

ADMINISTRATIVE PANEL DECISION

Tottenham Hotspur Limited v. Tony Fliet

Case No. D2022-4038

1. The Parties

The Complainant is Tottenham Hotspur Limited, United Kingdom, represented by Walker Morris Solicitors, United Kingdom.

The Respondent is Tony Fliet, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <tottenhamfantoken.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 27, 2022. On October 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 28, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 31, 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 amendment to the Complaint on November 1, 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 November 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 25, 2022.

The Center appointed Luca Barbero as the sole panelist in this matter on November 30, 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 is an English professional football club, founded in 1882 and which competes in the Premier League, the top-flight of English football. The Complainant's team is traditionally referred to as Tottenham Hotspur or "Spurs" for short. The Complainant has enjoyed significant success both in the United Kingdom and internationally and enjoys a global fan-base.

The Complainant is the owner of several trademark registrations for TOTTENHAM HOTSPUR, including the following, as per trademark certificates submitted as annexes to the Complaint:

- United Kingdom trademark registration No. UK00904563292 for TOTTENHAM HOTSPUR (word mark), filed on July 28, 2005, and registered on July 07, 2006, in classes 26, 27, 30, 35, 38, 39, 41, and 43;

- United Kingdom trademark registration No. UK00911681459 for TOTTENHAM HOTSPUR (word mark), filed on March 22, 2013, and registered on November 20, 2013 in classes 3, 6, 8, 9, 10, 11, 12, 14, 16, 18, 19, 20, 21, 24, 25, 26, 27, 28, 30, 31, 32, 33, 34, 35, 36, 38, 39, 41, 42, 43, and 45.

The Complainant owns and operates its main website at <tottenhamhotspur.com>, which was registered on December 17, 1999, and is used by the Complainant to promote its football club, team, and services.

The disputed domain name <tottenhamfantoken.com> was registered on November 15, 2021, and is currently pointed to a parking page with pay-per-click links related to the sale of digital tokens. According to the screenshot submitted as Annex 8 to the Complaint - which was not challenged by the Respondent - prior to the start of the present proceeding, the disputed domain name was pointed to a website displaying images of the Complainant's football club in association to the sale of digital tokens.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to the trademark TOTTENHAM HOTSPUR in which the Complainant has rights, highlighting that the distinctive element of the disputed domain name is the word "Tottenham", with the remaining words "fan" and "token" being considered mere descriptive terms.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent has no rights or legitimate interests in the disputed domain name since he is not commonly known by the disputed domain name and owns no relevant registered trademarks rights. Moreover, the Complainant underlines that the disputed domain name directly refers to the fraudulent sale and purchase of illegitimate digital tokens in the name of the Complainant, that can only be used or sold in reference to the Complainant.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondent is using the disputed domain name in a manner that directly seeks to disrupt the business of the Complainant and is in any event detrimental to the Complainant's business. The Complainant submits that the Respondent in fact appears to offer for sale illegitimate digital tokens in the name of the Complainant, clearly increasing the risk of fraud being committed against the Complainant's fans and customers, who may be misled in purchasing illegitimate digital tokens and may consequently raise complaints against the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

The Complainant has provided evidence of ownership of numerous trademark registrations for TOTTENHAM HOTSPUR in several countries of the world, as mentioned under Section 4 above.

As highlighted in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. In addition, as stated in section 1.8 of the [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". Moreover, as indicated in section 1.11 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

The Panel finds that the disputed domain name is confusingly similar to the trademark TOTTENHAM HOTSPUR as it reproduces the dominant portion of the trademark "Tottenham", with the mere addition of the dictionary terms "fan" and "token" and the gTLD ".com", which in the Panel's view does not prevent a finding of confusing similarity.

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

It is well established that the burden of proof lies on the complainant. However, satisfying the burden of proving a lack of the respondent's rights or legitimate interests in respect of the domain name according to paragraph 4(a)(ii) of the Policy is potentially onerous, since proving a negative can be difficult considering such information is often primarily within the knowledge or control of the respondent.

Accordingly, in line with previous UDRP decisions, it is sufficient that the complainant show a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production on the respondent. If the respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the

complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In the case at hand, by not submitting a Response, the Respondent has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademark. Moreover, there is no evidence that the Respondent might be commonly known by the disputed domain name.

As highlighted above, the disputed domain name is currently pointed to a parking page with pay-per-click links related to the sale of digital tokens whilst, prior to the start of the present proceeding, it resolved to a website displaying images of the Complainant's football club in association to the sale of digital tokens.

The Panel finds that the above-described use of the disputed domain name made by the Respondent does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name without intention to misleadingly divert the consumers or to tarnish the Complainant's trademark.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

The Panel finds that, in light of the fact that the Complainant's football club and its trademark TOTTENHAM HOTSPUR have been known internationally since several years before the registration of the disputed domain name – which occurred only in November 2021 - the Respondent was more likely than not aware of the Complainant's trademark at the time of registration.

In light of the composition of the disputed domain name, which combines the dominant element of the Complainant's trademark "Tottenham" with the word "fan", it is clear that the Respondent registered the disputed domain name with the intention to refer to the Complainant's trademark and football club and not to the city of Tottenham.

Furthermore, the Panel notes that the disputed domain name, currently pointed to a parking page with links related to the sale of digital tokens, resolved, prior to the present proceeding, to a website displaying images of the Complainant's football club in association to the sale of digital tokens, which further indicates that the Respondent was clearly aware of the Complainant and its trademark.

The Panel also finds that that the Respondent's use of the disputed domain name described above amounts to bad faith under paragraph 4(b)(iv) of the Policy, since the Respondent intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the website and the products and services advertised therein.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to 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 <tottenhamfantoken.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: December 19, 2022