

CHANNEL ISLANDS DOMAIN DISPUTES

C.I.D.D. DOMAIN DISPUTE SERVICE AND ARBITRATION A TIMELY SERVICE

EMBARGOED FOR GENERAL PUBLICATION UNTIL 4th AUGUST 2017

IN THE CASE OF THE DOMAIN NAME FIFA.GG

2nd August 2017

Federation Internationale de Football Association (“FIFA”), Switzerland.

(Complainant)

- v -

John Roundstone, Petersburg 62675, United States.

(Respondent)

1. This Complaint is submitted by Federation Internationale de Football Association (“FIFA”), represented internally by the Head of Intellectual Property in line with the dispute resolution service (“DRS”) and the Channel Islands Domain Disputes Rules (“C.I.D.D.”) in July 2017 in relation to FIFA.gg.
2. The Respondent according to the Channel Islands Registry is John Roundstone, listed as 79 Almond Lane, Petersburg 62675 and whose details were provided pursuant to the exemptions in the Data Protection (Guernsey) Law 2000, to FIFA.
3. The Federation Internationale de Football (“FIFA”), founded in 1904 in Paris, is the governing body of “association football”, and is the originator and organiser of a number of world soccer championships, including, in particular, the widely known quadrennial world football championship known as the FIFA World Cup™ and also the organizer of the FIFA Interactive World Cup, which is an annual Video gaming competition enabling millions of gamer fans of the “FIFA” computer game series distributed under license by Electronic Arts (“EA”) to compete for the title of being named the best FIFA player.
4. On 31st March 2017, Electronic Arts (“EA”) notified FIFA that Monstar Inc. had approached EA by way of a solicitation to acquire the Domain Name, FIFA.gg.
5. The Complainant advised the Respondent of the Complainant's rights in the trade mark “FIFA” and requesting that the disputed domain name be transferred to the Complainant,

CHANNEL ISLANDS DOMAIN DISPUTES

C.I.D.D. DOMAIN DISPUTE SERVICE AND ARBITRATION A TIMELY SERVICE

EMBARGOED FOR GENERAL PUBLICATION UNTIL 4th AUGUST 2017

upon reimbursement of reasonable registration and transfer fees (not exceeding out of pocket expenses).

6. It is clear that the Complainant's mark is a famous and Well-Known Marks entitled to special protection.
7. On 27th April 2017 the Respondent, via an alleged representative, Mr. Mike Wolfe, "CMO, Anon Labs" replied to Complainant's letter via email. From the response to the Dispute Resolution Proceedings where John Roundstone states "*The next paragraph expressed by FIFA appears to poke questionability at the use of a personalized business mail for Mr. Mike Wolfe (me)*", it is my view that on the balance of probability, as "Mr Wolfe" has access to the personal e-mail account of the Respondent, Mr Mike Wolfe and Mr John Roundstone are likely to be the same person, although nothing turns on this point.
8. On 08 May 2017, the Complainant was approached so see if they were interested in acquiring the Domain Name and in a series of emails, the Respondent submitted alleged valuations of the FIFA.gg domain citing a recent scaled assessment of US\$74,882,714. 19. This assessment was clearly hopelessly inaccurate and delusional.
9. The Complaint is based on the grounds that the name is Identical or Similar Rights are Infringed (Rule 2.1) and Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name (Rule 2.1.1) and that the Domain Name is identical or confusingly similar to a trade mark in which the Complainant has rights in.
10. The adjudicator accepts that FIFA holds an extensive trade mark rights in FIFA as a result of its portfolio, including event related marks and marks related to the FIFA brand covering various jurisdictions and that the Domain Name, FIFA.gg, is identical and/or confusingly similar to a (number of) trade marks in which FIFA has rights.
11. Since the public whois provides only limited data on the Registrant, the Complainant established bona-fide reasons to obtain the full details of the Registrant. This was provided by the .gg Registry under the exemptions within the Guernsey Data Protection legislation.
12. Subsequently the Complainant obtained further details of the Registrant from a third Party domain information provider, Domain Tools, the data appears to have been collected in

CHANNEL ISLANDS DOMAIN DISPUTES

C.I.D.D. DOMAIN DISPUTE SERVICE AND ARBITRATION A TIMELY SERVICE

EMBARGOED FOR GENERAL PUBLICATION UNTIL 4th AUGUST 2017

breach of the terms and conditions of the Registry and potentially collected in breach of the Guernsey Data Protection legislation. ((It was however provided in accordance with the exemptions within the Guernsey Data Protection legislation). It would normally fall to the adjudicator to consider whether it could to rely upon data collected unlawfully, even if subsequently provided within the exemption.

13. As adjudicator, my concern would be whether a 'Fruits of the Poisoned Tree" argument could be founded to exclude other names identified from the use of potentially unlawfully collected. data from a complaint. Fortunately in this case, no such consideration arises because prior to the third party search, the Complainant had also approached the Registry which provided the full information it held on the Registrant as set out above.
14. The Complainant states that to its knowledge, the Respondent has failed to make any active use of the disputed domain name as a website or email domain but has used it to redirect to another domain name, Flippa.com which sells domain names and where numerous FIFA domain names have been listed for sale in the past.
15. Whilst it is common for websites to list domains for sale without the permission of the owner, the redirection could only occur with the active participation by the Respondent and as a result I conclude that the Respondent has not used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services.
16. Whilst prior domain adjudications within UDRP do not create case-law that adjudicators should consider, this does not apply to Court Cases and the domain name, in the hand of the Registrant, falls within the English High Court definition in the case of BT Plc v One in a Million [1999] FSR1 and NMBA v Freeman [2001] E.B.L.R. 13 case of a name which whilst not inherently leading to passing off is still potentially an instrument of fraud.
17. The Complainant confirms that Respondent has no license or agreement with Complainant permitting use of any of the FIFA trade marks.
18. On 24th July 2017, "John Roundstone" responded in a largely incoherent and unfocused manner. Within that response was an allegation that FIFA failed to deliver certain paper documents which allegation is irrelevant as it is clear that the Respondent knew about and

CHANNEL ISLANDS DOMAIN DISPUTES

C.I.D.D. DOMAIN DISPUTE SERVICE AND ARBITRATION A TIMELY SERVICE

EMBARGOED FOR GENERAL PUBLICATION UNTIL 4th AUGUST 2017

received the C.I.D.D. documentation and had the opportunity to respond to it.

Correspondence from various emails was explained and assertions made about Anon Labs unavailability. These points are of no material relevance to the case.

19. Various points are made about online real estate although properly described, a domain name is an intellectual property right and not a real estate right and in any event the assertions made by the Respondent in this matter are irrelevant to considerations.
20. The Respondent complains about the Complainants behaviour in feigning interest in purchase of the domain name, but this is normal practice for Rights Holders in the case of suspected infringement.
21. The Respondent also complains that FIFA have not disclosed arrangements with EA Games and the adjudicator accepts that any such arrangements are likely to be confidential between the parties and the Complainant's statement referred to in paragraph 14 is adequate for these purposes.
22. The Complainant also states that it has conducted a reverse whois of the Registrant, Mr. John Roundstone revealing numerous other .gg registrations incorporating other well known trade marks. As set out in paragraph 11-13, there are concerns about whether the evidence from the Domain Tools database is admissible.
23. Fortunately, it is standard practice for the adjudicator to request the .gg Registry to provide a list of .gg and .je domains registered by the Complainants and the Respondents prior to looking at the Complaint and any Response. Accordingly, the adjudicator is able to note judicially from the data provided by the .gg Registry registration by the Respondent of various .gg domain names including adidas.gg, att.gg, comcast.gg, ibm.gg, pepsi.gg, playstation.gg, sony.gg, tencent.gg, and toyota.gg and others.
24. The Respondent has not adequately explained these .gg registrations.
25. Accordingly the Respondent has not demonstrated any legitimate non-commercial or fair use of the FIFA.gg domain name nor adequately explained satisfactorily his conduct in registration not provided any grounds that evidence a defence to the Claimants case.

CHANNEL ISLANDS DOMAIN DISPUTES

C.I.D.D. DOMAIN DISPUTE SERVICE AND ARBITRATION A TIMELY SERVICE

EMBARGOED FOR GENERAL PUBLICATION UNTIL 4th AUGUST 2017

26. The Adjudicator also takes into consideration the pattern of active solicitations that the Respondent made to sell the Domain Name at significant costs and to sell to FIFA at significantly above the "out of pocket expenses". The somewhat incoherent correspondence received "on behalf of" the Respondent would tend to clarify that the Respondent has no defence to the Claimants case.
27. It would appear therefore that the Respondent has, on the balance of probability, engaged in a pattern of registering .gg domains related to numerous well-known and famous brands and trade marks.
28. In relation to the FIFA.gg domain name, therefore the Respondent has registered the name as a blocking name, alternatively in bad faith, alternatively as a cyber-squatter.

CONCLUSION

The Adjudicator therefore:

- a) accepts the Complainant's assertion that the use and registration of the Domain Name FIFA.gg in conjunction with Respondent's behaviour represents an abusive or improper registration in the hands of the Respondent; and
- b) In relation to the FIFA.gg domain name, considers that the Respondent has registered the name as a blocking name, alternatively in bad faith, alternatively as a cyber-squatter and
- c) concludes that the Registry should transfer the domain FIFA.gg to the name and ownership of the Complainant.

Nick Lockett

Nick Lockett
Adjudicator
C.I.D.D.
2nd August 2017