

## **ADMINISTRATIVE PANEL DECISION**

### **Formula One Licensing BV v. Adam Robert Case No. D2023-4186**

#### **1. The Parties**

The Complainant is Formula One Licensing BV, Netherlands (Kingdom of the), represented by Sheridans Solicitors, United Kingdom.

The Respondent is Adam Robert, United Kingdom.

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

The disputed domain name <thef1magazine.com> is registered with NameSilo, LLC (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 9, 2023. On October 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 10, 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 (thef1magazine.com, c/o NameSilo, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 13, 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 October 18, 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 October 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 13, 2023.

The Center appointed Andrew F. Christie as the sole panelist in this matter on November 17, 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, together with its affiliated companies, Formula One Asset Management Limited (“FOAM”), and Formula One World Championship Limited, make up the Formula 1 group of companies. The Federation Internationale de l’Automobile (“FIA”) established the Formula One World Championship (“F1 Championship”) in 1950. Each year, approximately 23 F1 Championship races are held throughout the world. Each race is usually attended by over 250,000 people, with on average 4.2 million race attendees annually. The races are televised and have attracted around 425-600 million viewers annually since 2005, with broadcasts in around 189 countries.

FOAM owns commercial rights in the F1 Championship. The Complainant is the owner of thousands of registrations around the world for trademarks consisting of or containing F1, including United Kingdom registration UK00906747877 for the word trademark F1 (filed March 12, 2008; entered on the register January 20, 2009).

The disputed domain name was registered on January 3, 2020. The disputed domain name was previously used to resolve to a website run by a company called Lifestyle Media House Ltd (“Lifestyle”), which was the Complainant’s licensee. The Lifestyle license was terminated on March 4, 2021, but the disputed domain name was not returned to the Complainant, and the site remained active for a period. As from July 2021, the company Lifestyle is currently in liquidation. The Complainant engaged a third-party web enforcement agency to have certain unauthorized uses of the Complainant’s intellectual property removed from the website resolving from the disputed domain name in March 2021. The Whois records for the disputed domain name were updated in May 2022 and November 2023. The Complainant puts forward that it sent a letter to Lifestyle and its administrator in July 2023, but did not receive a reply.

The Complainant has provided an undated screenshot of the website resolving from the disputed domain name, showing that it included a tab on the home page for “Best Betting Sites Canada” which purportedly resolved to a website with click-through links to a number of betting agency sites. Per the Internet Archive Wayback Machine, in December 2021 the disputed domain name resolved to a “403 Forbidden” error page, and at times in 2022 the disputed domain name resolved to a website that claimed to be “THE OFFICIAL FORMULA 1® MAGAZINE”. At the time of this decision – and per the Wayback Machine since at least October 2023 – the disputed domain name resolves to a webpage headed “Magazine World A Better Mind”, the sole substantive content of which is an essentially meaningless short post entitled “Importance of Books: Unveiling the Key to Knowledge and Growth”.

#### **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.

The Complainant made the following contentions, among others, to establish that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The disputed domain name comprises an identical reproduction of the Complainant’s F1 registered trademark, preceded by the word “the” and followed by the word “magazine”, together with the generic Top-Level Domain (“gTLD”) “.com”. The term “magazine” is the same term used in the official website that was previously licensed by the Complainant. The gTLD “.com” can be disregarded. The continued use by the Respondent of the disputed domain name following the termination of the license increases the false association between the Respondent and the Complainant.

The Complainant made the following contentions, among others, to establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The license with Lifestyle was terminated in March, 2021. There is no relationship, connection and/or affiliation between the Complainant and the Respondent which provides any rights, licenses and/or permissions of any kind to the Respondent and which would entitle the Respondent to incorporate and use the F1 trademark in the disputed domain name, or in any trading activities. No *bona fide* use of the disputed domain name can be claimed by the Respondent as, prior to this Complaint, the Complainant has attempted to contact the Respondent requesting the removal of the disputed domain name or its return to the Complainant following the termination of the license with Lifestyle. The Respondent's details were initially hidden by a privacy shield. The disputed domain name has not been set up for legitimate noncommercial or fair use purposes because the website resolving from it appears to be operating as a commercial betting website whilst still utilizing the Complainant's famous F1 trademark.

The Complainant made the following contentions, among others, to establish that the disputed domain name was registered and is being used in bad faith. The use of the disputed domain name incorporating the Complainant's registered trademark is an attempt to attract, for commercial gain, users to the website by creating a likelihood of confusion with the Complainant's F1 trademark as to the source, affiliation and/or endorsement of the website or of a product on the website. The registration of the disputed domain name is a deliberate attempt by the Respondent to benefit from the Complainant's success and, in the process, divert customers from the Formula 1 group of companies and their authorized licensees. The update in May 2022 is as the result of a change in registration ownership. The use by the Respondent of the Complainant's F1 trademark, including the F1 logo and other intellectual property, highlights that the Respondent is fully cognizant of the Complainant as part of the Formula 1 group of companies and their businesses. Following the termination of the license with Lifestyle on March 4, 2021, no continued use of the disputed domain name was authorized by the Complainant, and no authorization was given for updating the registration of the disputed domain name on May 20, 2022.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

Once the gTLD ".com" is ignored (which is the typical rule and is indeed appropriate in this case), the disputed domain name consists of the Complainant's registered word trademark F1 preceded by the word "the" and followed by the word "magazine".

The Complainant's trademark is clearly recognizable within the disputed domain name.

The additional terms do not avoid a finding of confusing similarity of the disputed domain name with the Complainant's trademark.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

### **B. Rights or Legitimate Interests**

The Respondent is not a licensee of the Complainant, is not otherwise affiliated with the Complainant, and is not authorized by the Complainant to use its F1 trademark. The Respondent has not provided any evidence that it has been commonly known by, or has made a *bona fide* use of, the disputed domain name, or that it has, for any other reason, rights or legitimate interests in the disputed domain name.

While the disputed domain name previously resolved to a website displaying the Complainant's trademark under license, that license is now terminated.

The Complainant has provided a screenshot of the website resolving from the disputed domain name, showing that it included a tab on the home page for "Best Betting Sites Canada" which resolved to a website with click-through links to a number of betting agency sites.

At the time of this decision, the disputed domain name resolves to a webpage headed "Magazine World A Better Mind", the sole content of which is an essentially meaningless short post entitled "Importance of Books: Unveiling the Key to Knowledge and Growth".

Given the confusing similarity of the disputed domain name to the Complainant's trademark, the absence of any current relationship between the Respondent and the Complainant, and the risk of implied false affiliation with the Complainant, the Respondent's present use of the disputed domain name is neither a *bona fide* use nor a legitimate noncommercial or fair use.

The Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the Respondent has not rebutted this. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

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

The disputed domain name was first registered in January 2020. The Whois information for the disputed domain name stated that the registrant's name was redacted for privacy. The Complainant alleges that there was a change in registration details for the disputed domain name in May 2022. As stated in section 3.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)): "In cases where the domain name registration is masked by a privacy or proxy service and the complainant credibly alleges that a relevant change in registration has occurred, it would be incumbent on the respondent to provide satisfactory evidence of an unbroken chain of registration; respondent failure to do so has led panels to infer an attempt to conceal the true underlying registrant following a change in the relevant registration. Such an attempt may in certain cases form part of a broader scenario whereby application of UDRP paragraph 4(b)(iv), read in light of paragraph 4(a)(ii), can support an inference of bad faith registration for the respondent to rebut. Facts or circumstances supporting an inference that a change in registrant has occurred may typically include a change in the content of the website to which a domain name directs to take advantage of the complainant's mark or unsolicited attempts to sell the domain name to the complainant only following such asserted change in registrant."

The Complainant's assertion of a change in registration – noting the fact that the original registrant is now in insolvency and that there has been a change in website content following termination of the relevant license – is credible, and the Respondent has not provided any evidence of an unbroken chain of registration; indeed, the Respondent has not responded in any way to the Complaint. At a minimum, if the original registrant were the current registrant (and therefore Respondent) one would expect them to reply to the Complaint at least to explain who they are and their relation to the disputed domain name. In these circumstances, it is appropriate to infer, and the Panel does infer, that there has been a change in registration of the disputed domain name.

The Panel also notes, for completeness, that none of the individuals listed in the Companies House data for Lifestyle (either as an officer of the corporation/person with significant control, or in terms of its insolvency trustees) correspond to the Respondent name, and an Internet search does not reveal any such link.

It is inconceivable that the current registrant, the Respondent, registered the disputed domain name ignorant of the existence of the Complainant's trademark, given that the disputed domain name consists of the Complainant's trademark with the mere addition of a term describing a service that was provided using the disputed domain name until the termination of the license to do so. Given the Respondent's lack of rights or legitimate interests in the disputed domain name and the confusing similarity of the disputed domain name to

the Complainant's trademark, any use of the disputed domain name by the Respondent almost certainly implies an affiliation with the Complainant that does not exist. The Respondent's registration of the disputed domain name in these circumstances is a bad faith registration.

Furthermore, the evidence on the record provided by the Complainant indicates that the Respondent has used the disputed domain name in an attempt to attract, for commercial gain, Internet users to a website by creating confusion in the minds of the public as to an association between the website and the Complainant. The Respondent's use of the disputed domain name in this manner is a bad faith use.

## **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, <thef1magazine.com>, be transferred to the Complainant.

*/Andrew F. Christie/*

**Andrew F. Christie**

Sole Panelist

Date: December 1, 2023