

ADMINISTRATIVE PANEL DECISION

OneFootball GmbH v. Privacy Department, IceNetworks Ltd.
Case No. D2024-3259

1. The Parties

The Complainant is OneFootball GmbH, Germany, represented by Thomas Rechtsanwälte, Germany.

The Respondent is Privacy Department, IceNetworks Ltd., Iceland.

2. The Domain Name and Registrar

The disputed domain name <one-football.com> is registered with Internet Domain Service BS Corp (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 8, 2024. On August 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 12, 2024, 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 (Whois Privacy Corp.) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 14, 2024, 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 amendment to the Complaint on August 20, 2024.

The Center verified that the Complaint together with the amendment to the 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 August 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 11, 2024.

The Center appointed Jeremy Speres as the sole panelist in this matter on September 20, 2024. 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 operates a sports media service under its ONEFOOTBALL mark covering football from its website operated using the domain name <onefootball.com>, which was registered in 2004. It also operates a store where customers can purchase merchandise featuring its ONEFOOTBALL mark from the same domain name.

The Complainant owns various registrations for its ONEFOOTBALL mark, including:

- European Union Trademark Registration No. 012456083 OneFootball in classes 9, 16, 35, 38, and 42, having a registration date of May 14, 2014; and
- European Union Trademark Registration No. 018126567 ONEFOOTBALL and device in classes 9, 35, 38, 41, and 42, having a registration date of March 4, 2020.

Importantly for the purposes of this matter, the latter registration includes a device featuring the legs of a footballer with a football in front of them, with the left leg cocked backwards apparently about to strike the ball.

The disputed domain name was registered on November 23, 2022, and presently resolves to a website entitled "ONE FOOTBALL" featuring a logo incorporating a footballer with a football in front of them, with their left leg cocked backwards in striking position. The website offers football jerseys for sale.

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 the disputed domain name was registered and used in bad faith to attract Internet users to its website for commercial purposes by creating a likelihood of confusion with the Complainant's well-known mark.

B. Respondent

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

6. Discussion and Findings

A. 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.

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 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. Although the addition of other elements, here a hyphen, may bear on the assessment of the second and third elements, the Panel finds this addition does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy, which remain almost identical despite the hyphen. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

For the reasons discussed in relation to bad faith below, it is likely that the Respondent acquired the disputed domain name to take advantage of confusion with the Complainant’s mark. The Respondent’s acquisition and use of the disputed domain name in these circumstances cannot represent a bona fide offering of goods or services under paragraph 4(c)(i) of the Policy and cannot confer rights or legitimate interests. *Sistema de Ensino Poliedro Vestibulares Ltda., Editora Poliedro Ltda. v. Anonymize, Inc. / STANLEY PACE*, WIPO Case No. [D2022-1981](#).

The Panel finds the second element of the Policy has been established.

C. 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.

For the following reasons, the Panel finds that it is more likely than not that the Respondent registered and has used the disputed domain name to take advantage of confusion with the Complainant’s mark for the Respondent’s commercial gain, falling squarely within paragraph 4(b)(iv) of the Policy.

The Complaint contends that its ONEFOOTBALL mark was well known and exclusively associated with the Complainant prior to registration of the disputed domain name. In the interests of justice, and in accordance with its powers of independent research ([WIPO Overview 3.0](#), section 4.8), the Panel conducted its own cursory online searches with a view to establishing whether the Complainant’s mark may have been well known prior to registration of the disputed domain name. The results of an Internet search, time limited to

websites published prior to registration of the disputed domain name, predominantly relate to the Complainant. Many news articles concerning the Complainant had been published at that stage. According to evidence gleaned from the Google Play Store (concerning the Complainant's ONEFOOTBALL app) and the Internet Archive (concerning the Complainant's website operated from its domain name <onefootball.com>), it appears that the Complainant has been in operation since at least 2011, if not earlier.

The Panel therefore accepts that the Complainant's mark was well known prior to registration of the disputed domain name. UDRP panels have consistently found that registration of a domain name that is confusingly similar to a famous or well-known trademark (as in this case) by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

The Respondent's website includes a footballer device as part of its logo that is highly reminiscent of the Complainant's own logo featuring the legs of a footballer, and a football, in a very similar style and position, which is strongly suggestive of targeting.

Internet search results for the second level portion of the disputed domain name predominantly relate to the Complainant, including when time limited as aforesaid. Coupled with the facts that the Complainant's mark appears to be inherently distinctive and was well known prior to registration of the disputed domain name, this suggests that it is unlikely that the Respondent, operating in the same industry, was not aware of the Complainant and the potential for confusion, or that the Respondent at least should have known this. [WIPO Overview 3.0](#), section 3.2.2.

The Panel has independently established that at least two security vendors have flagged the disputed domain name for malicious activity, which is a further indicator affirming the Panel's finding of bad faith. *The Commissioners for HM Revenue and Customs v. WhoisGuard Protected, WhoisGuard, Inc. / Hoshyar Marshall*, WIPO Case No. [D2021-0344](#).

It would appear that the underlying registrant details for the disputed domain name, per the Whois record, are those of a privacy service, at least in part. These underlying details were revealed by the Registrar, after disclosing that the initial registrant details included in the Whois record were also those of another privacy service. This would thus appear to be a multi-layered "Russian doll" obfuscation scenario, which is a further indicator of bad faith. [WIPO Overview 3.0](#), section 4.4.6.

The Panel draws an adverse inference from the Respondent's failure to reply to the Complainant's contentions, where an explanation is certainly called for. [WIPO Overview 3.0](#), section 4.3.

The Panel finds that the Complainant has established the third element 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 <one-football.com> be transferred to the Complainant.

/Jeremy Speres/

Jeremy Speres

Sole Panelist

Date: October 4, 2024