

ADMINISTRATIVE PANEL DECISION

Television Française 1 v. Delamar
Case No. D2023-2720

1. The Parties

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

The Respondent is Delamar, France.

2. The Domain Name and Registrar

The disputed domain name <mytf1max-renouvellement.com> is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 26, 2023. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Also on June 26, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint.

The Center sent an email communication in English and French to the parties on June 27, 2023 regarding the language of the proceeding, as the Complaint has been submitted in English and the language of the registration agreement for the disputed domain name is French. The Complainant submitted a request for English to be the language of the proceeding on June 28, 2023. The Respondent did not comment on the language of the proceeding.

The Center sent an email communication to the Complainant also on June 27, 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 June 28, 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 July 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 27, 2023. Aside from some hostile communications, the Respondent did not submit any formal response. Accordingly, the Center notified the commencement of Panel appointment process on August 3, 2023.

The Center appointed Elise Dufour as the sole panelist in this matter on August 4, 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, Television Française 1, is known as “TF1”. It was founded in 1974 and operates one of the oldest television channel in France. TF1 is one of the most watched television channel in Europe.

The Complainant has developed digital services on its online platforms, notably “MYTF1”, allowing access to replays as well as video-on-demand services. At the end of 2022, the Complainant developed a new fee-based replay service under the name “MYTF1 MAX”, which provides members with additional replay services (no advertising and increased replay availability).

The Complainant is the registered owner of a large number of trademarks since the early 1980s consisting or including the wording TF1 in France and abroad, including *inter alia* the following trademarks:

- French trademark MY TF1 MAX No. 4776015 registered on June 11, 2021, in classes 9, 35, 38, 41 and 42;
- International Trademark TF1 No. 556537, registered on July 30, 1990 and duly renewed, in classes 9, 16, 25, 28, 35, 38 and 41;
- French trademark TF1 No. 1290436, registered on November 22, 1984 and duly renewed, in classes 1 to 42.

The Complainant also owns numerous domain names, including the following ones:

- <tf1.com>, registered on April 2, 1998;
- <tf1.fr>, registered on December 3, 1995;
- <mytf1max.com>, registered on May 11th, 2022

The disputed domain name was registered by the Respondent on June 9, 2023.

The record shows that the disputed domain name resolved to a site that makes reference to Complainant's MY TF1 brand, and that said disputed domain name was used to send scam emails to the Complainant's customers owning a “MYTF1 MAX” account, pretending to be the Complainant and requesting renewal of their subscription.

The Complainant filed an abuse report with the hosting provider and the Registrar. Following this request, the Registrar suspended the access to the disputed domain name.

Currently, the disputed domain name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that (i) the disputed domain name is confusingly similar to the Complainant's

previous trademarks; (ii) the Respondent has no rights or legitimate interests in the disputed domain name; and (iii) the Respondent registered and is using the disputed domain name in bad faith.

- (i) The Complainant claims that the disputed domain name is confusingly similar to its well-known and previous trademarks and domain names. Indeed, the disputed domain name incorporates entirely the verbal element of the Complainant's trademark MY TF1 MAX, with the mere addition of a hyphen and the French dictionary term "renouvellement" (*i.e.* "renewal") which does not eliminate the likelihood of confusion in the public mind. On the contrary, for the Complainant, this addition increases the likelihood of confusion, and deception of Internet users who will believe that the disputed domain name is used by the Complainant for the renewal of a "MYTF1 MAX" account.
- (ii) The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name: the Respondent is neither related to, nor has it been licensed or permitted to use the Complainant's trademarks. The Respondent is not commonly known by the disputed domain name and is not making a legitimate noncommercial or fair use of the disputed domain, which is used as part of a phishing attack targeting the Complainant and its customers. The Complainant highlights that such use cannot constitute a *bona fide* offering of goods or services.
- (iii) Due to the strong reputation and the well-known character of its trademarks TF1, the Complainant considers that the Respondent could not have ignored the existence of the Complainant's trademark at the time the disputed domain name was registered. In addition, for the Complainant, the disputed domain has been used in order to impersonate the Complainant and to scam its customers, which does not constitute good faith use.

B. Respondent

The Respondent did not reply to the Complainant's contentions, except from some hostile email communications on June 28, 2023 and July 10, 2023.

6. Discussion and Findings

6.1. Language of Proceedings

The language of the Registration Agreement for the disputed domain name is French.

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, 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".

As noted by previous UDRP panels, paragraph 11 of the Rules must be applied in accordance with the overriding requirements of paragraphs 10(b) and 10(c) of the Rules that the parties are treated equally, that each party is given a fair opportunity to present its case, and that the proceeding takes place with due expedition.

The Complainant has submitted a request that the language of the proceedings be English.

The Complainant contends that:

- The Registration Agreement is available in English,
- No material element does ensure that the Respondent has no knowledge of English,
- At last, the translation of the Complaint into French would cause undue delays to the Complainant with respect to a decision in this case.

The Panel accepts that substantial additional expense and delay would likely be incurred if the Complaint had to be translated into French. Moreover, the Panel notes that the Respondent did not comment on the language of the proceedings.

Thus, taking these circumstances into account, the Panel finds that it is appropriate to exercise its discretion and allow the proceedings to be conducted in English.

6.2. Discussion and Findings

In the absence of any response, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent.

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- i) the disputed domain name is identical or confusingly similar to a trademark 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 was registered and is being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

A. Identical or Confusingly Similar

The Panel finds that disputed domain name is confusingly similar to the Complainant's registered distinctive previous trademarks TF1 and MY TF1 MAX since it entirely contains the verbal element of the MY TF1 MAX trademark with of a hyphen and the French dictionary term "renouvellement" (*i.e.* "renewal").

It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name, the disputed domain name will normally be considered confusingly similar to the Complainant's trademark (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Such happens to be the case here. The addition of the word "renouvellement", ("renewal" in English) does not prevent a finding of confusing similarity.

Finally, it has also long been held that a generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and as such is disregarded under the confusing similarity test, as it does in the present case.

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

B. Rights or Legitimate Interests

The burden of proof is on the Complainant to demonstrate a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name. Once the Complainant has made out a *prima facie* case, the burden of production then shifts to the Respondent, which has then to demonstrate rights or legitimate interests in the disputed domain name.

On the basis of the submitted evidence, the Panel considers that the Complainant has successfully established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name: the Respondent is not commonly known under the disputed domain name, nor owns any registered rights on the disputed domain name or has been authorized by the Complainant to use the prior trademarks in any way.

Moreover, the Complainant has adduced evidence to show that the disputed domain name has been used for fraudulent activities, as part of a phishing attack targeting the Complainant and its customers, which cannot constitute a *bona fide* offering of goods or services.

Given such evidence and the absence of contrary evidence from the Respondent, the Panel considers that it is not possible for the Respondent to establish that it has rights or legitimate interests in the disputed domain name.

The Panel therefore finds, noting the Complainant's *prima facie* arguments and the absence of a response, that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Given the notorious and strong reputation of the Complainant's TF1 and MY TF1 MAX trademarks, the Panel considers that the Respondent knew or should have known of said trademarks at the time of the registration of the disputed domain name. Noting the circumstances of the case, such knowledge is sufficient to establish that the disputed domain name was registered in bad faith.

Regarding the previous use of the disputed domain name (scam and phishing attack targeting the Complainant and its customers), it is well established that bad faith is established if by using the disputed domain name the 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, affiliations, or endorsement of its website or location or of a product or service on its website or location.

As submitted by the Complainant, here the fake client space was use for fraudulent purposes and for phishing scams. See section 3.4 of the [WIPO Overview 3.0](#).

With respect to the current use of the disputed domain name, the passive holding of the disputed domain name does not prevent a finding of bad faith. See section 3.3 of the [WIPO Overview 3.0](#).

In these circumstances, the Panel finds that the disputed domain name was registered and being used in bad faith within 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 disputed domain name <mytf1max-renouvellement.com> be transferred to the Complainant.

/Elise Dufour/

Elise Dufour

Sole Panelist

Date: August 16, 2023