WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

LIN Television Corporation v. Home In USA and Home In USA, Inc.

Case No. D2000-0257

1. The Parties

The Complainant is LIN Television Corporation, a corporation organized in the state of Delaware, United States of America (USA), with a principal place of business in Providence, Rhode Island, USA.

The Respondent is Home In USA and Home In USA, Inc., with an addresses in Williamsburg, Virginia, USA.

2. The Domain Names and Registrars

The disputed domain names are WAVYTV.COM; WAVY-TV.COM; WAVYTV10.COM; and WAVY-TV10.COM.

The registrar of the disputed domain names WAVYTV.COM, WAVYTV10.COM, and WAVY-TV10.COM is Network Solutions, Inc., with a business address in Herndon, Virginia, USA.

The registrar of the disputed domain name WAVY-TV.COM is Internet Domain Registrars, with a business address in San Francisco, California, USA.

3. Procedural History

The essential procedural history of the administrative proceeding is as follows:

The Complainant initiated the proceeding by the filing of a complaint via e-mail, received by the WIPO Arbitration and Mediation Center ("WIPO") on April 4, 2000, and by courier mail received by WIPO on April 7, 2000. Payment by Complainant of the

requisite filing fees accompanied the courier mailing. On April 19, 2000, WIPO completed its formal filing compliance requirements checklist.

On April 26, 2000 WIPO transmitted notification of the complaint and initiation of the proceeding to the Respondent via e-mail and courier. This date represents the commencement of this administrative proceeding (Rules for Uniform Domain Name Dispute Resolution Policy, para. 4(c)). On April 26, 2000, WIPO also transmitted notification of the complaint to the Complainant's authorized representative.

The Complainant filed Supplement to its complaint via e-mail, received by the WIPO Arbitration and Mediation Center ("WIPO") on April 27, 2000, and by courier mail received by WIPO on May 1, 2000. On April 28, 2000, WIPO completed its formal filing compliance requirements checklist and supplied the Respondent with the Supplement via e-mail and courier.

On May 11, 2000, the Respondent submitted its response to the complaint via e-mail and courier to WIPO and the Complainant.

On May 25, 2000, the Complainant and Respondent were notified by WIPO of the appointment of the undersigned sole panelist as the Administrative Panel (the "Panel") in this matter. WIPO notified the Panel that, absent exceptional circumstances, it would be required to forward its decision to WIPO by June 8, 2000.

The Panel has not received any requests from Complainant or Respondent regarding further submissions, waivers, or extensions of deadlines, and the Panel has not found it necessary to request any further information from the parties. The proceedings have been conducted in English.

4. Factual Background

The Complainant has provided a copy of its United States Federal Communications Commission License Renewal Authorization dated September 30, 1996 for the television station WAVY-TV, Channel 10. The Complainant does not own any federal trademark or service mark registrations for WAVY, WAVY-TV, or WAVY-TV 10. The Complainant has provided representative samples of advertising and promotional materials showing its use of its alleged WAVY, WAVY TV and WAVY TV 10 service marks to promote its television broadcasting services. The Complainant alleges use of the marks since 1957 in the area of Hampton Roads, Virginia. The Complainant operates a website promoting its television broadcasting at WWW.WAVY.COM. This domain name was registered on August 29, 1995.

A Network Solutions' WHOIS database query response indicates that Home In USA, with Gilinda Rogers as Administrative, Technical, Zone, and Billing Contacts, is the registrant of the domain names WAVYTV.COM and WAVYTV10.COM. The records of these registrations were created on September 2, 1999.

A Network Solutions' WHOIS database query response indicates that Home In USA Inc., with Gilinda Rogers as Administrative, Technical, Zone, and Billing Contacts, is the registrant of the domain name WAVY-TV10.COM. The record of these registration was created on January 6, 2000.

An Internet Domain Registrars WHOIS database query response indicates that Home In USA Inc., with Gilinda Rogers as Administrative, Technical, and Billing Contacts, is the registrant of the domain name WAVY-TV.COM. The record of these registration was created on March 21, 2000.

The Uniform Domain Name Dispute Resolution Policy (the "Policy"), as approved by the Internet Corporation for Assigned Names and Numbers ("ICANN") on October 24, 1999, requires that all ".COM" domain name registrants submit to a mandatory administrative proceeding conducted by an approved dispute resolution service provider, of which WIPO is one, regarding allegations of abusive domain name registration (Policy, para. 4(a)). Respondent has not contested that it is properly before this Administrative Panel.

5. Parties' Contentions

A. Complainant

The Complainant alleges that the service marks WAVY, WAVY TV and WAVY TV 10 have been used by it and its predecessors in connection with television broadcasting services and programming since 1957 in the Hampton Roads area of Virginia. The Complainant is the owner of an exclusive license from the Federal Communications Commission to use WAVY-TV as its call letters. It is local television channel 10.

The Complainant does not own federal trademark registrations for these marks, but has provided representative samples of advertising and promotional materials showing its use of its WAVY, WAVY TV and WAVY TV 10 service marks to promote its television broadcasting services. The Complainant alleges substantial advertising and promotional expenditures for the station, including $2.5 million since 1998. The Complainant also promotes its television station and programming at a website located at the domain name WWW.WAVY.COM, which the Complainant states was established in April, 1997. The Complainant alleges that it enjoys consistently high ratings in its viewing area. Thus, the Complainant alleges that its significant marketing and promotional expenditures, combined with long and extensive use of the call letters as service marks, establishes common law trademark rights in WAVY, WAVY TV and WAVY TV 10.

The Complainant discovered the registrations of the WAVYTV.COM and WAVYTV10.COM domain names in October 1999, and the use of its WAVY TV

10 logo on the corresponding websites. The logo was used as a link to the Complainant's website, located at WAVY.COM. The disputed websites also contained the logo of one of the Complainant's competitors and a link to that competitor's website. The Complainant's counsel sent the Respondent a letter dated November 19, 1999 requesting the removal of its logo from the websites and the transfer of the domain names.

The Complainant states that the Respondent telephoned the Complainant's counsel on December 2, 1999, and allegedly stated that she "wanted to design a website for the geographic region served by [the Complainant's] WAVY TV 10 television station and believed the registration and use of the WAVYTV.COM and WAVYTV10.COM domain names would be a means to attract traffic to that website." The Complainant alleges that during this conversation, Mr. Rogers agreed to remove the Complainant's logo and link from the website, but refused to transfer the domain names to the Complainant. The disputed websites continued to be identified by domain names incorporating the Complainant's marks, and she did not remove any of the Complainant's competitor's logos or those links to their websites.

In a subsequent letter dated December 7, 1999, counsel for the Respondent reiterated the Respondent's refusal to transfer the domain names. On January 3, 2000, counsel for the Complainant sent a letter to the Respondent's counsel, again asserting its trademark rights and demanding the transfer of the domain names. Three days after the date of this letter, the Respondent registered the domain name WWW.WAVY-TV10.COM.

On January 21, 2000, counsel for the Respondent called counsel for the Complainant and allegedly requested a meeting to discuss business opportunities between the parties involving the domain names, which the Complainant declined. The Respondent allegedly offered to sell the domain names to the Complainant for $30,000. On March 21, 2000, the Respondent registered the domain name WWW.WAVY-TV.COM.

On March 24, 2000, the Complainant alleges that the Respondent posted content on the websites at the disputed domain names that refer to "Wavy-TV Technology."

The Complainant alleges that the WWWW.WAVYTV.COM, WWW.WAVYTV10.COM, WWW.WAVY-TV.COM, and WWW.WAVY-TV10.COM domain names are identical or confusingly similar to its WAVY, WAVY TV and WAVY TV 10 service marks.

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the domain names, since before notice of the dispute, the Respondent had made no demonstrable preparations to use the domain names in connection with a bona fide offering of goods or services. Specifically, the Complainant

alleges that the Respondent registered the domain names for the sole purpose of trading upon the goodwill and recognition associated with its marks, through her admission that she wished to create a website that would attract people in the Complainant's television viewing area.

The Complainant alleges that the "Wavy-TV" content posted on the site in late March, 2000 is an illegitimate attempt by the Respondent to demonstrate preparations to use the names in connection with a bona fide offering of goods or services. The Complainant alleges no such "wavy" technology exists, and that any use of the disputed domain names for any such technology would still cause confusion with its marks. The Complainant alleges that the Respondent has never been commonly known by the domain names prior to the dispute.

The Complainant alleges that the Respondent registered and used the domain names in bad faith because she registered the domain names with knowledge of the Complainant and with the intent to divert Internet users to her site by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of her website. Specifically, the Complainant alleges that her intent in registering the domain names and creating her websites at those domain names was to divert those computer users who were familiar with the Complainant and its marks, who were looking for the official WAVY TV website.

The Complainant alleges the use of the Complainant's marks on the original two websites is further evidence of the Respondent's intent to trade off the Complainant's marks and cause confusion among the Complainant's viewers, and that actual confusion has occurred. Furthermore, the Complainant argues that initial interest confusion would still occur, no matter what content was posted on the websites, because of the identical nature of the trademarks and the domain names. The Complainant argues that there could be no legitimate reason for registering and using these specific domain names, other than to confuse computer users and trade on the goodwill established by the Complainant.

The Complainant alleges that the Respondent's bad faith is further evidenced by her offer to sell the domain names for $30,000, and her registration of the WWW.WAVY-TV.COM and WWW.WAVY-TV10.COM domain names after the Complainant had made its objection to the registration of the WWW.WAVYTV.COM and WAVYTV10.COM domain names quite clear.

The Complainant alleges that additional evidence of the Respondent's bad faith conduct is found in its registration of several other trademarks belonging to third parties, one of which is pending in a U.S. federal district court; the Complainant alleges that this shows a pattern of cybersquatting conduct.

B. Respondent

The Respondent denies that the Complainant has any trademark or service mark rights in the terms WAVY, WAVY TV, and WAVY TV 10, because the Complainant has not registered the terms with the U.S. Patent and Trademark office, because the Complainant does not use the symbol "TM" with the terms, because call letters are not strong marks, and because the Complainant allegedly does not use the terms in a trademark sense. The Respondent alleges that the Complainant only has rights in the design form of the terms, but not in the terms themselves. Furthermore, the Respondent alleges that any alleged rights in the terms are limited to the television broadcasting context, and do not extend to the Internet.

The Respondent also alleges that in any determination of likelihood of confusion, the relevant public for the Complainant is its current and potential advertisers, but not the viewing public. The Respondent states that these advertisers would not "mistakenly place an ad on Respondent's website thinking it to be Complainant's TV station or Complainant's website…" and thus there could not be any possibility of confusion between the Complainant's marks and the Respondent's domain name and websites.

The Respondent denies that it ever offered to sell the domain names for $30,000, alleging that the figure was offered in a settlement context and is thus not properly considered by the Panel.

The Respondent argues that the Complainant should have registered variations of its marks as domain names if it wanted to secure them for its own use. The Respondent argues that the Complainant should not be allowed to demand the transfer of domain names that the Complainant should have registered if it wanted to enforce its marks.

The Respondent asserts that Wave TV technology is a viable emerging technology and alludes that the domain names will be used to develop websites in the future that will involve or showcase this technology. The Respondent alleges that the Complainant is trying to prevent the Respondent from using any domain name that uses the term "wave" or "wavy."

The Respondent denies that she is a cybersquatter who registers other parties' trademarks, asserts that she has developed websites that other third parties endorse or have otherwise acquiesced to, and has developed hundreds of other successful websites.

The Respondent otherwise generally denies the Complainant's allegations.

6. Discussion and Findings

Paragraph 4(a) of the Policy instituted three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration, and to obtain relief. These elements are that:

(i) respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) respondent has no rights or legitimate interests in respect to the domain name; and

(iii) respondent's domain name has been registered and is being used in bad faith.

Each of these three elements must be proved by a complainant to obtain relief. Paragraphs 4(b) and 4(c) of the Policy provide further nonexclusive criteria for determining whether the Registrant has engaged in abusive domain name registration with respect to subparagraphs 4(a)(ii) and 4(a)(iii).

A. Identity of Respondent's Domain Name and Complainant's Trademarks

The Panel concludes that the Complainant has trademark rights in the terms WAVY, WAVY TV, and WAVY TV 10. The lack of a federal registration does not prevent the Complainant from establishing common law trademark rights in these terms. Nor does the failure of the Complainant to use the symbol "TM" prevent the establishment of trademark rights.

Broadcasting call letters can serve as trademarks, if they are used in a trademark sense. The Panel finds that the Complainant uses the call letters and the composite terms in a trademark sense, based on the materials provided by the Complainant, and material viewed by the Panel at the Complainant's WWW.WAVY.COM website. The terms are clearly and consistently used to identify the Complainant, and high television ratings support the contention that many people associate the marks with the Complainant. Use of the marks on-air for thirty-two years, supplemented by significant off-air marketing expenditures in the form of advertising and website content, has created legal rights in the marks under the common law that are protectable against infringement, just as are registered rights.

The Panel finds that the WAVYTV.COM, WAVY-TV.COM, WAVYTV10.COM, and WAVY-TV10.COM domain names are virtually identical and in the context of the use here, are confusingly similar to the trademarks in which the Complainant has rights. WAVY TV is the Complainant's call letters. WAVY TV 10 is the Complainant's call letters and its local station number, which it uses to identify itself, and which no others are authorized to use. WWW.WAVY.COM is the domain name for the Complainant's website. The

Complainant has rights in these marks. The addition of a hyphen does not decrease the confusing similarity between the domain names and these marks.

Thus, Panel finds for the Complainant on the first element, that Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

B. Respondent's Rights or Legitimate Interests in the Domain Name

The Panel considers the nonexclusive list of factors found in Paragraph 4(c) of the Policy to determine whether the Respondent has rights or legitimate interests in the disputed domain names.

The Panel finds that the Respondent, while making allegations, has not provided any persuasive evidence that she was commonly known by the disputed domain names prior to the dispute, and has not provided any persuasive evidence that she has otherwise established trademark rights in the terms – no documents, no advertising, no brochures, no letterhead, no mail to her, no invoices, no purchase orders, simply no evidence beyond an allegation in gross. Thus, the Respondent can not claim any trademark rights in the terms that would trump the Complainant's.

The Panel finds that the Respondent has not provided persuasive evidence that she made a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain by misleadingly diverting consumers to her websites. The Panel finds that the Respondent's uses of the domain names are for commercial purposes, since she operates a commercial website design business, and by her own admission attempted to establish a for-profit business relationship with the Complainant involving the domain names.

The Panel further finds that the Respondent did not make any demonstrable preparations to use the disputed domain names in connection with a bona fide offering of goods or services before any notice of the dispute. Domain names made of another party's trademarks, with website content at those domain names containing the party's trademarks and those of its competitors, used without their authorization, does not constitute a demonstrable preparation to use the domain names in a bona fide offering of goods and services. Holding a stable of domain names comprised of another's trademarks hostage in an attempt to compel a business relationship with the trademark owner is not a demonstrable, appropriate and lawful preparation to use a domain name.

Furthermore, the Panel is unaware of any technology known as "Wave TV" technology and Respondent has provided no evidence of who if anybody generated such a technology or used the name "Wave TV" to identify or describe any such. In context here, the Panel finds the Respondent's website content posted at the disputed domain names well after the dispute was underway

regarding alleged "Wave TV" technology to be quite suspect, and not a demonstrable preparation to provide a bona fide offering of goods and services. The Respondent's timing in posting this content well after the Complainant began its strenuous objections to the domain names and the websites is suspicious, and appears like a post-hoc attempt to manufacture a legitimate use of the domain names.

Thus, Panel finds for the Complainant on the second element, that Respondent has no rights or legitimate interests in respect to the domain name.

C. Respondent's Registration and Use of the Domain Name

The Panel considers the nonexclusive list of factors found in Paragraph 4(b) of the Policy to determine whether the Respondent registered and used the disputed domain names in bad faith.

The Panel finds that the Respondent registered and used the disputed domain names in bad faith. The Panel finds that the Respondent registered and used the domain names with the intent to attract, for commercial gain, Internet users to its websites by creating with the Complainant's marks confusion as to source, sponsorship, affiliation, or endorsement or her website. In light of all the evidence of the Respondent's conduct, the Panel can not discern a legitimate reason for the registration of these specific domain names, other than to divert to her own website for her own benefit those online computer users who are seeking authorized information by or from the Complainant.

The domain names are virtually identical to the Complainant's marks, and as such, it is reasonable to assume that online computer users who are looking for the Complainant's website would try the Respondent's domain names in their search. The Respondent's websites are identified by the Complainant's marks in the domain names, and originally contained the Complainant's marks in its content.

Upon encountering the Respondent's websites that are identified by the Complainant's marks in the domain names, many of these users assuredly would assume that the Complainant had endorsed or sponsored the sites, or was somehow affiliated with the Respondent and/or all the parties whose marks appear on the sites. The unauthorized use of the Complainant's exact marks alongside those of it's competitors on the sites constitutes a bad faith use of the domain names. Removal of the Complainant's marks from the websites does not show lack of bad faith, because the continued use of the Complainant's competitor's marks at a website identified by the Complainant's mark in the domain name is still confusing. Confusion as to source or affiliation would not be dispelled once the user viewed the content of the site.

Contrary to the Respondent's arguments, the relevant public is not just the Complainant's advertisers, but includes all consumers who recognize the marks as

identifying the Complainant. The Complainant's advertisers are not the only relevant public since the Complainant uses the marks in a trademark sense and has done so for years prior to Respondent's subject use; and arguendo, even if such was true, the Respondent's registration and use would still be in bad faith, as these specific domain names and the content posted on the website would still be likely to cause confusion as to source, affiliation, or sponsorship with the Complainant.

The Panel notes that the timing of the Respondent's registration of the WWW.WAVY-TV.COM and WWW.WAVY-TV10.COM domain names is evidence of the Respondent's bad faith. As noted previously, the Respondent registered these domain names well after the Complainant strenuously objected to the registration of the other two domain names, and did not disclose these registrations during its attempts to settle the matter. Registration of such domain names, almost identical to the first two domain names and the Complainant's marks, especially at that stage in the dispute, could not have been done in good faith, and only served to escalate the dispute between the parties. These domain names were used in the same manner as the other domain names, in that the identical objectionable and confusing content is posted.

The Panel finds the Respondent's offer to "settle" the dispute for $30,000 suspicious and not indicative of a good faith registration in light the context here, such as lack of a plausible reason to select names so close to Complainant's marks, the actual registration cost, her steadfast refusal to consider the transfer of the domain names, and her repeated attempts to enter into a business relationship with an obviously unwilling trademark owner.

The Respondent's arguments that the Complainant should have registered every possible variation of its trademarks if it wanted to enforce its trademark rights is equally unavailing. A trademark owner is not charged with the duty to register any of the many possible variations of its trademarks as domain names in order to prevent cybersquatters from encroaching upon its marks and causing confusion in the marketplace. Trademark owners can not always anticipate creative infringing maneuvers by unrelated parties. If the Respondent's argument was correct, then large companies with a stable of thousands of marks would have to register an exponential number of domain names to protect their marks from infringers. Such a scenario is unworkable and has no basis in trademark law.

Contrary to the Respondent's reasoning, the mere availability of a domain name does not mean that the registration of that domain name will not infringe the trademark rights of others, or cause confusion in the marketplace. The Respondent's argument that the Complainant should not be entitled to prevent the use of its marks in a domain name merely because she "won the race to the registrar" is unavailing and reeks of a bad faith intent to prevent the Complainant from using and reflecting their own marks in corresponding domain names.

Regarding the Respondent's assertions that it registered the marks to preserve its ability to showcase what it now names "Wave TV technology," the Panel does not see why the Respondent needs four domain names that are virtually identical to the Complainant's marks to do so. If the Respondent originally registered these specific domain names with the specific intent to highlight a particular identifiable technology, it seems more logical that it would have registered "WWW.WAVETV.COM" or something along that line, instead of names that mimic the Complainant's call letters and even include the Complainant's local television station number. It also seems that if that was the Respondent's original intent, it would have posted relevant content regarding this technology from the beginning; instead, the Respondent posted a website featuring the Complainant's trademarks and those of its competitors, with links to their respective websites. Such conduct does not reflect registration and use in good faith.

The Panel finds that the Respondent registered and used of all four of the disputed domain names in bad faith. Thus, Panel finds for the Complainant on the third element.

7. Decision

For the foregoing reasons, the Panel decides:

1. That the WAVYTV.COM, WAVY-TV.COM, WAVYTV10.COM, and WAVY-TV10.COM domain names registered by the Respondent are virtually identical and confusingly similar to the trademarks in which the Complainant has rights;

2. That the Respondent has no rights or legitimate interests with respect to the WAVYTV.COM, WAVY-TV.COM, WAVYTV10.COM, and WAVY-TV10.COM domain names; and

3. The Respondent's WAVYTV.COM, WAVY-TV.COM, WAVYTV10.COM, and WAVY-TV10.COM domain names have been registered and are being used in bad faith.

Accordingly, pursuant to Paragraph 4(i) of the Policy, the Panel requires that the registration of the domain names WAVYTV.COM, WAVY-TV.COM, WAVYTV10.COM, and WAVY-TV10.COM be transferred to the Complainant.

/s/
Tom Arnold
Sole Panelist

Date: June 2, 2000