WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Milwaukee Radio Alliance, L.L.C. v. WLZR-FM LAZER 103

Case No. D2000-0209

1. The Parties

The Complainant in this matter is Milwaukee Radio Alliance, L.L.C. doing business as WLUM FM 102.1 ("MRA"). MRA operates an FM radio station in the Milwaukee, Wisconsin area.

No response has been filed. The registrant of the at-issue domain name is WLZR-FM LAZER 103 ("LAZER"). The registrant likewise operates an FM radio station in the Milwaukee, Wisconsin area.

2. The Domain Name(s) and Registrar(s)

Network Solutions, Inc. is the registrar for the at-issue domain name WLUM.COM.

3. Procedural History

On or about March 23, 2000, MRA filed its complaint in accordance with the requirements of the Rules and Supplemental Rules. Payment was properly made. The Panel agrees with the Center's assessment that the Complaint complies with the formal requirements of the Rules and Supplemental rules. The Complaint was properly notified in accordance with paragraph 2(a) of the Rules.

No response was filed. The panel at large consisting of a single member properly submitted a Statement of Acceptance and Declaration of Impartiality and Independence. There were no further submissions. The Panel's decision was scheduled for, and delivered on, June 5, 2000.

4. Factual Background

The Panel finds the following uncontested facts:

- MRA is regionally famous for its radio broadcasting and entertainment services. MRA undertakes multiple broadcasting and entertainment services for its radio station WLUM-FM 102.1, including use of the WLUM as its call letters and business name.

- WLUM maintains a presence on the Internet. A MRA web site located at: www.rock102one.com.

- LAZER is not a licensee of MRA, nor is it otherwise authorized by MRA to use any WLUM mark, including WLUM.COM.

- LAZER and Complainant MRA are radio broadcasting and entertainment competitors in Wisconsin, specifically, throughout Milwaukee and its surrounding vicinity.

- MRA has been granted a state trademark registration for the mark ROCK 102 ONE WLUM FM MILWAUKEE by the State of Wisconsin. The date of registration for this mark is June 16, 1999.

- MRA has been using WLUM as its call letters and business name in connection with its radio broadcasting and entertainment services for numerous years.

- LAZER has registered the domain name WLUM.COM

- LAZER is not (either as an individual, business, or other organization) commonly known by the name Milwaukee Radio Alliance or WLUM.COM (or WLUM).

- LAZER redirected WLUM.COM to its own LAZER 103 Internet web site.

- Although LAZER has stopped redirecting WLUM.COM to its LAZER 103 Internet web site; LAZER has refused to transfer ownership of the domain name WLUM.COM to MRA.

- MRA offered LAZER all out-of-pocket expenses related to WLUM.COM, namely, registration fees incurred by LAZER to date and any future transfer registration fees that they may incur. LAZER's only response to MRA is that MRA's offer to reimburse LAZER for its out-of-pocket costs is not enough and if MRA wants to buy the name, it will have to offer more.

- On June 17, 1999, one of the employees of LAZER 103, T. Oele, registered the domain name, WILLIEDAVIS.COM, using the LAZER address as the registrant's address. Willie Davis is a former Green Bay Packer NFL football player and the owner of MRA's WLUM-FM radio station. After numerous communications, LAZER has deactivated and cancelled this domain name.

5. Parties' Contentions

A. Complainant.

MRA contends that LAZER's actions directly violate Paragraph 4(a)(i) of the Uniform Domain Name Dispute Resolution Policy (Policy) as LAZER has registered a domain name identical to a trademark in which MRA has rights. MRA further contends that LAZER's actions directly violate Paragraph 4(a)(ii) of the Policy in that LAZER has no rights or legitimate interests in respect to WLUM.COM since LAZER is not (either as an individual, business, or other organization) commonly known by the name Milwaukee Radio Alliance or WLUM.COM. Finally, MRA asserts that LAZER's actions directly violate Paragraph 4(a)(iii) of the Policy since LAZER has registered and used the domain name WLUM.COM in bad faith as defined by the Policy. MRA asserts that "bad faith" is present because 1) LAZER registered the at-issue domain name with knowledge that WLUM was a famous MRA mark and shortly thereafter, linked WLUM.COM to its own LAZER 103 Internet web site; 2) LAZER refused to transfer the domain name to MRA upon MRA's request; 3) LAZER responded to MRA that it might sell the domain name for an amount in excess of that what MRA offered LAZER; 4) a website can not be developed in good faith since the domain name consists of the call letters of its competitors; and finally because a LAZER employee had registered a domain name containing the proper name of an MRA owner. MRA requests that the Provider instruct the Registrar to transfer the domain name to MRA.

B. Respondent

No response was filed.

6. Discussion and Findings

Standard of Review

Under the Section 4(a) of the Policy a complainant must plead and prove that: 1) the at-issue domain name is either identical or confusingly similar to Complainant's trademark or service mark; 2) that the respondent or registrant has no legitimate interest in the domain name; and 3) that the domain name was registered and used in bad faith. Policy §4(a).

Registrant LAZER has technically defaulted since no response was filed. Nevertheless, the Panel must determine the evidentiary weight and credibility of Complainant's allegations and annex material, and whether or not MRA's presentation is sufficient to establish the "proof" required by the Policy.

Identical or Confusingly Similar

The WLUM.COM domain name is obviously not identical to the MRA's registered Wisconsin trademark ROCK 102 ONE WLUM FM MILWAUKEE. MRA alleges that it has common law rights in the mark WLUM. If so, such trademark is identical to the at-issue domain name. However, the allegations advanced in MRA's papers are insufficient to prove such rights. The fact that WLUM is a radio station's call letters assigned by the FCC to Complaint does not, in and of itself, give rise to trademark rights in WLUM. See 1 McCarthy § 7:17.1 (domain names, like telephone numbers,

street addresses, and **radio station call letters**, which permit one to locate and communicate with a place or a person, do not, without more, function as trademarks). Emphasis added. Likewise, the fact that WLUM may have been used as a business name does not spawn trademark rights and MRA presents no direct factual basis from which the Panel may conclude that it has trademark rights in the specific mark WLUM.

Contrary to allegations in the Complaint, the Panel's examination of the Internet website – www.rock102one.com reveals no use of WLUM, either on the home page or any other of the several web pages that were reviewed. The use of WLUM in several meta-tag is not a trademark use. Importantly, the logo mark, which is currently on the referenced site and is pictured at right, contains no use of WLUM and is not identical to MRA's registered trademark. The bald averments that MRA "has been using WLUM as its call letters, business name, and as a trademark in connection with its radio broadcasting and entertainment services for numerous years" is conclusory. It would be inappropriate to hold that a complainant has trademark rights simply because it says it does without corroborating evidence demonstrating how and when such trademark rights sprung forth. Even absent a federal or state trademark registration for WLUM, convincing evidence may have easily been proffered in the form of sworn declarations, documents annexed to the complaint, or by some other auditable reference. MRA's failure to provide proof that it has trademark rights in the discrete mark WLUM bars any finding that the WLUM.COM domain name is identical to an MRA trademark.

Having found the mark and the domain not to be identical, we turn to the question of whether or not the second level domain name, WLUM, although not "identical" is "confusingly similar" to Complainant's registered trademark ROCK 102 ONE WLUM FM MILWAUKEE.

The Manual of Trademark Examining Procedures guides our inquiry. See generally The Manual of Trademark Examining Procedures, section 1207 *et seq.* http://www.uspto.gov/web/offices/tac/tmep/1200.htm . See also, *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). The similarity of the marks WLUM and ROCK 102 ONE WLUM FM MILWAUKEE in their entireties as to appearance, sound, connotation and commercial impression along with what appears to be a substantial potential for confusion, support a conclusion that MRA's registered trademark is confusingly similar to the at-issue domain name. The embedded term WLUM in MRA's registered trademark has a trademark function apart from its use as station call letters. Moreover, the services offered by the registrant and the MRA are very closely related. Both offer Rock & Roll format radio broadcast programming. MRA and LAZER are competitors in a local radio market. Internet users seeking MRA's radio station were likely to have been "initially confused" when, in attempting to reach WLUM FM through the URL www.wlum.com, linked to a website controlled by LAZER.

For the foregoing reasons the Panel finds that the domain name is confusingly similar to MRA's registered trademark and that the requirement of Policy § 4(a)(i) is satisfied.

<u>LAZAR's Rights and Legitimate Interest in the Domain Name</u>

In its Complaint MRA confuses a domain name with a trademark. There should be no mistake that trademark rights do not give rise to rights in a domain name. Domain names are not trademarks and there is a plethora of uses for domain names which are well clear of the ambit of trademark law. Therefore, the fact that MRA may have colorable trademark rights in certain uses of WLUM, does not, without more, compel

the conclusion that MRA similarly has rights in a like named second level domain name.

Significantly, by virtue of the domain name registration service agreement between the Registrant (LAZER) and Registrar (NSI) a presumption arises that the LAZER has at least some legitimate interest in the subject domain name. But the fact that MRA is a competitor of LAZER, and that LAZER used the subject domain name to re-route Internet traffic likely to be destined for MRA to its own site, indicates an improper, if not illegal, use of the WLUM.COM domain name. This use by the Registrant breaches NSI's service agreement whereby the registrant warrants that to the best of its knowledge and belief neither the registration of the domain name nor the manner in which it intends to use such domain name will directly or indirectly infringe the legal rights of a third party. NSI Registration Agreement, https://www.networksolutions.com/legal/service-agreement.html §17(ii).

LAZER's breach of this warranty divests LAZER of any rights or interests in the domain name conferred by the service agreement. For this reason alone, the panel finds that LAZER has no rights or legitimate interest in the domain name WLUM.COM.

Bad Faith

Section 4(b)(i)-(iv) of the Policy sets out certain factors which if found by the Panel to be present, shall be evidence of the domain name's registration and use in bad faith. Only sections 4(b)(i) and 4(b)(iv) warrant discussion.

The panel is not persuaded that consistent with Policy §4(b)(i) LAZER acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to MRA for valuable consideration in excess of its out-of-pocket expenses directly related to the domain name. The sole evidence MRA presents via its complaint, and without any supporting documentation, is that LAZER refused to transfer the domain name for the "out-of-pocket" costs that MRA offered and that LAZER countered that the amount offered by MRA "was not enough." Complaint ¶27. This exchange fails to indicate the presence of the section 4(b)(i) factor for several independent reasons.

Under paragraph 10(d) of the Rules, the panel "shall determine the admissibility of evidence." Rules paragraph 10(d). Evidence derived from MRA's offer, LAZER's rejection of that offer, and any invitation to further negotiate the transfer of the domain name is excluded from the Panel's consideration pursuant to F.R.E. 408[1]. Even if such evidence were not eclipsed by 408, the exchange is not relevant since MRA's demand and LAZER's response thereto occurred after the domain name was registered and used. Finally, the primary purpose of LAZER's "acquiring" the domain name was

[1] Federal Rules of Evidence 408 states: Evidence of (1) furnishing or offering or promising to furnish, or (2) accepting or offering or promising to accept, a valuable consideration in compromising or attempting to compromise a claim which was disputed as to either validity or amount, is not admissible to prove liability for or invalidity of the claim or its amount. Evidence of conduct or statements made in compromise negotiations is likewise not admissible. This rule does not require the exclusion of any evidence otherwise discoverable merely because it is presented in the course of compromise negotiations. This rule also does not require exclusion when the evidence is offered for another purpose, such as proving bias or prejudice of a witness, negativing a contention of undue delay, or proving an effort to obstruct a criminal investigation or prosecution. see also Uniform Rules 52 and 53; California Evidence Code § 1152, 1154; Kansas Code of Civil Procedure §§ 60-452, 60-453; New Jersey Evidence Rules 52 and 53.

apparently to misdirect Internet users seeking radio station WLUM FM, not to offer the domain name for sale.

Only Section 4(b)(iv) operates in favor of showing that LAZER registered and used the domain name in bad faith. This section states:

> (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

The unchallenged averment that LAZER registered the domain name then directed traffic from WLUM.COM to its own website falls squarely within the ambit of this factor in that LAZER sought to create an "initial confusion" on the part of Internet users with regard to the source of the domain name WLUM.COM. Therefore, the Panel finds that the registrant LAZER acted in bad faith in registering and using the domain name.

7. Decision

Pursuant to section 4(i) of the Policy and Section 15 of the Rules, having found that: 1) the at-issue domain name WLUM.COM is confusingly similar to a service mark in which the Complainant has rights; 2) that the registrant LAZER has no rights or legitimate interests in respect of the domain name and; 3) that the domain name has been registered and was being used in bad faith at the time the dispute arose, the Panel requests the Registrar to transfer the domain name WLUM.COM to the MRA.

Paul Michael DeCicco
Panelist

Dated: June 5, 2000