WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Viacom International Inc. v. B&B Engineering Ltd.

Case No. D2001-0667

1. The Parties

The Complainant in this administrative proceeding is Viacom International Inc., doing business at 1515 Broadway, New York, New York, USA.

The Respondent in this Administrative Proceeding is B&B Engineering Ltd., located at 11 Vasil Aprilov Street, Sofia, Sofia 1504, Bulgaria.

2. The Domain Name and Registrar

The disputed domain name is <mtvmp3s.com>. The Registrar of this domain name is Network Solutions, of Herndon, Virginia.

By registering the subject domain name with the Registrar, the Respondent agreed to the resolution of the dispute pursuant to the Policy and Rules.

3. Procedural History

This is a mandatory administrative proceeding submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy, adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy, approved by ICANN on October 24, 1999 (the "Rules") and the World Intellectual Property Organization ("WIPO") Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

The Administrative Panel consisting of one member was appointed on July 19, 2001, by WIPO.

Complainant filed its Complaint with the World Intellectual Property Organization Arbitration and Mediation Center (the "Center") on May 17, 2001, by email and on

May 21, 2001, by hardcopy. The Center dispatched to the Registrar a Request for Registrar Verification on May 23, 2001. On June 1, 2001, having verified that the Complaint satisfied the formal requirements of the Policy and the Rules, the Center formally commenced this proceeding. On June 26, 2001, the Center sent a notification of Respondent's default.

An examination of this material confirms that all technical requirements for the prosecution of this proceeding were met.

Neither party requested an opportunity to make further submissions and the Administrative Panel is content to proceed on the basis of the existing record.

4. Factual Background

The following information is derived from the Complainant's material.

The Complainant, through its wholly-owned subsidiary MTV Networks, operates several well-known television programming services. One of the best known is MTV: Music Television ("MTV"). The MTV programming service is a 24 hour-a-day, 7 day a week programming service that features primarily music-related programming including music videos, interviews, documentaries, entertainment information and news. Marks, including MTV in block letters, MTV in a stylized format, and MTV: Music Television in a stylized format (collectively the "MTV Marks") are used to promote MTV and its programs and are associated with Plaintiff.

The MTV programming service first aired in 1981. It is seen in more than 139 different territories worldwide and in over 520 million households. In the United States, MTV reaches over 77.3 million domestic subscriber households. It enjoys a level of popular success that is virtually unparalleled in cable television history. MTV is recognized as a leader in the music industry and has received numerous awards and recognition.

The Complainant's MTV programming service is advertised on television, in newspapers and magazines and on billboards and other outdoor advertising. In all advertisements, the MTV Marks are shown prominently.

The MTV Marks appear not only in off-channel advertising, but also on-air at the beginning of all programs on the MTV channel. The MTV Marks also are seen on the sets of many programs as well as in connection with station identifiers. They are the core element of on-air commercials for the programming service. These commercials have been recognized by the advertising industry for their innovation and excellence. The MTV Marks also are used in connection with programs that MTV produces including, among others: "The MTV Video Music Awards," "MTV Movie Awards," "MTV Spring Break" and "MTV Unplugged."

Complainant has spent hundreds of millions of dollars over the last 19 years in advertising and promoting its services and merchandise under the MTV Marks. It owns trademark registrations in over 100 countries for the MTV Marks. Within the U.S., these registrations include, but are not limited to:

MARK	REG. NO.	DATE OF REGISTRATION	GOODS/INT'L CLASS
MTV MUSIC TELEVISION (Stylized)	1,310,411	December 18, 1984	Cable television broadcasting services in Int'l Class 38
MTV MUSIC TELEVISION (Stylized)	1,400,277	July 8, 1986	Books, posters, bumperstickers, calendars, decals in Int'l Class 16
MTV MUSIC TELEVISION (Stylized)	1,580,650	January 30, 1990	Production of tv programs; music shows; live concerts; tv news shows in Int'l Class 41
MTV MUSIC TELEVISION	1,818,179	January 25, 1994	Cable television broadcasting services; production of tv shows in Int'l Classes 38, 41
*MTV	1,985,017	July 9, 1996	Video recordings featuring music and television programming and sound recordings featuring music in Int'l Class 9; Television broadcasting in Int'l Class 38; Production and presentation of TV news shows, sports events, fashion shows and others in Int'l Class 41; disseminating information on news, entertainment, sports, fashion etc. via the Internet in Int'l Class 42.
*MTV	1,955,606	February 13, 1996	Cable television broadcasting in Int'l Class 38; Television and entertainment services in Int'l Class 41.
MTV	1,373,948	December 3, 1985	Clothing, namely t-shirts, sport shirts, sweat shirts, hats and shorts in Int'l Class 25
MTV	1,386,644	March 18, 1986	Audio cassettes and tapes in Int'l Class 9
MTV	1,373,690	December 3, 1985	Watches in Int'l Class 14
MTV	1,373,804	December 3, 1985	Tote bags in Int'l Class 18
MTV	1,401,140	July 15, 1986	Printed matter, namely books, posters, bumperstickers, calendars, decorative stickers or decals, and paper napkins in Int'l Class 16
MTV (Stylized)	1,401,139	July 15, 1986	Printed matter, namely books, posters, bumperstickers, calendars, decorative stickers or decals, and paper napkins in Int'l Class 16
*MTV ONLINE	2,059,081	May 6, 1997	Providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information in Int'l Class 42

*MTV MUSIC TELEVISION ONLINE and Design	2,092,556	September 2, 1997	Providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information in Int'l Class 42

These registrations are valid, subsisting, in full force and effect and serve as *prima facie* evidence of the validity of the marks and of the Complainant's exclusive right to use the MTV Marks on the goods and services listed in the registrations. In addition, all of the registrations, except those denoted with an asterisk (*) are incontestable in the U.S. and serve as conclusive evidence of Complainant's exclusive right to use the MTV Marks on the goods and services listed.

The Complainant's MTV programming services has been available in Bulgaria since March 1990 and is accessible in more than 280,000 homes. The Complainant owns seven trademark registrations and two pending applications in Bulgaria for MTV or marks that feature MTV. The earliest registration was issued on April 5, 1991, prior to the Respondent's registration of the subject domain name. By the time the subject domain name was registered, the Complainant owned four registrations, one for MTV *per se* and three for the MTV Music Television logo in classes 9, 16, 25, 38, 41 and 42.

The Complainant has had a presence on the Internet since 1994. In 1995, the Complainant launched the website mtv.com, which consistently is ranked as the number one music content site among teens 13-17. During 1999, MTV.COM averaged a monthly audience of 429,000. In the case *MP3.Com Inc. v. Sander & Associates*, WIPO D2000-0579, the panelist noted that mtv.com was a prominent music website. Since at least June 1999, Complainant has made music downloads using the MP3 technology available at the <mtv.com> website. The website is accessible in Bulgaria.

MTV has been recognized by the media as changing television and as being among the most influential television channels. In a December 13, 1999 article in *The New York Times*, MTV was named as one of the 100 "most powerful corporate, media and product brands in the 20th century."

In proceedings before WIPO, panelists have recognized the fame of the MTV Marks: *Viacom Int'l Inc. v. Bryan Dulsky*, WIPO D2000-0961 (noting that Viacom's MTV trademarks are famous); *Viacom Int'l Inc. v. Sung Wook Choi and M Production*, WIPO D2000-1114 (noting that the MTV Marks are well known, enjoy an "extensive reputation" and are famous).

There has never been any relationship between the Complainant and the Respondent and the Respondent has never been licensed or authorized to use the MTV mark in any manner, including in or as part of a domain name.

The Complainant first learned about the Respondent's activities in or around September 1999. At that time, the Respondent was using the subject domain name and the Complainant's MTV: Music Television name and logo on its website.

In response to a demand letter about the use of the logo, the Respondent stated that it is a real estate agency, which recently had become involved in Internet activities. The Respondent agreed to remove the MTV logo, but did not agree to change the subject domain name.

On October 7, 1999, another letter was sent on behalf of the Complainant to the Respondent. The Complainant requested that MTV be deleted from the subject domain name. In a response dated October 12, 1999, the Respondent asserted that it had the right to use the subject domain name because the name had been registered and that it would put a disclaimer on the site. It refused to cease use of the MTV mark.

On November 7, 2000, a further demand letter was sent by the Complainant to the Respondent. No response was received.

In addition to owning the subject domain name, the Respondent owns the domain name <xxxpower.net>, which leads directly to a pornographic website.

The Respondent made not submission.

5. Parties' Contentions

A. Complainant

The Complainant relies on its registered marks and use of the letters MTV and says that the subject domain name is confusingly similar. It refers to *Viacom Int'l, Inc. v. mtvmp3.com*, WIPO D2001-0275, a recent WIPO decision in which the panelist found that the domain name <mtvmp3.com> was confusingly similar to the MTV mark. It was noted and the Complainant so contends, that the domain name was a combination of two components, MTV and MP3, the first of which is identical to the Complainant's rights and the second which is a well-known designator for a type of music file.

It is asserted that the Respondent has no legitimate interest in the subject domain name because it was registered after the Complainant acquired its rights, there is no relationship between the parties that would allow the Respondent to use the subject domain name, the Respondent is not know by the subject domain name and the subject domain name is a meaningless combination of letters and numbers.

Bad faith is said to be established by the fact that the Respondent has inserted the Complainant's mark directly into the subject domain name. The addition of "mp3s." compounds the offensiveness of the conduct because it is a generic reference to music files downloaded from the internet, which is a business of the Complainant. It also is contended that bad faith is shown by the risk of confusion caused by the Respondent's use of the subject domain name. The Complainant expresses concern that the Respondent could link its pornographic site with the subject domain name and put the Complainant's reputation at risk. It says that the Panel should infer that the Respondent intended to harm the Complainant by diluting its marks and that the Respondent's conduct suggests "opportunistic bad faith".

B. Respondent

The Respondent has asserted no position in this proceeding.

6. Discussion and Findings

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

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

(ii) the Respondent has no rights or legitimate interests in respect of the domain name;

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

The Complainant relies on determinations by other ICANN administrative panels. The decisions of other administrative panels are neither binding on this administrative panel nor determinative of the issues that it must decide, but reference to them can be of assistance.

The resolution of this dispute takes place in the context of a consideration of the requirements of paragraph 4(a) of the Policy.

A. Identical or Confusingly Similar

It is clear that the Complainant has rights to the letters "MTV". They are established by extensive trademark registrations and use. The subject domain name includes those letters. It differs only by the addition of “mp3s” and “.com”. The latter clearly is not a distinguishing feature as has been decided in numerous cases. The former is related to internet music downloading which is a business of the Complainant. The following comment appears at the website associated with the subject domain name:

“MP3 is an open audio compression codec that allows you to download near-CD quality music and audio from the web. MP3 was developed by the Motion Picture Experts Group (MPEG). The abbreviation ‘MP3’ stands for MPEG Layer 3.”

In a previous ICANN domain name dispute case, it was held that <mtvmp3.com> was confusingly similar to the Complainant’s rights. The subject domain name differs only by the addition of the letter “s”. It is appropriate in this case for this Panel to give weight to that decision.

The Administrative Panel is satisfied that the Complain has met the requirements of paragraph 4(a)(i).

B. Respondents Legitimate Interest

An examination of the relevant website shows that the subject domain name is used by the Respondent. The focus of the site is on the downloading of music. It contains a disclaimer

and an invitation to send proof of intellectual property interests to the occupier of the site. At the bottom of the web page specific reference is made to the Complainant's interests with the statement that: "This site is in no way related to MTV or MTVN".

The Respondent asserts that by registering the subject domain name it has rights to it. It also contends that it is a real estate agency, which has become involved in internet activities.

There is no ostensible link between the site and real estate activities and the Respondent's name, B & B Engineering Ltd. does not automatically connote such a business.

Its contention that merely by registering the subject domain name it achieved a right to use it regardless of the rights of others is wrong in law.

Even if the Respondent has a legitimate interest in mp3, which is the principle subject of the material on the website, in light of the Complainant's extensive use of the mark MTV there is a serious question as to the legitimacy of the Respondent's interest in the subject domain name. The explanation for its use, which the Complainant properly provided to the Panel, does little to answer the question. The Respondent has offered nothing more.

The Administrative Panel is satisfied that the Complain has met the requirements of paragraph 4(a)(ii).

C. Bad Faith

A finding that a respondent has registered a domain name which is confusing similar to the rights of a complainant and that the Respondent does not have a legitimate interest in the domain name, does not lead automatically to a conclusion that the domain name was registered and used in bad faith. Bad faith is a separate ingredient that a complainant must establish, but it can do so relying on the evidence overall and on inferences that derive from that information and legitimately from other conclusions in the case.

The fact that the Complainant fears that its mark may be devalued if a link were established between the subject domain name and the Respondent's pornographic site, has little weight in the absence of any evidence to suggest that this may occur.

There is little if any evidence that directly supports a finding of bad faith in this case. The Respondent has not offered to sell the subject domain name. It has complied in part with the Complainant's requests. A specific disclaimer has been inserted. It has offered an explanation for the registration and use and stated a legal basis for refusing to change the name. The fact that its position may be wrong in law does not make its assertion bad faith.

Weighing against the Respondent is the use of the letters MTV. On the information provided in the case, a reasonable inference can be drawn that the Respondent was aware of the Complainant's interests. Deletion of a logo and the insertion of a disclaimer do nothing to avoid access to the site through the website use of the subject domain name. There is no apparent reason for it and no explanation offered by the Respondent. Its only explanation is unconnected to the actual use.

The lack of any ostensible link to the Respondent's business also makes its use of the Complainant's mark suspect.

Mere confusion or the likelihood of confusion does not establish bad faith, but it is a factor which, considered in the context of the information as a whole and particularly without explanation by the Respondent, supports an inference of bad faith.

The Administrative Panel is satisfied that the Complain has met the requirements of paragraph 4(a)(iii).

7. Decision

Based on the information provided to it and on its findings, the Administrative Panel concludes that the complaint is established. The Complaint asks that the subject domain name be transferred to it. The Administrative Panel so orders.

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Edward C. Chiasson, Q.C.
Sole Panelist

Dated: August 1, 2001