

1. The Parties

The Complainant in this administrative proceeding is The Liverpool Football Club and Athletics Grounds Limited, Anfield Road, Anfield L40TH, Merseyside, Liverpool, United Kingdom. The Complainant is represented by Richard Ferguson, Stobbs IP Ltd, Building 1000, Cambridge Research Park, Cambridge, CB25 9PD, United Kingdom

(Email: liverpoolfc@iamstobbs.com, Richard.fergusons@iamstobbs.com, enforcement@iamstobbs.com, Telephone +44(0) 1223 435240).

The Respondent is Adarsh Karle, B1504, Mantri Astra, Chelkere, Bangalore, Karnataka 500062 (Telephone: (91).9886844846, E-Mail: adarsh.ak@gmail.com),

2. Domain Name and Registrar

(i) The disputed domain name is <liverpoolfc.in>.

(ii) The Registrar with whom the domain name is registered is GoDaddy, LLC, 2155 East, GoDaddy Way Tempe, AZ 85284, United States.

3. Procedural History

The arbitration proceedings is in accordance with the .IN Domain Name Dispute Resolution Policy (the policy) adopted by National Internet Exchange of India ("NIXI") and INDRP Rules of Procedure ("the Rules") which were approved on June 28, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering disputed domain name with a NIXI registrar, the respondent agreed to the resolution of disputes pursuant to the Policy and the Rules.

As per the information received from NIXI, the history of the proceedings is as follows:



On March 2, 2023, I submitted the statement of Acceptance and Declaration of Impartiality and independence, as required by NIXI to ensure compliance with Paragraph 6 of Rules. NIXI notified the parties of my appointment as Arbitrator via email on March 1, 2023 and served an electronic copy of the complaint on the Respondent. I informed the Parties about commencement of arbitration proceedings on March 2, 2023 and the Respondent was directed to submit a response within 7 (Seven) days. The Respondent did not submit any response to the arbitration notice within the stipulated time and was given further time of 5 (Five) days to submit his response to the arbitration notice issued through email dated 2.3.2023. The Complainant submitted on 12.03.2023 to suspend these arbitration proceedings as the Complainant was negotiating with the Respondent for transfer of disputed domain name. The request of the Complainant was accepted and on 13.03.2023 the arbitration proceedings were suspended for two weeks. The proceedings were revoked on 17.3.2023 on request of the Complainant. The Respondent sent communication on 17.03.2023 that he has unconditionally handed over the disputed domain name to the Complainant.

4. Grounds for Administrative Proceedings

1. The disputed domain name is identical or confusingly similar to trademark or service marks in which complainant has rights
2. The Respondent has no rights or legitimate interests in the disputed domain name.
3. The Respondent has registered and being used the domain name in bad faith.

5. Background of the Complainant

The Complainant is a professional football club based in Liverpool, United Kingdom. The Complainant submitted that the club was founded in 1888 , is now one of the most widely supported football clubs in the world and the club had established itself as a major force in English and European football in the 1970s and 1980s. The Complainant further submitted that the Complainant jointly owns the company LiverpoolFC.TV Ltd



alongside Granada Media plc, who are the largest company in the United Kingdom within the commercial television sector, and who have been licensed by the Complainant to utilise the Complainant's trade marks and brand online since the early 2000s. The Complainant further submitted that the domain name <liverpoolfc.tv> had been used for the purposes of a website at www.liverpoolfc.tv since as early as 2000, serving as the official website for the Complainant at the time, and which provides news, statistics and other information on the club, as well as selling match tickets and club merchandise. The Complainant further submitted that in 2002, the Complainant began to utilise the domain name <liverpoolfc.com> as its primary website for the club, initially as a redirect to www.liverpoolfc.tv, and then as a website at www.liverpoolfc.com in its own right. The Complainant submitted that based on website traffic analysis made available for period April 2021 – September 2021, www.liverpoolfc.com generates an average 7.8 million visitors every month, from various locations worldwide, and almost half of all visits originating from United Kingdom based internet users and aside from <liverpoolfc.tv> and <liverpoolfc.com>, the Complainant owns various other domain names comprising of the LIVERPOOL FC term, which stem back to as early as 1996. The Complainant further submitted that the Complainant's impressive internet presence can thus be traced back over 20 years, the <liverpoolfc.co.uk> domain having been registered within less than a decade of the inception of the domain name infrastructure of the late 80s. The Complainant further submitted that the Complainant's significant internet presence under the LIVERPOOL FC name is further demonstrated by a variety of social media accounts acquired and registered under handles "@liverpoolfc" and these accounts have generated a substantial fan following, with over 18 million followers on Twitter, 33 million on Instagram, and over 40 million on Facebook. The Complainant further submitted that the Complainant's business and brand has partnered and collaborated with a variety of household names over the years, which included Standard Chartered, Nike, Axa, Expedia, Carlsberg, EA Sport and Cadbury. The Complainant further submitted that the Complainant's brand has a variety of revenue streams and in 2018/2019, the club earned approximately 299.3 million euros from broadcasting. The Complainant further submitted that the commercial revenue stream is the second largest, amounting to 210.9 million euro in 2018/2019, and 243.4 million in 2019/2020, and includes revenue generated from the sale of sport clothing and other branded merchandise and these



goods are predominantly being offered and sold via the Complainant's main website at www.liverpoolfc.com and via other authorised merchants and online outlets. The Complainant further submitted that the Complainant and its LIVERPOOL FC brand have substantial reputation in India, with an enormous fandom nationwide. The Complainant further submitted that the Complainant was formerly affiliated with the Indian professional football club DSK Shivajians between 2013 and 2015, as part of a launch of an international football academy. The Complainant further submitted that in 2014, LIVERPOOL FC was voted "the most trusted football brand in India" and publicly commented on as 'India's "No.1 club"', following a Brand Trust Report India Study in 2014 and the project generated nearly five million data points and studied over 20,000 brands, making it the most intensive study on Brand Trust anywhere in the world. In 2016, the Player Development Centre was launched in India by the Complainant, as the first official Liverpool FC coaching programme in India, outside of the year-round Liverpool FC International Academy - DSK Shivajians residential programme. The Centre is based on Mundhwa, Pune, with the programme running three times a week. The Complainant further submitted that as of 2022, the Complainant has a vast social media presence across the country, as seen by the various social media accounts operated by its numerous official supporter's clubs based in various locations in India. The Complainant further submitted that the Complainant also offers various branded merchandise at its online store made accessible to internet users worldwide at <https://store.liverpoolfc.com> and the store facilitates shipping to India and the Complainant's products under the LIVERPOOL FC brand are also widely offered to consumers in India via other online channels, such as, via www.amazon.in. The Complainant further submitted that the Complainant and the LIVERPOOL FC name were widely known in India and held substantial reputation, at the time of the Disputed Domain Name was registered by the Respondent. The Complainant submitted that they have registered trade marks for LIVERPOOL FC pre-dating the registration of the Disputed Domain Name, substantial, goodwill in the LIVERPOOL FC name dating as far back as the 1970s and evidence of heightened commercial activity in India since 2013.

The Respondent

The Respondent is ADARSH KARLE , B1504, Mantri Astra, Chelkere, Bangalore, Karnataka 500062 (Telephone: +91-9886844846, E-Mail: adarsh.ak@gmail.com).The Respondent



has registered nearly identical disputed domain name <liverpoolfc.in> on Dec 9, 2015.

6. Legal Grounds

The Complainant submitted that the Complainant notes that the Disputed Domain Name was registered in 2015, however the doctrine of 'laches' does not apply in domain disputes and this has been applied in other domain dispute policies, such as the UDRP process, where the WIPO Overview 3.0, section 4.17 states that panels: 'have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits.'. The Complainant further submitted that the INDRP has also applied this same principle in cases such .The Complainant has relied on Subway Inc. v. Ramaswamy Nathan. INDRP Case No. 1151/2019, where panelist Vinod K. Agarwal applied the comments in National Association for Stock Car Auto Racing, Inc. v. Racing Connection / The Racin' Connection, Inc. WIPO Case No. D2007-1524 that: '...the equitable defense of laches does not properly apply in this Policy proceeding. The remedies under the Policy are injunctive rather than compensatory in nature, and the concern is to avoid ongoing or future confusion as to the source of communications, goods, or services.' The Complainant submitted that the doctrine of laches should not apply in these proceedings. 'POLICY' aims to resolve the domain names disputes to avoid future conflict between the parties. This panel accepts the submissions of the Complainant as the 'POLICY' does not bar filing of complaint on account of delay between registration of disputed domain name and filing of complaint by the Complainant.

A. The domain name <liverpoolfc.in> is nearly identical or confusingly similar to mark or services in which the Complainant has rights.

Complainant's Contentions

The Complainant contended that the Disputed Domain Name wholly incorporates the trade mark "LIVERPOOL FC" in its entirety, with no additional elements. The Complainant that the Panel omit the suffix extension 'in' as this is merely a technical requirement for domain names in India. The Complainant has relied on Urban



Outfitters, Inc. v. Machang. INDRP Case No. 601/2014. The Complainant further contended that the Complainant does not rely on rights in the term "LIVERPOOL" alone as the Complainant owns numerous trade mark registrations comprising of "LIVERPOOL FOOTBALL CLUB", "LIVERPOOL FC" and "LFC". The Complainant contended that the INDRP does not explicitly mention where the trade mark rights need to be registered, but merely requires rights to be present at the time of filing the INDRP complaint. The Complainant submitted that there have been recent 11 decisions where the complaining party has relied on UK and EUTM rights, which were held to be sufficient for the purposes of establishing 'rights' in a INDRP dispute concerning the domain . The Complainant has relied on What3Words Limited v. Vinit Saxena INDRP Case No. 1229/2020. The Complainant further submitted that the Complainant owns earlier UK and EU rights in the LIVERPOOL FC name. The Complainant further submitted that it is evident from the LIVERPOOL FC brand's active trading in India pre-dating the registration of the Disputed Domain Name, that it enjoys goodwill and a reputation and with that, unregistered or common law trademark rights. The Complainant submitted that the LIVERPOOL FC mark has become a distinctive identifier which consumers associate with the Complainant's goods and/or services and accordingly, LIVERPOOL FC is the name in which the Complainant has rights.

Respondent's Contentions

The Respondent has unconditionally handed over the disputed domain name to the Complainant.

The Respondent has no rights or legitimate interests in the Disputed Domain Name

Complainants Contentions

The Complainant submitted that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name. The Complainant submitted that under Policy, Paragraph 6 of the INDRP Policy, the Complainant acknowledges that a Respondent may demonstrate a right or legitimate interest in the domain name if it can be established that:

- The Respondent's use of the Disputed Domain Names or a name corresponding to the Disputed Domain Names is in connection with a bona fide offering of goods or services;



- The Respondent has been commonly known by the Disputed Domain Names, even if they have acquired no trade mark or service mark rights;or

- The Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Names, without intent or commercial gain to misleadingly divert consumers.

The Complainant contended that based on the Complainant's reputation, there is no believable or realistic reason for registration or use of the Disputed Domain Name other than to take advantage of the Complainant's rights. The Complainant submitted that the Disputed Domain Name has resolved to a website which contained links to services either relating to the Complainant ("Lfc Merchandise"), or football clubs (and brands therein) in competition with that of the Complainant (Chelsea Merchandise). The Complainant contended that by using the Disputed Domain Name to resolve to such content, it is clear that the Respondent knew of the Complainant's LIVERPOOL FC brand and has more likely than not, set the Disputed Domain Name up to try and profit from the redirection through click-through revenue and such use of a domain does not constitute a bona fide offering of goods and/or services. The Complainant submitted that to the best of their knowledge, the Respondent has never legitimately been known as 'LIVERPOOL FC' at any point in time. The use of the Complainant's LIVERPOOL FC trade mark in the domain name which is an indicator of trade origin of the Complainant and the Complainant alone, further used to host a website featuring pay-per-click ads mentioning the Complainant as promoting related goods and services leads the Complainant to conclude that the only reason why the Respondent registered the Disputed Domain Name was to take advantage of the Complainant's goodwill and valuable reputation and no other logical or reasonable conclusion can be gleaned.

The Complainant submitted that nothing about the Disputed Domain Name suggests that the Respondent is making a legitimate non-commercial or fair use. The Complainant further submitted that the Disputed Domain Name has been previously set up to feature click-ads, evidencing the Respondent's attempt to capitalize on the brand value of the Complainant's LIVERPOOL FC brand and the use of the pay-per click advertisement creates monetization revenue for the Respondent from internet

A handwritten signature in black ink, appearing to be "J. B. P.", is written over a horizontal line at the bottom right of the page.

users' visits to content featured at the Disputed Domain Name. The Complainant has relied on *Lululemon Athletica Canada, Inc vs Liheng Just Traffic Supervision Consulting* (<lululemon.in>) wherein it was held that "monetized domain parking without the domain being associated with any e-mail or website service cannot be said to be bona fide and active use of the domain, particularly when that domain almost entirely consists of somebody else's well known trade mark" and therefore, the Respondent cannot come within Policy, Paragraph 6(c) of the INDRP Policy.

Respondent's Contentions

The Respondent has unconditionally handed over the disputed domain name to the Complainant.

The domain name was registered and is being used in bad faith.

Complainants Contentions

The Complainant submitted that the Disputed Domain Names have been registered and used in bad faith in accordance with Policy, Paragraph 7. The Complainant reiterates their comments that the LIVERPOOL FC brand is established worldwide and therefore, the Complainant submits that the Respondent had knowledge of the Complainant's LIVERPOOL FC brand and that the Disputed Domain Name was registered with the Complainant in mind. The Complainant submitted that the Respondent has registered the Disputed Domain Name in bad faith by intentionally attempted to attract Internet users to their website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location (as per INDRP Policy Paragraph 7(c)). The Complainant further submitted that the Respondent had actual knowledge of the Complainant before and at the time of the registration, and that the Disputed Domain Name was registered with prior knowledge of the Complainant's LIVERPOOL FC brand. The Complainant further submitted that the Disputed Domain Name was registered with the sole purpose of creating an association with the Complainant, which is highlighted by the Respondent's use of the Disputed Domain Name for the purposes of pay-per-click advertisements which expressly mention the Complainant's brand and/or contain URLs to a competitor football club of the Complainant.

A handwritten signature in black ink, appearing to read "S. Sengupta", is written over a horizontal line at the bottom right of the page.

7. Discussion and findings

The Complainant Liverpool Football Club and Athletics Grounds Limited founded in 1888 is a football club based in Liverpool, United Kingdom. The Complainant is a football club having a strong presence in UK and other European Countries. The Complainant has also significant presence in India where the Respondent is based. The Complainant is also in business of broadcasting and selling of sports clothings beside other business merchandises. The Complainant has also collaborated with popular brands. The Complainant is owner of livepoolfc.tv and liverpoolfc.com which were registered many years prior to registration of disputed domain in October 2015 by the Respondent. The Complainant is generating substantial revenues from broadcasting and sale of sports clothings etc through their website and other online platforms. The Complaint has strong social media presence. The Complainant is also the owner marks Liverpool, Liverpool football club and LiverpoolFC. These marks a constitute invaluable intellectual property which need to be protected against misuse by unauthorized persons. The disputed domain name <liverpoolfc.in> contains the Complainant's mark 'LIVERPOOLFC' in full and is almost identical to mark of the Complainant. The top level domain ".in" is irrelevant and does little to make it different. The Complainant has not licensed , authorized or given consent to the Respondent to use/utilize the Complainant's registered trademark in any manner. The nearly identical disputed domain is likely to be taken as business associates of the Complainant by ordinary internet users. The Complainant has continuously used the "marks" for many years before registration of disputed domain name by the Respondent. The Respondent appears to have prior knowledge of "the marks" of the Complainant. The purpose of the Respondent appears to profit from the reputation of the Complainant by



registering a nearly identical domain. The Respondent has unconditionally over handed over the disputed domain name to the respondent

The domain name <liverpoolfc.in> is nearly identical or confusingly similar to trademark or service mark in which the Complainant has rights.

The Complainant has been able to prove that it has trademark rights and other rights in marks 'LIVERPOOLFC' by submitting substantial documents. The marks are widely used by the Complainant in different advertising, marketing and promotion through different channels. The disputed domain contains name which is nearly identical to mark 'LIVERPOOLFC' as the disputed domain contains <LIVERPOOLFC.IN> Complainant's mark completely. Addition of top level domain (CCTLD) extension '.in' is insignificant and does little to make it different. There can't be coincidence that the respondent has chosen domain name confusingly similar to the marks of the Complainant. The top level domain <liverpoolfc.com> was registered by the Complainant years before registration of disputed domain <liverpoolfc.in> by the Respondent in 2015. The respondent has unconditionally surrendered the disputed domain name to the Complainant.

Bases on the forgoing analysis, I am of the opinion that the disputed domain name is nearly identical and confusingly similar to the complainant's mark.

The Respondent has no rights or legitimate interests in respect of the Domain Name.

The Complainant has been able to prove by submitting evidences that it has legitimate interest in trademark 'LIVERPOOLFC'. The Respondent is neither a licensee nor authorized by the Complainant, to use Complainant's mark. The Respondent is not known by the mark and can't have legitimate interest in the disputed domain. The Respondent should have come forward with evidence to show his legitimate interest by rebutting the contentions of the Complainant. The Respondent is involved in soliciting customers to

A handwritten signature in black ink, appearing to read "S. S. S.", is written over a horizontal line.

websites having similar business to that of the Complainant. The Respondent failed to submit his response to justify legitimate non commercial use of disputed domain name. This panel is of the view that mere registration of domain name can't establish rights in disputed domain. According to the Policy that "once the Complainant makes a prima facie showing that the registrant does not have rights or legitimate interests in the domain name, the burden shifts to the registrant to rebut it by providing evidence of its rights or legitimate interests in the domain name". The burden of proof to establish any legitimate interest falls on the respondent. The Respondent could have invoked any of the circumstances set out in paragraph 6 of the Policy, in order to demonstrate rights or legitimate interests in the Disputed Domain Name but the Respondent has not filed any response to justify the legitimate interests in the disputed domain name to rebut the contentions of the Complainant. The Respondent has unconditionally handed over the disputed domain name to the Complainant.

Therefore, in light of complaint and accompanying documents, I am therefore of the opinion that the Respondent has no rights or legitimate interest in the disputed domain name.

The Domain Name was registered or is being used in bad faith

This can't be a coincidence that the Respondent registered disputed domain name fully incorporating well known mark of the Complainant. The Complainant has been the using the mark for several years before registration of the disputed domain name in 2015 by the Respondent. The panel finds that the Respondent has used the mark LIVERPOOLFC of the Complainant in disputed domain name giving impression that this site is affiliated to the Complainant. The sole purpose of the respondent is to create confusion to an ordinary internet user. The respondent is using disputed domain to profit from the

A handwritten signature in black ink, appearing to be 'S. S. S.', is written over a horizontal line.

popularity of the Complainant's mark. The intent of the Respondent to profit from the reputation of the Complainant's mark is definitely a bad faith registration use. The Respondent must have done dilly diligence to ensure that domain name registered does not infringe upon someone other's rights. The panel also takes notice of the fact that the Respondent has handed over the disputed domain name to the Complainant.

In view of the above, In view of the above, I am of the opinion that registration of disputed domain name is bad faith.




Decision

Based on the of contentions of the complainant , the attached documents , cited decisions and in view of the above read with all the facts of the present case, the Complainant's contentions are tenable. The test of prudence demands fairness of actions by the Respondent. The Respondent has failed to rebut the Complainant's contentions. The Respondent has unconditionally handed over the disputed domain name to the Complainant. In view of the forgoing discussion, I am of the opinion that the disputed domain name is nearly identical/confusingly similar to the Complainant's marks/domain. The Respondent does not have rights or legitimate interest in the disputed domain name and disputed domain name was registered in bad faith.

In accordance with the Policy and Rules I direct that the Disputed Domain name <liverpoolfc.in> be transferred to the Complainant, with a request to NIXI to monitor the transfer.

The award is being passed within statutory deadline of 60 days from the date of commencement of arbitration proceedings.

No order to costs.

March 23,2023


Sudhir Kumar Sengar

Sole Arbitrator