WIPO Arbitration and Mediation Centre

ADMINISTRATIVE PANEL DECISION

Capital Broadcasting Company, Inc. v Momm Amed Ia

Case No. D2000-1610

1. The Parties

1.1 The Complainant is Capital Broadcasting Company, Inc., a corporation organised under the laws of the State of North Carolina, United States of America, having its principal place of business at 2619 Western Blvd, Raleigh, North Carolina, 27606 United States.

1.2 The Respondent is Momm Amed Ia of Kwangsan-gu, MYONGDO-dong 13-1, Kwangju, Kr 506-011, KR.

2. The Domain Names and Registrar

2.1 The domain names upon which this Complaint is based are "*wral-tv5.com*" and "*wral5.com*". The registrar of the domain names as at the date of the Complaint is BulkRegister.com.

3. Procedural History

3.1 The Complaint was made pursuant to the Uniform Domain Name Dispute Resolution Policy adopted Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, (the "Policy"), in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy, also adopted by ICANN on August 26, 1999, (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999, (the "Supplemental Rules").

3.2 The Complaint was received by the WIPO Arbitration and Mediation Centre (the "Centre") by email on November 20, 2000, and in hard copy on November 22, 2000. The Complaint stated that payment had been made of the

fees prescribed under the Rules and Supplemental Rules. The Complaint further stated that the Complainant had sent a Federal Express package to the Respondent's address "in an effort to try to obtain a transfer of the "wral-tv5.com" and "wral5.com" domain names". The contents of the package were not specified in the Complaint. The Complaint stated that Federal Express tried several times to deliver the package, but was ultimately unsuccessful as it was an incorrect address. The Complaint alleges that the Respondent has actively provided and failed to correct false contact details by (inter alia) failing to provide a telephone number and email address. The Panel notes that the Whois database entry for the Respondent with BulkRegister.com (annexed to the Complaint) contains a telephone number for the administrative and technical contact, and while this appears to be incomplete, the Complaint makes no reference to any attempt being made to contact the Respondent or the contact by telephone. The Whois database entry also contains an email address for the contact and the Complaint makes no reference to any attempt being made to contact the Respondent or the contact by email. In the light of the Panel's finding (below) that the Centre discharged **its** duty to inform the Respondent of the Complaint, nothing turns on this omission on the Complainant's part. The Complaint also stated that a copy of the Complaint had been sent or transmitted to the Respondent in accordance with the Supplemental Rules.

3.3 The Centre sent the Complainant an Acknowledgment of Receipt of Complaint by email on November 24, 2000. The Centre sent a Request for Registrar Verification to BulkRegister.com on November 27, 2000, by email. BulkRegister.com responded to the Centre's request by email on the same date, verifying:

(a) that BulkRegister.Com was in receipt of the Complaint sent to it by the Complainant;

(b) that BulkRegister.Com was the registrar for the domain names "*wral-tv5.com*" and "*wral5.com*";

(c) that the Respondent was the current registrant of the domain names in dispute;

(d) the Respondent's contact details (which did not contain a facsimile number);

(e) that the Policy was applicable to the dispute; and

(f) that the status of the domain names "*wral-tv5.com"* and *"wral5.com"* was "Registrar LOCK".

3.4 The Centre sent a Notification of Complaint and Commencement of Administrative Proceeding on November 28, 2000, to the Respondent (both at its Registrant address and at the address of its administrative and technical contacts) by post/courier and email, to postmaster@wral-tv5.com and postmaster@wral5.com by email, and to the Complainant by email.

3.5 The Panel has been furnished with a copy of a shipment airway bill from DHL Worldwide Express evidencing the dispatch of the parcels containing the notifications sent to the Respondent at its Registrant address. No shipment airway bill has been provided in respect of the package sent to the administrative and technical contacts. The Panel has not been provided with a delivery receipt from DHL Worldwide Express but nor has it been provided with a return receipt, which would be usual had the courier been unable to deliver the package. Furthermore, there is no evidence that the emails to the registrant's email address, the administrative and technical contact email address, postmaster@wral-tv5.com and postmaster@wral5.com were not successfully delivered.

3.6 Accordingly, the Panel is satisfied that the Centre has complied with subparagraphs 2(a)(i) to (iii) of the Rules and has discharged its responsibility to notify the Respondent of the Complaint. The Panel decides that the Respondent and its administrative contact received actual notice of the complaint and of the commencement of this proceeding at the latest by email on or about November 28, 2000.

3.7 No response was filed.

3.8 The Centre sent a notification of Respondent Default to the Respondent and the Complainant by email and by courier on December 20, 2000. Again, the Panel has been furnished with a shipment airway bill from DHL Worldwide Express evidencing the dispatch of the parcel containing the notification of Respondent Default. No receipts evidencing delivery have been provided to the Panel, but the Panel has not been informed of any non-delivery advice having been received from DHL Worldwide Express. Nor is there any evidence that the email sent to the Registrant's address was not delivered. No response has been received from the Respondent at any time prior to the Panel commencing its deliberations.

3.9 The Panel has been very concerned to ensure that the requirement of paragraph 10(b) of the Rules, that the parties are treated with equality and that each party is given a fair opportunity to present its case, is fulfilled. The Panel is of the view that nothing in the procedural history of this case is likely to have deprived the Respondent of the opportunity to communicate with the Centre if it so wished prior to the Panel commencing its deliberations.

3.10 The Centre sent a Notification of Appointment of Administrative Panel and Projected Decision Date to the Respondent and the Complainant by on January 4, 2001.

3.11 The Centre sent a transmission of case file to the Panel by on January 5, 2001. This did not include certain documentation. Such documentation was included in the hard copy case file received by the Panel on January 18, 2001, in Sydney, Australia.

3.12 All other procedural requirements appear to have been satisfied.

4. Factual Background

4.1 Activities of the Complainant

The following information is asserted as fact in the Complaint and remains uncontested.

The Complainant was founded in 1937, and is an industry-leading communications company that owns and operates several television networks. The Complainant founded WRAL-TV in 1956, which provides television broadcasting and entertainment services on local channel 5 in the Raleigh-Durham, North Carolina area of the United States of America.

Since 1996, WRAL-TV5 has had an Internet presence containing top news stories, weather forecasts and other features. These can be obtained through several website addresses including "*wral.com*", "*wralonline.com*", "*wraltv.com*" and "*wral-tv.com*". The WRAL website receives on average 2.5 million page views a week.

4.2 The Complainant's trade marks

The Complaint asserts the following facts and matters, which remain uncontested.

The Complainant holds common law rights in the marks "WRAL", "WRAL5" and "WRAL-TV5", these being the United States Federal Communications Commission assigned television call letters used by the Complainant for broadcast and entertainment services. Under FCC Regulations and Conventions, the letters WRAL uniquely indicate the call letters of a broadcast station, which no entity other than the Complainant may lawfully use within the United States of America.

Throughout its existence, WRAL-TV5 has continuously and exclusively used the call letters "WRAL" as a trademark in connection with its broadcasting and entertainment services. In the fiscal year preceding the complaint, WRAL-TV5 spent approximately US$1 million on advertising and promotional expenses related to the use of the mark. The mark is used in a variety of forms, with and without the hyphen, with and without the suffix "TV", and with and without the suffix "5". The Complaint attached copies of material demonstrating the varied use of the mark.

The Respondent is not a licensee of the Complainant, and is not otherwise authorised to use the Complainant's "WRAL", "WRAL5" or "WRAL-TV5" marks.

4.3 The websites complained of

The following information is asserted as fact in the Complaint and remains uncontested.

The Complaint states that the Respondent has registered the disputed domain names, which was discovered by WRAL-TV5 in September 2000. When

accessing each of these domain names, visitors are redirected to "*gotoo.com/treasure*", which displays an advertisement for "*bestoftheweb.com*", and a pop-up window opens that is directed to "*enter casino.net*" which displays a gambling casino website.

The advertising on this website is provided by "*clickfinders.com*". In its own words, Clickfinders.com holds itself out as a provider of "Innovative Advertising Solutions" and "specializes in placing full-page ads in places that most people disregard as worthless page views." The Complaint asserts that the Respondent is renting the domain name to Clickfinders.com and relies on rental details from the Clickfinders.com website

4.4 The Respondent

No response was filed.

5. The Complainant's contentions in the Complaint

5.1 Paragraph 4(a) of the Policy requires the Complainant to prove that:

(i) [the] domain name [registered by the Respondent] is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) [the Respondent has] no right or legitimate interests in respect of the domain name; and

(iii) [the] domain name has been registered and is being used in bad faith.

5.2 The Complaint asserts that each of the elements specified in paragraph 4(a) of the Policy have been satisfied.

5.3 In reference to the element in paragraph 4(a)(i) of the Policy, the Complaint asserts that the Respondent has registered domain names that are identical and/or confusingly similar to the marks "WRAL", "WRAL5" and "WRAL-TV5" owned by the Complainant, in that the domain name "*wral-tv5.com*" is identical to the mark "WRAL-TV5" and the "wral5.com" domain name is virtually identical to the mark "WRAL 5" but for the lack of a space between the "L" and "5", thereby being confusingly similar in appearance, pronunciation and sound to the Complainant's mark.

5.4 In reference to the element in paragraph 4(a)(ii) of the Policy, the Complaint asserts that the Respondent has no rights or legitimate interests in the domain names in dispute. In particular, the Complainant states that the Respondent is not a licensee of the Complainant, nor is it otherwise authorised by the Complainant to use the "WRAL" mark. The Complaint further contends that the Respondent provides no indication of use or intent to use the domain names in connection with a bona fide offering of goods and services, but is rather doing the opposite, deceptively misdirecting visitors, by renting the domain name to clickfinders.com,

to a site used for advertising with a strong likelihood of confusing visitors. The Complaint asserts that there is no indication that the Respondent has been commonly called by the domain name or that it could lawfully use the Complainant's TV station call letters under FCC conventions and regulations. Finally, the Complaint asserts that the Respondent is using the domain name for improper financial gain through the misdirection of visitors to an advertisement for which the Respondent is paid based on the number of visitors received. The Complainant asserts that the Respondent is tarnishing the trademark of the Complainant by the improper association of the Complainant to the advertising and on-line casino activity to which the domain names are redirected.

5.5 In reference to the requirements of paragraph 4(a)(iii) of the Policy, the Complaint asserts that the Respondent has registered and is using the domain names in dispute in bad faith. In support of this assertion, the Complaint states that the Respondent has registered the disputed names because they are identical and/or confusingly similar to Complainant's marks in order to attract visitors otherwise intending to visit Complainant's website. The Complainant relies on the identity or virtual identity of "*wral-tv5.com*" and "wral5.com" with the Complainant's marks. The Complainant asserts that the registration and use has been with the intent to obtain financial gain through the redirection to paid for advertising of clickfinders.com. The Complainant asserts that the use of the domain names was to create confusion as to the source, sponsorship, affiliation, and/or endorsement of the domain names with that of the Complainant, with the intent to exploit the Complainant's goodwill in its marks. The Complaint also asserts that the Respondent has taken active steps to conceal its true identity and has actively provided and failed to correct false contact details in breach of its registration agreement.

6. Discussion and Panel Findings

This proceeding raises many of the same facts and issues as Capital Broadcasting Company, Inc. v. Private, Case No. D2000-1609. In particular, the Panel's finding in respect of the Complainant's trademarks is the same as the Panel's finding in Capital Broadcasting Company, Inc. v Private.

6.1 *Complainant's trademark*

The Complainant has not made any registration of the terms "WRAL", "WRAL5" and "WRAL-TV5" in which it asserts common law trademark rights. Prior to addressing the question of whether the Complainant has proved the three elements required by paragraph 4(a) of the Policy, the Panel must therefore decide the preliminary question of whether the Complainant has trademark rights in those terms.

The Complainant relies on WIPO administrative Panel decisions LIN Television Corporation v Home in USA and Home in USA Inc., case No.D2000-0257 and WIPO administrative Panel decision Milwaukee Radio Alliance, LLC v WLZR-FM Laser 103 Case No. D2000-0209 as authority for the proposition that common law rights in unregistered marks based on the use of call letters is a basis for

transferring domain names to legitimate trademark owners where the three elements under paragraph 4(a) of the Policy are met. The Panel does not find any support for that contention in Milwaukee Radio Alliance, LLC v WLZR-FM Laser 103. That case concerned the use by WLZR-FM Lazer 103 of the domain name "*wlum.com*", the letters "WLUM" forming part of a Wisconsin State trademark registration granted to Milwaukee Radio Alliance, LLC in the mark "ROCK 102 ONE WLUM FM MILWAUKEE". The facts of that case are therefore too dissimilar to assist the Panel in the instant case. On the other hand, the Panel has found the decision in LIN Television Corporation v Home in USA and Home in USA Inc of assistance. In that case LIN Television Corporation was found to have common law trademark rights in the terms "WAVY", "WAVY TV" and "WAVY TV10". The Panel in that case found that broadcasting call letters could serve as trademarks if they were used in a trademark sense. The Panel found that the complainant did use the call letters in a trademark sense based upon materials viewed by the Panel, high television ratings and use of the marks on air for 32 years, supplemented by significant off air marketing expenditure in the form of advertising and website content.

With respect, that conclusion must be right. If a Complainant can show that they have used certain identifying letters in a trademark sense, they may acquire trademark rights in those letters. Whether they have done so will turn on the facts of each case, the factors listed in Milwaukee Radio Alliance, LLC v WLZR-FM Laser 103 being a sensible, but by no means exhaustive list of the factors that a Panel might take into account.

In the instant case the Complainant is entitled under FCC Regulations and Conventions to exclusive use of the call letters "WRAL", "WRAL5" and "WRAL-TV5". It has been using those terms since 1956, without interruption and has spent very significant amounts of money on advertising and promotional material in respect of the them. Furthermore, the Complainant has used the call letters "WRAL" and the composite terms both on its written material, on its television broadcasts and on its website. It is clear to the Panel that the Claimant has used the call letters "WRAL" and the composite terms in a trademark sense. The Panel concludes that the Complainant has created trademark rights at common law in the terms "WRAL", "WRAL5" and "WRAL-TV5". This conclusion is consistent with this Panel's findings in relation to the use of the identifying letters "ATT" by AT&T in WIPO administrative Panel decision AT&T Corp. v WorldcalssMedia.com, Case No. D2000-553

6.2 The Panel turns next to the three elements of paragraph 4(a) of the Policy which the Complainant must prove in order to obtain relief.

6.3 *Domain names identical or confusingly similar to Complainant's trademark.*

With respect to the domain name "*wral-tv5.com*", the Panel finds that this is identical to the mark "WRAL-TV5" owned by the Complainant. With respect to the domain name "*wral5.com*" the Panel agrees that it is virtually identical to the mark "WRAL 5" owned by the Complainant, but for the lack of a space between the "L" and the "5". The Panel finds confusing similarity proven, and also finds

that the difference which does exist, the space, is sufficiently immaterial that identity is also proven.

6.4 *The Respondent's rights or legitimate interest in the Domain names*

The Respondent has asserted no rights or legitimate interests in the disputed domain names. Taking into account the non-exclusive list of factors in paragraph 4(c) of the Policy, the Panel cannot presently conceive of any legally sound basis upon which any such assertion might be made. The Panel notes that the Complainant has been using the "WRAL" mark for in excess of 40 years and has had a website presence using variations on the mark since 1996. In contrast the Respondent does not appear to use the domain names for a bona fide offering of goods or services but rather misdirects visitors to unrelated advertising sites. The Respondent could not lawfully use the WRAL call letters within the United States and the websites to which visitors are directed, and the registrants name bear no resemblance to any known name or business of the Respondent. Finally, it appears that the Respondent intends to make commercial gain and to misleadingly divert customers given that the Respondent appears to be paid based on the number of visitors received on the "*clickfinders.com*" site.

Whilst sympathetic to the argument that a reputable TV company would not want to be associated with an on line casino, on the evidence currently before it, the Panel is not able to reach a conclusion as to whether the Respondent is tarnishing the trademark of the Complainant.

The Complainant denies, and there is no evidence to the contrary, that there is any relationship between the Complainant and the Respondent which would give rise to any licence, permission or other right by which the Respondent could own or use the domain name. The Panel finds accordingly that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

6.5 *The domain name has been registered and is being used in bad faith*

The Panel notes that paragraph 4(a)(iii) of the Policy requires both registration in bad faith and use in bad faith. The Panel adverts to the non-exclusive list of factors found in paragraph 4(b) of the Policy and in particular sub-paragraph (iv) thereof. The factor in that sub-paragraph is that by using the domain name, the Respondent has attempted to attract, for commercial gain, Internet users to its 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 the Respondent's web site or location of a product or service on the Respondent's web site or location.

The Complainant relies upon the identity or similarity of the domain names to the Complainant's marks as being used in order to attract visitors otherwise intending to visit the Complainant's website. The Complainant further asserts that the registration and use has been for the intent to obtain financial gain through the redirection to paid for advertising by "*clickfinders.com*". The Complainant asserts that the Respondent intends to exploit the Complainant's goodwill in its mark.

Furthermore, the Complainant asserts that the Respondent has taken active steps to conceal its true identity and relies upon WIPO Administrative Panel decision Telstra Corporation Limited v Nuclear Marshmellows No.D2000-0003 as authority for the proposition that such concealment can amount to evidence of bad faith. The Complainant also asserts that the Respondent has actively provided and failed to correct false contact details in breach of its registration agreement.

The Panel finds that the "WRAL" marks, and composite terms have notoriety and value within the geographical area of Raleigh-Durham, North Carolina, United States of America. The Panel has already found that the Respondent does not conduct a legitimate business activity connected to the mark of the Complainant. In the Panel's view, the fact that the disputed domain names divert visitors to an online location which makes money for the Respondent based upon the number of hits to the site, which has no link to WRAL, or any TV service brings this case squarely within paragraph 4(b)(iv) of the Policy. The Panel agrees that the registration and use of the disputed domain names for financial gain was intended to exploit the Complainant's goodwill in its marks.

The Panel is not able to conclude that the Respondent has taken deliberate steps to avoid being contacted by the Centre and the Complainant as there is no evidence that the Complaint and notification of Respondent Default sent by the Centre could not be delivered by courier and email to the Respondent's registered addresses. However, the Panel notes that the Respondent has chosen not to respond to the Complaint. In the light of all of these factors it seems inherently unlikely to the Panel that the Respondent registered the disputed domain name in good faith.

Finally, the Panel cannot conceive of a plausible circumstance in which the Respondent could legitimately use the disputed domain names, and the Respondent has provided no evidence of any actual or contemplated good faith use by it of the domain names. For this reason, the Panel finds that the domain names "*wral-tv5.com*" and "*wral5.com*" have been registered and are being used by the Respondent in bad faith.

7. Decision

7.1 The Panel has found that all of the requirements of paragraph 4(a) of the Policy have been proven by the Complainant. Accordingly, and for the purposes of paragraph 3(c) of the Policy, the Panel orders that the domain names "*wral-tv5.com*" and "*wral5.com*" be transferred by BulkRegister.com to the Complainant, Capital Broadcasting Company, Inc..

Philip Argy

Philip N. Argy
Sole Panelist

Dated: January 24, 2001