

ADMINISTRATIVE PANEL DECISION

The Football Association Limited v. Brown Hills
Case No. D2023-2204

1. The Parties

Complainant is The Football Association Limited, United Kingdom, represented by Wilson Gunn, United Kingdom.

Respondent is Brown Hills, United States of America.

2. The Domain Name and Registrar

The disputed domain name <englandfootballcollage.com> is registered with NameCheap, Inc. (the "Registrar"), hereinafter referred to as the Domain Name.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 21, 2023. On May 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 22, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 Complainant on May 23, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on May 30, 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 Respondent of the Complaint, and the proceedings commenced on May 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 20, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on June 21, 2023.

The Center appointed Richard C.K. van Oerle as the sole panelist in this matter on June 27, 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

Complainant, founded in 1863, is the governing body of association football in England. It is responsible for overseeing all aspects of amateur and professional football in England, including the commercial aspects of the England football teams, such as sponsorship, advertising, and merchandising, as well as being the governing body responsible for football coaching qualifications.

The limited company was incorporated in 1903 and has a permanent seat on the International Football Association Board (“IFAB”) which is responsible for the Laws of the Game (of association football).

It operates the website “www.Englandfootball.com” that Complainant has been using since at least May 5, 2021. Complainant also operates the website “www.thefa.com” (both websites jointly be referred to “Complainant’s Websites”) Complainant’s Websites show the consistent use of the Trademark, including pages relating to coaching

The Complaint is based on the trademark registrations in the European Union (“EU”) and United Kingdom (“UK”) for the following word/device mark:



- EU Trademark Registration number 018471683, filed on May 13, 2021, registered on November 23, 2021, and
- UK Trademark Registration number UK00003555580, filed on November 13, 2020, registered on March 26, 2021.

Both registrations have been duly renewed and are still valid. These registrations will jointly be referred to, in singular, as the “Trademark”.

The Domain Name was registered on July 9, 2022, and resolves to a website (the “Respondent’s Website”) offering football coaching services.

5. Parties’ Contentions

A. Complainant

Complainant states, in summary and in so far as relevant, the following.

Complainant’s Trademark contains the verbal element ‘England football’, which is distinctive and is identical to the first two words in the Domain Name. The Domain Name comprises the third word “collage”. Although “collage” means “a piece of art in which various materials or objects are stuck on a larger surface”, it is clear from the content of the website that this is meant to refer to “college”. So it is submitted that the last word in the Domain Name, when seen in the context of the use of the Domain Name, would be seen as a mistaken spelling of “college”, which is non-distinctive and descriptive in relation to the coaching services offered on Respondent’s Website and also provided by Complainant. Consequently “Englandfootball” is the dominant and distinctive part of the Domain Name, which is identical to the verbal elements of the Trademark and Complainant’s domain name <Englandfootball.com>.

It is therefore submitted that the Domain Name is confusingly similar to the Trademark.

Complainant submits that Respondent has no rights or legitimate interests in respect of the Domain Name.

The use of the Trademark in the Domain Name is for the purpose of increasing interest and traffic to Respondent's Website, so as to generate revenue from the unauthorized and infringing supply of football coaching services, by confusing Internet users into the mistaken belief that the website has been set up by, or on behalf of, or is at the very least connected with Complainant. To this end, Complainant's rights in its England Crest are being used on Respondent's Website together with content that has been copied from Complainant's website "www.thefa.com", including the direct copying of Football Association ("FA") Board member profiles.

Moreover, there is no evidence of Respondent's use of the Domain Name in connection with a *bona fide* offering of goods or services. The supply of football coaching services under the name 'England football', the England Crest or the FA is an infringement of Complainant's trademark rights. Also, copying Complainant's content in order to deceive users into the mistaken belief that the services being supplied are endorsed by Complainant constitutes copyright infringement and confirms that Respondent is not making legitimate, non-commercial, or fair use of the Domain Name, but is instead seeking to misleadingly divert consumers to its website for commercial gain.

The Domain Name was registered on July 9, 2022. At the time of registration, Complainant owned the registrations for the Trademark in the UK and EU in November 2020 and May 2021 respectively. Complainant had also been using "England football", its England Crest and the FA for a significant period prior to this.

Complainant's Websites provide information on a wide range of topics, including aspects of football coaching, including courses and information on coaching qualifications.

Respondent's Website shows content that has been copied from Complainant's Websites. This in itself constitutes copyright infringement at least in the UK. Complainant is also using 'England football', the England Crest and The FA in connection with the unauthorized and infringing offer of football coaching services.

An Internet user visiting Respondent's Website would likely be confused into the mistaken belief that the website has been set up by, or on behalf of, or is at the very least connected with Complainant, also because of Complainant's earlier use of a website "www.Englandfootball.com" which is closely similar to the Domain Name and provides information on official football coaching courses.

It is further submitted that the association of Complainant with the unauthorized offering and supply of football coaching services and courses is likely to cause Complainant significant damage to its reputation. Respondent's use of images and text in which Complainant has rights within the content of the webpage at the Domain Name is being done to give the mistaken impression to an Internet user attracted to the site that Respondent's services are endorsed by Complainant, when they are not and Complainant has no control or oversight of such, which could likely lead to damage to Complainant's reputation.

It is therefore submitted that the Domain Name has been registered and is being used in bad faith, as per paragraph 4(a)(iii) of the Policy.

Complainant requests that the Domain Name be transferred to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Dealing, first, with 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 Complainant prove 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 trademark or service mark in which Complainant has rights; and
- (ii) 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

Complainant has provided details of its trademark registrations, in respect of which details are set out above, and has thereby established its rights in this Trademark.

It is well accepted that the first element functions primarily as a standing requirement, and that the threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between a complainant's trademark and the disputed domain name to assess whether the trademark is recognizable within the disputed domain name (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Moreover, as found in a number of prior cases decided under the Policy and indicated in section 1.8 of the [WIPO Overview 3.0](#), where a trademark is recognizable within a domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.

The Trademark is a word/device mark that consists of the letters 'England football' shown next to a stylized version of the England Crest. The textual element 'England football' is, however, dominant. The non-textual elements of the Trademark do not detract in any way from the prominence of the word element of the Trademark, that is the most prominent element.

The Domain Name therefore incorporates the entirety of the Trademark.

In the Domain Name, "collage" is added to this textual element of the Trademark. It is clear from the content of Respondents Website that this is meant to refer to "college", and is therefore a mistaken spelling of "college", which is non-distinctive and descriptive in relation to the coaching services offered on the website and also provided by Complainant.

Furthermore, the Top-Level Domain ("TLD") is commonly disregarded under the first element confusing similarity test (section 1.11.1 of the [WIPO Overview 3.0](#)).

The Panel therefore finds that the Domain Name is confusingly similar to the Trademark. The requirements of paragraph 4(a)(i) of the Policy are fulfilled.

B. Rights or Legitimate Interests

Then, the second element of the Policy paragraph 4(a)(ii), essentially calls for a complainant to prove a negative, which is far from easy where the relevant information as to the respondent's rights or legitimate interests is often primarily within the knowledge of the respondent. The matter is addressed in section 2.1 of

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) as follows:

“While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”

This is not a case where Respondent has rebutted Complainant’s *prima facie* case. The facts speak for themselves. On Respondent’s Website football coaching services are offered under the name “England football” and the England Crest and content have been copied from Complainant’s Website, including the direct copying of FA Board member profiles. Consumers will think they are visiting the website of Complainant or an affiliated company.

Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (see section 2.13.1 of the [WIPO Overview 3.0](#)).

Moreover, the Panel finds that the composition of the Domain Name carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

Having regard to the above considerations, the Panel finds that the Domain Name is not being used in connection with a *bona fide* offering of goods and services, and the second element of the Policy under paragraph 4(a) has been satisfied.

C. Registered and Used in Bad Faith

The Panel finds that at the time of the registration of the Domain Name, Respondent was or should have been aware of the Trademark. Complainant is well known, and in any event, a trademark register search, or even a simple online search prior to the registration of the Domain Name would have informed Respondent of the existence of Complainant’s Trademark rights and its extensive use of the Trademark as a source identifier. Moreover, the composition of the Domain Name itself strongly suggests that Respondent targeted the Trademark.

Respondent’s Website uses the term “England Football College” (written with an “e” instead of an “a” as used in the Domain Name), the England Crest and offers football coaching services. In addition, it contains a direct copy of parts of Complainant’s Website (i.e. FA Board member profiles). By doing so, Respondent falsely suggests affiliation with Complainant and demonstrates that the Domain Name has intentionally been used by Respondent in an attempted to attract, for commercial gain, Internet users to Respondent’s Website by creating a likelihood of confusion with the Trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on that website.

Furthermore, the failure of Respondent to submit a response or to provide any evidence of actual or contemplated good faith use, is further evidence of bad faith, given the circumstances of the case (see, [WIPO Overview 3.0](#), section 3.2).

Therefore, the Panel finds that the Domain Name has been registered and is being used in bad faith within the meaning of 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 Domain Name, <englandfootballcollage.com>, be transferred to Complainant.

/Richard C.K. van Oerle/

Richard C.K. van Oerle

Sole Panelist

Date: July 5, 2023