WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Paramount Stations Group of Fort Worth/Dallas, Inc. v. Netico, Inc.

Case No. D2001-0715

1. The Parties

1.1 The Complainant is Paramount Stations Group of Fort Worth/Dallas, Inc., a Virginia corporation with its principal place of business in Texas, USA.

1.2 The Respondent is Netico, Inc., a corporation having an address of P.O. Box 80540, Las Vegas, Nevada 89180-0540, USA.

2. The Domain Name and Registrar

2.1 The disputed domain names are <ktxa.com> and <ktxa.net>.

2.2 The registrar of the disputed domain names is Internet Names Worldwide, Level 2, 120 King Street, Melbourne, Victoria 3000, Australia.

3. Procedural History

3.1 Complainant initiated the proceeding by filing a Complaint, received by the WIPO Arbitration and Mediation Center ("WIPO") on May 30, 2001.

3.2 On June 11, 2001, all formal requirements for the establishment of the Complaint were checked by WIPO and found to be in compliance with the ICANN Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Domain Name Dispute Resolution Policy (the "Supplemental Rules"). The Panel accepts the WIPO checklist as evidence of proper compliance with the Policy, Rules, and Supplemental Rules.

3.3 On June 11, 2001, WIPO transmitted notification of the Complaint and commencement of the proceedings to Respondent.

3.4 On July 4, 2001, WIPO transmitted notification of Respondent's default to the Respondent.

3.5 On July 9, 2001, WIPO invited the undersigned to serve as panelist in this administrative proceeding, subject to receipt of an executed Statement of Acceptance and Declaration of Impartiality and Independence ("Statement and Declaration"). On July 9, 2001, the undersigned transmitted by facsimile the executed Statement and Declaration to WIPO.

3.6 On July 11, 2001, 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 July 25, 2001.

The Panel has not received any further 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

4.1 Complainant Paramount Stations Group of Fort Worth/Dallas, Inc. (hereinafter "Paramount") has used the mark KTXA since at least January 4, 1981, in interstate commerce in connection with its television broadcasting services.

4.2 The Respondent registered the domain name <ktxa.com> on September 30, 2000, and the domain name <ktxa.net> on December 11, 2000. Neither domain name is currently active.

5. Parties' Contentions

A. Complainant

Complainant states:

> "Since at least January 4, 1981, Complainant has used the KTXA mark in interstate commerce in connection with its broadcasting services; specifically, the broadcasting services of KTXA-TV, a television station owned and operated by Complainant that broadcasts to the Dallas/Fort Worth, Texas market."
>
> "Although Complainant does not own a federal trademark registration for the KTXA mark, Complainant has common law trademark rights in the KTXA mark since it has long-used the mark as a trademark to promote its television broadcasting services."
>
> "Complainant is famous for its television broadcasting and entertainment services. Complainant undertakes broadcasting and entertainment services under the KTXA mark, including use of the KTXA mark as its call letters and business name in the Dallas/Fort Worth, Texas market."

"Complainant has spent a substantial sum of money advertising and promoting its broadcasting services under the KTXA mark, which has resulted in the creation of a great deal of goodwill and popularity for the KTXA mark."

"Complainant also actively promotes its services on the Internet. In fact, prior to Respondent's registration of the KTXA.com domain name, Complainant had registered and used the domain name KXTA.com to market and promote its services via the Internet. (*See* Annex D). However, after Complainant inadvertently let its registration lapse, Respondent registered the KTXA.com domain name, thereby preventing Complainant from reflecting the KTXA mark in its domain name. As a result, Complainant now uses the Paramount Television Stations Group website, located at www.paramountstations.com/KTXA. This website displays Complainant's KTXA trademark on each page of the website in connection with Complainant's business logo."

"As a result of Complainant's long use of the KTXA mark, its advertising and promotional efforts and expenditures in connection with the mark (including its promotional efforts on the Internet), and the wide recognition achieved for the mark, the public has come to associate the KTXA mark with services originating with, emanating from, sponsored by or otherwise associated with or approved by Complainant, thus entitling Complainant to assert common law trademark rights in the KTXA mark."

"On September 30, 2000, Respondent registered the domain name KTXA.com, and on December 11, 2000, Respondent registered the domain name KTXA.net, both of which are virtually identical to Complainant's KTXA mark. The addition of the generic top-level domain (gTLD) names ".com" and ".net" are without legal significance."

"Respondent has no rights or legitimate interests in the disputed domain names. Respondent is not (either as an individual, business or other organization) commonly known by the name KTXA, KTXA.com or KTXA.net, and has never been authorized by Complainant to use those names or the KTXA mark."

"Further, after registering the KTXA.com and KTXA.net domain names, Respondent used the names to direct Internet users to a website owned by Respondent, located at "www.usaonline.com." After receiving a cease and desist letter from Complainant, Respondent caused the domain names to resolve to "www.romancasino.com," an on-line gambling site, which tarnishes Complainant's KTXA mark. (*See* Annex F). The fact that Respondent caused the disputed domain names to disappear from a browser window in favor of its "usaonline.com" domain, and the fact that the names now resolve to an on-line gambling site, is compelling evidence of Respondent's lack of any rights or legitimate interest in the domain names, and evidences Respondent's bad faith registration and use of the names."

"On or about January 24, 2001, after learning of Respondent's registration of the KTXA.com and KTXA.net domain names, counsel for Complainant sent a letter to Respondent, advising it that Complainant was the owner of the KTXA mark, and that Respondent's registration of the disputed domain names constituted a violation of Complainant's rights in its KTXA mark."

"After receiving the letter, Respondent directed Complainant to his attorney, Ammar Kubba. Mr. Kubba asked Complainant counsel, David Garfield Roland,

Esq., to make an offer for the KTXA.com domain name, which Mr. Roland refused to do."

"Thereafter, on or about March 26, 2001, Mr. Roland received a voice mail message from Mr. Kubba, in which Mr. Kubba advised Complainant that Respondent was willing to sell the KTXA.com domain name to Complainant for "around $5,000.00." (*See* Annex H, ¶ 4). On or about March 29, 2001, Complainant sent a letter to Mr. Kubba, advising him that Complainant would not pay "around $5,000.00" to recover the domain name."

"In addition to Respondent's offer to sell the KTXA.com domain name to Complainant, Respondent also lists the KTXA.net domain name as "FOR SALE" on its WhoIs contact information (*See* Annex A), which further demonstrates Respondent's bad faith."

"Respondent's offers to sell the KTXA domain names for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain names establishes that the domain names have been registered and are being used in bad faith."

"Moreover, the fact that Respondent initially used the KTXA domain names to divert individuals looking for Complainant or its KTXA television station to Respondent's "usaonline.com" website further demonstrates Respondent's bad faith, in that Respondent sought to improperly benefit from the goodwill that Complainant has developed in its KTXA mark."

"Finally, the fact that Respondent has registered both the domain names KTXA.com and KTXA.net, thereby preventing Complainant from reflecting the KTXA mark in its domain name, evidences precisely the pattern of bad faith conduct that is proscribed by the Policy."

B. Response

Respondent did not file a Response to the Complaint.

6. Discussion and Findings

6.1 The Uniform Domain Name Dispute Resolution Policy (the "Policy"), adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 (with implementing documents approved on October 24, 1999), is addressed to resolving disputes concerning allegations of abusive domain name registration. The Panel will confine itself to making determinations necessary to resolve this administrative proceeding.

6.2 It is essential to dispute resolution proceedings that fundamental due process requirements be met. Such requirements include that a Respondent have notice of proceedings that may substantially affect its rights. The Policy, and the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), establish procedures intended to assure that Respondents are given adequate notice of proceedings commenced against them, and a reasonable opportunity to respond (see, *e.g.,* paragraph 2(a) of the Rules).

6.3 WIPO forwarded notification of the Complaint to the Respondent via post/courier, facsimile and email in accordance with the contact details found in the appropriate WHOIS database. WIPO also forwarded notification of default to the Respondent via post/courier and email.

6.4 Based on the methods employed to provide the Respondent with notice of the Complaint and default the Panel is satisfied that WIPO took all steps reasonably necessary to notify the Respondent of the filing of the Complaint and initiation of these proceedings. The Panel also finds that the failure of the Respondent to furnish a reply is not due to any omission by WIPO.

6.5 Paragraph 4(a) of the Policy sets forth 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 of the domain name; and

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

In the administrative proceeding, the Complainant must prove that each of these three elements are present.

6.6 As the Respondent has failed to submit a Response to the Complaint, the Panel may accept as true all of the allegations of the Complaint. *Talk City, Inc. v. Michael Robertson*, WIPO Case No. D2000-0009, February 29, 2000.

6.7 Based upon the common law trademark KTXA and the continuous use of the mark, the Complainant clearly has rights in the mark.

6.8 Complainant asserts that the domain names "ktxa.com" and "ktxa.net" are identical to the trademark KTXA.

6.9 The Panel agrees with the Complainant that the addition of the generic top-level domain (gTLD) names ".com" and ".net" are without legal significance.

6.10 The Panel finds the <ktxa.com> and "ktxa.net" domain names are identical to the common law trademark KTXA, and that the Complainant has established it has rights in the mark KTXA, pursuant to paragraph 4(a)(i) of the Policy.

6.11 Paragraph 4(c) of the Policy lists several circumstances, without limitation, that if found by the Panel shall demonstrate the Respondent's rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii). In particular, paragraph 4(c) states:

(i) before any notice to you [Respondent] 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 or 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 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.

6.12 There is no evidence in the record that would indicate that Respondent has any rights or legitimate interests in respect of the domain names <ktxa.com> and <ktxa.net>.

6.13 The Panel finds that the Respondent has no rights or legitimate interests in respect of the domain names <ktxa.com> and <ktxa.net>, pursuant to paragraph 4(a)(ii) of the Policy.

6.14 Paragraph 4(b) of the Policy lists several factors, without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. In particular, paragraph 4(b) states in part:

(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) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website 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 website or location or of a product or service on your website or location.

6.15 Complainant has submitted the declaration David Garfield Roland, an attorney in the Contracts, Rights and Development section of the CBS Law Department, in which Mr. Roland declares the following:

> "Subsequently, I spoke to Ammar Kubba, Esq., an attorney purporting to represent Mr. Doumanian [Respondent's agent] in connection with this domain name dispute. Mr. Kumma asked me to make an offer for the KTXA.com domain name on behalf of Complainant, which I refused to do."
>
> "Thereafter, on or about March 26, 2001, I received a voicemail message from Mr. Kubba, in which he advised me that Mr. Doumanian was willing to sell the KTXA.com domain name to Complainant for "around $5,000.00""

6.16 In the absence of contrary evidence, Respondent's offer to sell the domain name <ktxa.com> to the Complainant for approximately $5,000.00 is clearly evidence of registration and use of the domain names in bad faith.

6.17 The Panel finds that the Respondent's offer to sell the domain name <ktxa.com> for approximately $5,000.00 is also clearly in excess of any reasonable out-of-pocket costs that could have been associated with each domain name.

6.18 In addition to Respondent's offer to sell the <KTXA.com> domain name to Complainant, the following acts also establish the Respondent's registration and use of the domain names in bad faith:

(a) Respondent lists the KTXA.net domain name as "FOR SALE" on its Whois contact information. *See* UDRP Policy, ¶4(b)(i).

(b) Respondent has registered both the domain names <KTXA.com> and <KTXA.net>, thereby preventing Complainant from reflecting the KTXA mark in its domain name. *See* UDRP Policy, ¶4(b)(ii).

(c) Respondent initially used the KTXA domain names to divert individuals looking for Complainant or its KTXA television station to Respondent's <usaonline.com> website. *See* UDRP Policy, ¶4(b)(iv).

6.19 Although not directly related to the present dispute, the Panel notes that Respondent is no stranger to these proceedings. At least two other WIPO Panels have found that individuals with either the same address or contacts as Registrant had engaged in abusive registration of domain names. See *LOFO High Tech Film GmbH v. Hagop Doumanian*, WIPO Case No. D2000-1085, November 3, 2000; *Diversified Gestao e Investimientos Lda. v. Krikor Doumanian*, WIPO Case No. D2000-1749, February 13, 2001. These rulings demonstrate a pattern of abusive registration that only bolsters the conclusions of this Panel.

6.20 The Panel finds the Complainant has established that the Respondent registered and used the domain names <ktxa.com> and <ktxa.net> in bad faith, pursuant to paragraphs 4(b)(i)(ii) and (iv) of the Policy.

7. Decision

As the Complainant, Paramount Stations Group Of Fort Worth/Dallas, Inc., has established that the Respondent, Netico, Inc., has engaged in abusive registration of the domain names <ktxa.com> and <ktxa.net> within the meaning of paragraph 4(a) of the Policy, the Panel orders that the domain names <ktxa.com> and <ktxa.net> be transferred to the Complainant.

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R. Eric Gaum
Sole Panelist

Dated: July 18, 2001