WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Viacom International Inc. v. Erwin Tan

Case No. D2001-1440

1. The Parties

Complainant is Viacom International Inc., USA, represented by Fross Zelnick Lehrman & Zissu, New York, New York, USA.

Respondent is Erwin Tan, Indonesia.

2. The Domain Name and Registrar

The domain names at issue are <mtv-girl.com>, <mtv-girl.net> and <mtv-girl.org>.

The Registrar is Network Solutions, Inc., Virginia, USA.

3. Procedural History

A Complaint was submitted to the World Intellectual Property Organization Arbitration and Mediation Center (the "WIPO Center") on December 7, 2001, and subsequently in hard copy on December 11, 2001. The WIPO Center sent an Acknowledgement of Receipt of Complaint to the Complainant on December 11, 2001.

On December 12, 2001, a Request for Registrar Verification was transmitted to the Registrar. On December 14, 2001, the Registrar confirmed that they were in receipt of the Complaint sent to them by the Complainant and that the domain names <mtv-girl.com>, <mtv-girl.net> and <mtv-girl.org> were registered with them and were in "active" status. The Registrar forwarded at the same time the requested WHOIS details.

A Formal Requirements Compliance Checklist was completed by the WIPO Center on December 20, 2001. The Panel has independently determined and agrees with the assessment of the WIPO Center that the Complaint is in compliance with the requirements of the Uniform Domain Name Dispute Resolution Policy ("the Policy") and the Rules for Uniform Domain Name Dispute Resolution Policy ("the Rules"), as approved by ICANN on October 24, 1999, and the WIPO Supplemental Rules for

Uniform Domain Dispute Resolution Policy (the "WIPO Supplemental Rules"), in effect as of December 1, 1999.

The Complainant paid on time and in the required amount the fees for a single-member Panel.

On December 20, 2001, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification") was transmitted to the Respondent by the required means, setting a deadline of January 9, 2002, by which the Respondent could file a Response to the Complaint.

On January 10, 2002, having received no Response from the designated Respondent, the WIPO Center transmitted to the Respondent a Notification of Respondent Default.

On January 25, 2002, the WIPO Center invited Knud Wallberg to serve as a Panelist in the case, and transmitted to him a Statement of Acceptance and Request for Declaration of Impartiality and Independence.

Having received Knud Wallberg's Statement of Acceptance and Declaration of Impartiality and Independence, the WIPO Center transmitted on February 1, 2002, to the parties a Notification of Appointment of Administrative Panel and Projected Decision Date, in which Knud Wallberg was formally appointed as the Sole Panelist. The Projected Decision Date was February 15, 2001.

The Sole Panelist finds that the Administrative Panel was properly constituted and appointed in accordance with the Rules and WIPO Supplemental Rules.

The Administrative Panel has issued its Decision based on the Complaint, the Policy, the Rules, the WIPO Supplemental Rules, but without the benefit of a Response from the Respondent.

4. Factual Background

Viacom, through its wholly-owned division MTV Networks, operates several well-known television programming services. One of the best known is MTV: Music Television ("MTV"). In the United States, 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 firmly associated with Complainant.

The MTV programming service first aired in 1981. MTV has become so popular that it is seen in 139 territories worldwide and in over 365 million households. In the United States alone, MTV reaches over 79 million domestic subscriber households. MTV enjoys a level of popular success that is virtually unparalleled in cable television history. MTV is recognized as a leader in the entertainment industry and has received numerous awards and recognition of its achievements.

Worldwide, 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 prominently shown.

The MTV Marks not only appear in off-channel advertising worldwide but also appear on-air at the beginning of all programs aired on the MTV channel. The MTV Marks are also seen on the set of many programs as well as in connection with station identifiers. In addition, the MTV Marks 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 are also 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." Some of these shows are aired worldwide including in Indonesia.

Complainant has spent hundreds of millions of dollars over the last 20 years in advertising and promoting its services and merchandise under the MTV Marks. Complainant owns trademark registrations in over 100 countries for the MTV Marks.

Complainant's MTV programming service has been available in Indonesia since 1995, and is accessible in more than 16 million homes. In addition Viacom owns 15 trademark registrations and 3 pending applications in Indonesia all for marks which feature MTV. The earliest registrations issued in 1994, and all 15 issued before Respondent registered the contested domain names.

In addition, Complainant has used the MTV mark in connection with radio broadcasts in Indonesia. Test broadcasts occurred on the Sky Network as early as April, 2000, and, as of June 7, 2000, Complainant officially launched its radio service in Indonesia under the name "MTV On Sky 101.6 FM."

Complainant has had a presence on the Internet since 1994. In 1995, Complainant launched the website mtv.com, which is consistently ranked as the number one music content site among teens 13-17. In 1999, mtv.com averaged a monthly audience of 4,619,945 unique visitors; in the year 2000, the average monthly audience was 7,708,363.

Also, in 2001, Complainant launched the website<mtvgirl.com>, specifically designed for teenage girls and offering access to MTV pop culture, music and entertainment, as well as health and beauty information and other community building content. These websites are available to consumers in Indonesia. In addition, consumers in Indonesia can access many of Complainant's other websites including <mtvasia.com>, <mtv-china.com>, <mtvchinese.com>, <mtvjapan.com>, <mtvkorea.co.kr> and <mtvindia.com>.

There can be little doubt that the Complainant's MTV Marks are famous and that their fame existed long prior to Respondent's registration of the contested domain names.

Respondent's Activities

On July 16, 2000, Respondent registered the contested domain names. There is no at present no substantive website content available at these names. Instead, users who type in the domain names are brought to a "parking page" of Network Solutions. No other information on the Respondent has been presented to the Panel.

5. Parties' Contentions

A. Complainant

The following is taken from the Complaint.

Viacom's Rights in the MTV Marks

There can be no dispute but that Viacom has strong rights in the MTV Marks in the U.S. and abroad, including in Indonesia. The existence of its valid and subsisting trademark registrations for the MTV Marks in the USA and in Indonesia were shown in the Annexes to the Complaint. In addition, the extensive use made by Complainant of its mark throughout the world makes it clear that Viacom has sufficient rights in its MTV Marks so that it can invoke the Policy, which has been recognized in other UDRP cases, such as WIPO Case D2000-0961 and WIPO Case D2000-1114. In WIPO Case D2001-0603, the panelist recognized that the rights of Viacom in the MTV marks as recited herein were sufficient to proceed, and prevail, against an Indonesian Respondent.

The contested domain names are Identical or Confusingly Similar to the MTV Marks

The contested domain names all incorporate in whole Complainant's famous registered MTV Marks. The only deviation is that Respondent has added "girls" as a suffix. The addition of this generic term does not distinguish the domain name from Complainant's MTV mark. Indeed, adding this term is likely to actually create confusion since it could lead consumers to believe that the domain name is related to the <mtvgirl.com> website operated by Complainant. Confusion could also result because consumers may believe that the contested domain names refer to young female singers such as Brittany Spears or Christina Aguillera that are featured on the MTV channel, that they refer to the women in the music videos shown on MTV, or to the various female hosts of MTV programming. As such, consumers are likely to believe that the contested domain names are related to an official MTV website.

Respondent has no Rights or Legitimate Interests in the contested domain names

Numerous facts exist here to show that Respondent can demonstrate no legitimate interests in the contested domain names. First, the domain names were registered <u>after</u> Complainant had obtained numerous U.S. federal trademark registrations for its MTV Marks, <u>after</u> the MTV Marks were registered in Indonesia, <u>after</u> the MTV Marks had been used worldwide including in Indonesia, <u>after</u> Complainant had been extensively advertising its MTV Marks in Indonesia, <u>after</u> Complainant began operating the MTV.com website and other websites accessible to consumers in Indonesia, and <u>after</u> Complainant launched its radio services under the MTV marks.

Second, there exists no relationship between Complainant and Respondent that would give rise to any license, permission or authorization by which Respondent could own or use the contested domain names. Under the circumstances, Respondent cannot show any legitimate rights or interests in the names.

Third, Respondent is not using the domain names in connection with a bona fide offering of goods or services nor is Respondent making a legitimate non-commercial or other fair use of the domain names. Indeed, although the contested domain names have been registered since July 16, 2000, no functioning websites have ever been established under any of the domain names. This failure to use the domain names further supports a finding of no legitimate interests or rights in the domain names.

Fourth, there is no evidence to suggest that Respondent is now or has ever been known by the name MTV or MTV-Girl. While Respondent was given the opportunity to explain why it adopted the domain names, it chose instead to ignore Complainant's cease and desist letter, giving rise to the inference that Respondent has no legitimate rights. Taken together, all of these facts show that Respondent has no legitimate rights or interests in the contested domain names.

Finally, Respondent lacks the right to use the domain names since the contested domain names all falsely suggest that Viacom is or may be associated with the domain name registrant or may be authorizing or sponsoring any eventual website at the names.

Where, as here, the MTV Marks are venerable and distinctive and where, as here, Respondent was on constructive if not actual notice of the MTV Marks, it is not reasonably possible for Respondent to demonstrate any legitimate interest in the domain names

Respondent Registered and Used the contested domain names in Bad Faith

First, the fact that Respondent has taken Complainant's very trademark MTV for his domain names is evidence of bad faith. Second, Respondent has failed to use the contested domain names to sell or provide any goods or services. This too is evidence of bad faith. Third, Respondent has failed to respond to Complainant's cease and desist letter. Panelists have in previous decisions found this to constitute evidence of bad faith. Respondent was given the opportunity to explain why the domain names were taken and his plans for using the domain names. By failing to respond, Respondent in effect has admitted that there was no bona fide reason for taking the contested domain names, no legitimate rights or interests in those domain names and that the domain names were registered and are being used in bad faith.

Bad faith is also found from the fact that the domain names are so obviously connected with the Complainant that its very use by someone with no connection with the Complainant suggests "opportunistic bad faith.". The MTV mark is so famous that Respondent had to have known about it. As such the registration of the mark as a domain name without any color of title or justification is proof of bad faith on Respondent's part.

Additionally, Internet users are likely to believe that the contested domain names are connected to a website associated with or sponsored by Complainant. Given that Respondent has never been authorized by Complainant to use the MTV Marks, the very fact that Respondent has registered the contested domain names establishes bad faith use and registration. By using Complainant's marks as his domain names, Respondent is attempting to create an association with Complainant and to usurp Complainant's goodwill in violation of Complainant's rights. Because the ultimate effect of any use of the contested domain names

would be to cause confusion with Viacom, the use and registration of the domain names must be considered to be in bad faith

Further evidence of bad faith is found by virtue of the fact that Respondent has been warehousing the contested domain names for more than one year.

By knowingly choosing domain names consisting of Complainant's MTV marks, Respondent intentionally created a situation at odds with the legal rights and obligations of the parties. The conduct of Respondent in registering and maintaining the contested domain names leads to a conclusion of bad faith.

B. Respondent

As mentioned above in section 3, the Respondent has not filed a Response in accordance with the Rules, Paragraph 5.

6. Discussion and Findings

According to Paragraph 15(a) of the Rules, the Panel shall decide a Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

1) 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; and

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

3) that the domain name has been registered and is being used in bad faith.

Identical or Confusingly Similar

The Complainant's mark MTV is registered and has been used in numerous countries around the world including in Indonesia. In addition the mark must be considered to be a well-known mark.

The domain names <mtv-girl.com>, <mtv-girl.net> and <mtv-girl.org> contain the word MTV in full as the first and dominant part of the domain name. To this part is added the descriptive word "-girl" and the gTLD suffix. Under these circumstances the domain name must be considered to be confusingly similar to the trademark MTV in which the Complainant has rights. See in particular WIPO Case D2000-0102 where the domain name <nokiagirls.com> was found confusingly similar to the NOKIA trademark

The prerequisites in the Policy, Paragraph 4(a)(i) are therefore fulfilled.

Legitimate Interest

The Complainant has not licensed or otherwise permitted the Respondent to use its trademark or to apply for any domain name incorporating the mark. Further, the Respondent has not demonstrated that he has any prior rights or legitimate interests in the domain name, and, in the absence of other information, the Panel finds it highly unlikely that such legitimate interest may exist.

The prerequisites of the Policy, Paragraphs 4(a)(ii) are also considered fulfilled.

Bad Faith

Paragraph 4(a)(iii) of the Policy further provides that the Complainant must prove registration and use of the domain name in bad faith. Paragraph 4(b) sets out, by way of example, the kind of evidence that may be put forward.

Given the nature of the Respondent's business and the fame of the MTV mark *inter alia* in Respondents home country Indonesia, Respondent must have been fully aware of the existence of the Complainant and its affiliated companies and of their rights to the trademark MTV at the time he registered the domain name.

The Respondent has no reason to use the domain name other than to attract Internet users by suggesting that the Complainant is associated with the Respondent or has endorsed the Respondent's products. This is an attempt to misappropriate the Complainant's reputation for commercial gain. In this connection it should be noted that this panel finds that passive use is also use within the meaning of the Policy. See WIPO Case D2000-0003 and several subsequent decisions.

The Panel therefore concludes that the Complainant has proved that the Respondent was acting in bad faith pursuant to Paragraph 4(a)(iii) of the Policy.

The above mentioned considerations and views are supported by several previous decisions under the UDRP.

7. Decision

In view of the above circumstances and facts the Panel finds that the domain names registered by the Respondent is confusingly similar to the trademark in which the Complainant has rights, that the Respondent does not have any rights or legitimate interests in respect of the domain name, and that the domain name has been registered and is being used in bad faith.

Consequently the Panel decides that the domain names <mtv-girl.com>, <mtv-girl.net> and <mtv-girl.org> be transferred to the Complainant.

Knud Wallberg
Sole Panelist

Dated: February 15, 2002