WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Radiodifusora del Centro Sociedad Anonima v. Name for Sale $980/Louis Rosenfeld trading as netEGG Internet

Case No. D2001-0634

1. The Parties

The Complainant is Radiodifusora del Centro Sociedad Anonima, an Argentinean corporation with its principal place of business at Córdoba, Argentina. The Complainant is represented by Dr. Matías Altamira Amadeo and Dr. Aníbal Alejandro Pardini, both of Córdoba, Argentina.

The Respondent is shown in the registration of the disputed domain name as "Name for Sale $980 / Louis Rosenfeld!". He since identified himself in his Response as Louis Rosenfeld d.b.a. netEGG Internet of Washington DC, U.S.A. He is represented by Mr. B. P. Miller of Wilkinson, Barker, Knauer LLP of Washington DC, U.S.A.

2. The Domain Name and Registrar

The domain name at issue is <lv3.com>. The domain name is registered with The N@meiIT Corporation of Fayetteville, N.C., U.S.A ("the Registrar").

3. Procedural History

The Complaint submitted by Radiodifusora del Centro Sociedad Anonima was received on May 7, 2001, (electronic version) and June 6, 2001, (hard copy) by the World Intellectual Property Organization Arbitration and Mediation Center ("WIPO Center").

On May 16, 2001, a request for Registrar verification was transmitted by the WIPO Center to the Registrar, requesting it to:

- Confirm that a copy of the Complaint had been sent to it by the Complainant as requested by WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy ("Supplemental Rules"), paragraph 4(b).

- Confirm that the domain name at issue is registered with the Registrar.

- Confirm that the person identified as the Respondent is the current registrant of the domain name.

- Provide full contact details, i.e., postal address(es), telephone number(s), facsimile number(s), email address(es), available in the Registrar's WHOIS database for the registrant of the disputed domain name, the technical contact, the administrative contact and the billing contact for the domain name.

- Confirm that the Uniform Domain Name Dispute Resolution Policy ("UDRP") was in effect.

- Indicate the current status of the domain name.

By email dated June 15, 2001, the Registrar advised WIPO Center as follows:

- It had received a copy of the Complaint from the Complainant.

- It is the Registrar of the domain name registration <lv3.com>.

- Name for Sale $980 / Louis Rosenfeld is shown as the "current registrant" of the domain name.

- The technical, administrative and billing contact is "Names for Sale starting at $980" (Louis Rosenfeld) of Washington DC, U.S.A.

- The UDRP applies to the registration.

- The disputed domain name registration is currently in 'Registrar Locked' status.

The Registrar has incorporated in its agreements the Uniform Domain Name Dispute Resolution Policy adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN").

The advice from the Registrar that the domain name in question is in 'Registrar Locked' status indicates the Respondent has not requested that the domain name at issue be deleted from the domain name database. The Respondent has not sought to terminate the agreement with the Registrar. Accordingly, the Respondent is bound by the provisions of the Registrar's Uniform Domain Name Dispute Resolution Policy, i.e., the ICANN policy. The Respondent has not challenged the jurisdiction of the Panel.

Having verified that the Complaint satisfied the formal requirements of the Uniform Policy and the Uniform Rules, the WIPO Center on June 21, 2001, transmitted by post-courier and by email a notification of the Complaint and Commencement of Administrative Proceedings to the Respondent. A copy of the Complaint was also emailed to the Registrar and ICANN.

The Respondent was advised that a Response to the Complaint was required within 20 calendar days. The Respondent was also advised that any Response should be communicated, in accordance with the Rules, by one original and four sets of hard copy and by email. A Response was filed by the Respondent on July 10, 2001, by electronic means only.

WIPO Center invited the Honorable Sir Ian Barker QC of Auckland, New Zealand to serve as sole Panelist in the case. It transmitted to him a statement of acceptance and requested a declaration of impartiality and independence. The Panelist duly advised acceptance and forwarded to the WIPO Center a statement of impartiality and independence. The Panel finds that the Administrative Panel was properly constituted in accordance with the Rules and the Supplemental Rules.

On July 26, 2001, WIPO Center forwarded to the Panel by courier the relevant submissions and the record. In terms of Rule 15(b), in the absence of exceptional circumstances, the Panel is required to forward its decision by August 9, 2001.

The Panel has independently determined and agrees with the assessment of WIPO Center that the Complaint meets the formal requirements of the Rules for Uniform Domain Name Dispute Resolution Policy as approved by ICANN on October 24, 1999, ("the Rules") and the Supplemental Rules.

The language of the administrative proceeding is English, being the language of the registration agreement.

4. Factual Background

LV3 is the abbreviation granted exclusively to the Complainant in 1930, by the relevant Argentine Authority having jurisdiction over the operation of AM/FM radio transmitting in bands in the city of Córdoba. The authorization so granted is still operative. The abbreviation "LV" is taken from a list of international abbreviations and is granted exclusively to Argentina and awarded to each transmitting station there.

In 1999, the Argentine Government awarded the license for the operation of the public radio transmitting station LV3 to the Complainant.

Argentine law requires that a radio transmitting station must transmit its identification signal at least once each sixty minutes from the starting of the programming schedule. The identification signal transmitted is required to contain, inter alia, the name of the station, band transmission, and town or city, province where the station is located.

LV cannot be registered as a trademark under Argentine Trademark legislation. LV3 has become a famous mass medium with outreach not only in the province of Córdoba (1.5 million inhabitants) but also in the whole Argentine Republic. Since 1997, it has retransmitted its programmes to many other transmitting stations located in different cities of the country. The Complainant's station has an audience reaching more than two million listeners who know the station as LV3.

In January 1996, the Complainant registered as a domain name <lv3.com.ar>.

5. Parties' Contentions

Complainant

The disputed name is identical to the Complainant's mark which was allotted to it as a call sign by the relevant authority. The call sign is associated throughout Argentina with the Complainant.

The Respondent has no rights or genuine interests in relation to the name. His name is not LV3; the initials of his name and surname are "LR" and have no similarity to "LV3": he is not known, commonly, by the abbreviation LV. There has been no license granted by the plaintiff to the defendant for the usage of the domain name.

The main activity of the Respondent is to register and later sell domain names. An example of this is the label shown as key element in the page "Whois": "Name for sale $980" (amount exceeding registration costs). This attitude reveals the defendant's bad faith in the registration of the disputed domain name with the sole aim of obtaining profits.

The Complainant contacted the Respondent on July 26, 2000, requesting additional information. He replied saying that the selling price increased as of $29,990 for new and better offers. On further contact, the Respondent rerouted the page to a pornographic page called <prostitutas.com.> This conduct indicates bad faith.

Rerouting the name to a site with pornographic content without any intention of developing nor producing enough evidence to use the domain name to identify products or services injures Complainant's commercial activity and public image. It also violates the legitimate rights of users not to choose pornography: they are trapped in this pornographic page automatically and without previous warning. The filters usually used to avoid children visiting pornographic sites are inactive through this rerouting.

Respondent is not making a legitimate use of the domain name since users are intentionally rerouted to this site. The domain name does not reflect the page content to which it is rerouted. There is no relation at all between lv3 and pornography; condition invested by the domain name <prostitutas.com.>

Respondent

The Complaint must fail because (a) the facts presented by Complainant admit that Complainant owns no trademark, thereby failing to prove that it owns trademark rights in the domain name <lv3.com> as required by the Rules, (b) Complainant has failed to prove that Respondent owns no rights or legitimate interests in the domain name, and (c) Complainant has failed to prove bad faith registration of the domain name.

By Complainant's own admission it has no trademark rights, even in its own country of Argentina. Moreover, according to the history of Complainant's business contained at Complainant's web site, Complainant operates under the "Cadena 3" trademark at various

radio frequencies and under various government-assigned call letters, including the call letters "LV3". But Complainant does not use "LV3" as a trademark. Instead, Complainant's "Cadena 3" trademark and brand appears with prominence throughout its website. Nowhere on that site does Complainant use the term or call letters "LV3". Argentine law does not permit such call letters to be claimed as a trademark. If this combination of characters cannot serve as a trademark in Argentina where Complainant resides, it can hardly be asserted that the characters can serve as a trademark outside of the country where they are assigned. It certainly cannot be asserted that Respondent adopted or registered its domain name in bad faith when Respondent had no knowledge of these claimed, but clearly non-existent, trademark rights.

This was the holding in the *Deutsche Welle v. DiamondWare Ltd* (WIPO Case No. D2000-1202). There, as in the present case:

- the complainant did not/ does not claim to have had any rights in the United States when the domain name was registered in the United States by a U.S. company.

- the characters comprising the domain name do not by themselves denote a trade or service mark of the complainant, but are merely a broadcasting designation.

- the complainant seeks to strip a registrant of its domain name because broadcasters are now starting to move to the Internet and it is attractive to use existing call letters on the Internet.

- the respondent did not know of the existence of the complainant's alleged trademark until it received the complainant's inquiries regarding the domain.

- the complainant admitted that it had not used its alleged trademark outside of its country before the respondent registered the domain name. Hence it is impossible for the domain name to have been registered in bad faith by the U.S. business.

- the complainant is involved in reverse domain name hijacking for its own business, commercial and financial gain.

Complainant has presented no evidence that the mark LV3 is a particularly distinctive mark or is world famous. See *Toronto Star Newspapers Limited v. Virtual Dates Inc* (WIPO Case No. D2000-1612), the WIPO panel refused to transfer the domain name. There is no evidence that the Complainant has any reputation in the mark outside of Argentina and no evidence that Respondent used the domain name to attract users to the web-site by creating a likelihood of confusion with Complainant's mark.

Proof of a willingness to sell a domain name does not constitute evidence of bad faith. Moreover, when the domain name in question is generic, or a short collection of arbitrary characters, speculation in the domain name does not constitute bad faith. In the *Toronto Star* case, the WIPO panel refused to transfer the name <tstv.com> to a Canadian television station, the domain was an abbreviation for certain words (in that case "trans-sexual" and "trans-vestite"). In the present case, the designation "LV3" can stand for "love" or many

other suggestive things. In other WIPO cases, it has been held that there is no prohibition against selling a domain for value. As in the *Deutsche Welle* case, the Complainant in the present case contacted Respondent with an offer to buy the domain. Consequently, Respondent's willingness to sell the domain name does not constitute bad faith registration. Complainant, in fact, proposed a specific purchase and should not now be allowed to claim that Respondent's consideration of that offer comprises bad faith registration.

Complainant claims that Respondent has no rights or legitimate interests in the domain name. This is incorrect as evidenced by two factors: (1) under applicable trademark law, no one party presently has exclusive rights to "LV3" (in the U.S) and even in Argentina, where there is likewise no registration for such mark and where Complainant operates as "Cadena 3"): thus the term has a generic, or at least non-trademark, significance, and (2) if LV3 is capable of serving as a trademark, the either (a) Respondent owns such rights (at least in the U.S. where it makes use of the mark) or (b) even assuming *arguendo* that the Complainant owned trademark rights in "LV3" in Argentina, Respondent, without knowledge of Complainant's purported rights, used the domain name as a fanciful Internet address and thus had no bad faith.

The Rules set forth guidelines providing for Respondent's rights in LV3 Paragraph 4(c), provides that "[a]ny of the [certain enumerated] circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii)." These include two circumstances which apply to Respondent:

(i) before any notice to [respondent] of the dispute, [respondent's] use of, or demonstrable preparation to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) [respondent is] making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Complainant and Respondent are not competitors and the domain name was not registered by Respondent primarily to disrupt Complainant's business. Respondent notes that in the *Toronto Star* case, as in the present case, the Respondent displayed a willingness to sell the domains it owned. Until sold, the respondent utilizes the domain as a link to sites not owned by the Respondent, which sites deal with adult entertainment. Respondent likewise uses the domain for lawful adult entertainment and not for "pornography." Complainant's use of the pejorative term is likely an unjustified attempt to prejudice the Panel against Respondent. The implication evidences additional bad faith on the part of Complainant.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to:

> "decide a complaint on the basis of the statements and documents submitted in accordance with the policy, these rules and any rules and principles of law that it deems applicable".

The burden for the Complainant, under paragraph 4(a) of the ICANN Policy, is to show:

- that the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

- that the Respondent has no rights or legitimate interests in respect of the domain name; and

- that the domain name has been registered and used in bad faith.

In the view of the Panel, the disputed domain name is identical to the Complainant's mark. Although Argentine law forbids the registration of call signs as trademarks, that does not mean that the Complainant does not have a 'common law' mark. LV3 is clearly identified for many years as the call sign or mark of the Complainant, well known throughout Argentina. Nor does it matter that the Complainant is also well-known under another name which also have Argentine trademark registration.

The Complainant gave the Respondent no rights or legitimate interests in the disputed domain name. That finding can sometimes be sufficient for the Complainant to discharge the initial evidential burden. Paragraph 4(a) of the Policy indicates that a Respondent can demonstrate rights or legitimate interests in the domain name. Thus:

(i) before any notice to you of the dispute, your use of or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods and services; or

(ii) you (as an individual, business or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly direct customers or to tarnish the trademark or service mark at issue.

The Panel cannot find any evidence that could properly bring the Respondent into the above categories. In the Panel's view, the Respondent has not proved that he came within one of the above categories.

The second criterion is established.

Paragraph 4(b) of the Policy states:

> "For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:
>
> (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
>
> (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
>
> (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
>
> (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."

It should be noted that the circumstances of bad faith are not limited to the above.

The Panel considers that it has not been proved that the Respondent knew of the Complainant's mark at the date of registration. Whatever the evidence about bad faith continuing use, the Complainant's onus is to demonstrate by inference or otherwise bad faith at the time of registration. No such inference is possible in this case.

There is no evidence that the Complainant's mark, whilst no doubt enjoying fame in Argentina, is well-known outside that country, particularly in the United States where the Respondent is resident. A similar view was reached by a 3-person panel in *KCTS Television Inc. v. Get-on-the-Web Limited* (WIPO Case No. D2001-0154). There, the call sign of a television station operating in the North-Western United States (which call sign happened also to be a US-registered trademark) could not be presumed to have been known to a domain name registrant in England. (See also *VZ Vermögens Zentrum AG v. Anything.com* (WIPO Case No. D2000-0527) to similar effect. Moreover as was pointed out in the *Deutsche Welle* case (cit. supra) two letter.com registrations are extremely prized. It might not be surprising if a person who registers names wholesale such as the Respondent would seek to register a simple combination two letters and a number. Such a person could well be unaware that the combination of letters and/or numbers happened to be a radio station call sign somewhere in the world. It is therefore unnecessary for the Panel to consider allegations of bad faith use against Respondent after it had notice of the Complainant's mark.

7. Reverse Domain Name Hijacking

Such a claim is not infrequently made by a counter-attacking Respondent. It is rarely justified and is certainly not justified here. Respondent has offered no grounds such as those which found favour with the majority of the Panel in *Koninklijke KPN N.V. v. Telepathy Inc* (WIPO Case No. D2001-0217). See also *Sydney Opera House Trust v. Trilynx Pty Ltd* (WIPO Case No. D2000-1224).

The Panel declines to make such an order in this case.

8. Decision

The Panel accordingly decides:

(a) that the Complaint in respect of the domain name <lv3.com> be denied;

(b) that no finding of Reverse Domain Name Hijacking be made against the Complainant.

Hon. Sir Ian Barker QC
Sole Panelist

Dated: August 2, 2001