that the disputed domain name is identical or confusingly similar to a trade mark in which it has rights. It refers to its trade marks for TF1, full details of one of these marks having been given above, and says that the disputed domain name incorporates its mark in its entirety and merely adds the letters “vr”. These letters are commonly used as an acronym for “virtual reality” and the public could think that the disputed domain name is being used by the Complainant to offer services connected with virtual reality, not least because the Complainant is already offering such services under its TF1 mark and uses signs such as “MY TF1 VR” to denote such services.

The Complainant says also that the Respondent has no rights or legitimate interests in respect of the disputed domain name. To the best of the Complainant’s knowledge, the Respondent is not known by the disputed domain name and does not own any trade marks for the name “TF1VR”. The Respondent is not in any way related to the Complainant’s businesses and the Complainant has not licensed, authorized or otherwise permitted the Respondent to register or use a domain name incorporating its trade marks. Finally, the use of the disputed domain name to redirect to a pornographic website cannot be considered as a *bona fide* offering of goods and services.

Lastly, the Complainant says that the Respondent has registered and is using the disputed domain name in bad faith. The Complainant has actively been using its TF1 marks for many years and a simple search on Google for the term “TF1” demonstrates that all results relate to the Complainant. Furthermore, the term “TF1” is not a common word in any language. Accordingly, it is highly unlikely that the Respondent was unaware of the existence of the Complainant and its marks as at the date of registration of the disputed domain name. The registration and use of the disputed domain name by the Respondent accordingly suggests opportunistic bad faith. Additionally, the Respondent has been the subject of four previous complaints under the Policy which resulted in the transfer of the domain names in issue.

The previous use of the disputed domain name to redirect to a pornographic website does not constitute good faith use. Moreover, the current, inactive status of the disputed domain name does not prevent a finding of bad faith use under the doctrine of passive holding. Furthermore, the Respondent has provided incomplete information concerning its identity when registering the disputed domain name, which confirms its bad faith.

## B. Respondent

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

## 6. Discussion and Findings

Dealing, first, with the Respondent's failure to file a response to the Complaint, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under these Rules, the Panel shall be entitled to draw such inferences from this omission, as it considers appropriate.

Paragraph 4(a) of the Policy provides that the Complainant proves each of the following three elements in order to succeed in its Complaint:

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

### A. Identical or Confusingly Similar

The information provided by the Complainant in relation to its trade mark registrations has established its rights in its TF1 trade mark.

For the purpose of determining whether the disputed domain name is identical or confusingly similar to its mark, the generic Top-Level-Domain ("gTLD") ".com" is disregarded as this is a technical requirement of registration. The disputed domain name comprises the Complainant's TF1 trade mark, in full and without alteration, followed by the letters "vr". These additional letters do not prevent the disputed domain name from being found confusingly similar to the Complainant's trade mark. As explained at section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[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 Complainant's TF1 mark is clearly recognizable within the disputed domain name and the Panel accordingly finds that it is confusingly similar to a trade mark in which the Complainant has rights.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out circumstances, without limitation, by which a respondent might demonstrate that it has rights or a legitimate interest in a domain name. These are, summarised briefly: (i) if the respondent has been using or prepared to use the domain name in connection with a *bona fide* offering of goods and services; (ii) if the respondent has been commonly known by the domain name; or (iii) if the respondent has been making a legitimate noncommercial or fair use of the domain name.

The established and widespread use of the Complainant's mark, coupled with its distinctive character and the confusing similarity between the disputed domain name and the Complainant's mark suggests that the disputed domain name has been used by the Respondent to divert visitors to its adult website, Internet users who are likely to have been searching for services associated with the Complainant. Use of the disputed domain name for the purpose of misleading Internet users in this manner does not comprise a *bona fide* offering of goods and services; see for example, *Sodexo v. Li Li*, WIPO Case No. [D2015-1018](#). Turning to the second circumstance, there is no evidence that the Respondent has been commonly known by the

disputed domain name. The third circumstance is also inapplicable as the Respondent is likely to have been deriving income from the website to which the disputed domain name previously resolved.

Lastly, the current inactive status of the disputed domain name comprises neither a *bona fide* offering of goods and services nor a legitimate noncommercial or fair use of it; see, by way of example, *G4S Plc v. Muyou Chen, wer*, WIPO Case No. [D2020-0715](#).

The Complainant has made out a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name and the burden of production shifts to the Respondent to show that it does; see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#). In the absence of any response from the Respondent, the Panel finds that the Respondent has no rights or legitimate interests with respect to the disputed domain name.

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

The widespread use and distinctive character of the Complainant's TF1 mark coupled with the confusing similarity to it of the disputed domain name provides a strong indication that the Respondent was aware of the Complainant and its mark as at the date of registration of the disputed domain name and that it was registered in order to target the Complainant and take advantage of its repute in its mark. As explained at section 3.1.4 of the [WIPO Overview 3.0](#); "Panels 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". See also *Costco Wholesale Membership Inc. and Costco Wholesale Corporation v. Almantas Kakareka and Hostmaster Oneandone, 1&1 Internet, Inc.*, WIPO Case No. [D2007-1833](#); "Substantial authority exists to the effect that registration of a domain name that is confusingly similar to a famous trademark by any entity that has no relationship to that mark is itself sufficient evidence of bad faith registration and use". The Panel accordingly finds the registration of the disputed domain name to have been in bad faith.

Paragraph 4(b) of the Policy sets out, without limitation, circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The circumstance set out in paragraph 4(b)(iv) of the Policy is if a respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website.

The use to which the Respondent has previously put the disputed domain name falls within this circumstance in that the Respondent has used the fame of the Complainant's mark in order to attract Internet users to its website who would have been likely to assume, from the confusing similarity between the disputed domain name and the Complainant's mark, that the disputed domain name resolved to a website, operated or authorized by the Complainant. The fact that such users would have realized on reaching the Respondent's website that this was not the case is immaterial because the Respondent would have achieved its objective of attracting them to its website in order to earn revenue from such visits; see *Yahoo! Inc. v. Hildegard Gruener*, WIPO Case No. [D2016-2491](#). Moreover, the diversion of Internet users, who were likely seeking information about the Complainant and its services, to a website containing pornographic content, for the purposes of the Respondent's financial gain is a clear instance of bad faith use; see, by way of example, *Merck Sharp & Dohme Corp. v. ZhenHui, HuiZhen*, WIPO Case No. [D2016-1431](#).

The Respondent's previous use of the disputed domain name therefore falls within the example of bad faith registration and use set out at paragraph 4(b)(iv) of the Policy namely that, by its use of the disputed domain name, it had attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website.

The current inactive status of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding; see section 3.3 of the [WIPO Overview 3.0](#). The factors that are typically

considered when 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 concealment of its identity or use of false contact details and (iv) the implausibility of any good faith use to which the domain name may be put.

These factors are fulfilled in the current circumstances in that: (i) the Complainant has established the repute of its TF1 trade mark; (ii) the only known use made to date of the disputed domain name has been in bad faith; (iii) the Respondent has sought to conceal its identity by use of a privacy service; (iv) there is no plausible good faith use to which the disputed domain name could be put by the Respondent, as, due to its composition, it is apt to be implicitly connected by Internet users with the Complainant.

For the above reasons, the Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

## **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 <tf1vr.com> be transferred to the Complainant.

*/Antony Gold/*

**Antony Gold**

Sole Panelist

Date: August 25, 2022