WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Cox Holdings, Inc. v. Private

Case No. D2001-1446

1. The Parties

Complainant is Cox Holdings, Inc. ("Cox"), a Delaware Corporation, doing business at 1400 Lake Hearn Drive, N.E., Atlanta, Georgia 30319, U.S.A. Complainant's authorized representative is Mitchell H. Stabbe, Esq., of Dow, Lohnes & Albertson, PLLC, 1200 New Hampshire Avenue, N.W., Suite 800, Washington D.C. 20036-6802, U.S.A.

The Respondent is Private, whose address is Parkovaya Street 12a-24, Moscow, Russia 312022.

The Respondent originally named in the Complaint was Andrey Vasiliev, whose address is Free Domains Parking, Glavpochtamt, d/v Vasiliev Andrey Vladimirovich, Moscow, Russian Federation.

Subsequent to the filing of the Complaint but prior to the commencement of the proceeding, the Complainant established by contacting the Registrar that the name of the Respondent is Private. The Administrative Contact and Technical Contact for the Complainant are Andrey Vasiliev, whose address is Free Domains Parking, Glavpochtamt, d/v Vasiliev Andrey Vladimirovich, Moscow, Russia 101000. The Complainant prepared an amendment to the Complaint and forwarded copies of the amendment to the Respondent, the Registrar and the WIPO Center.

2. The Domain Name and Registrar

The domain name in issue is <kiro7.com>. The Registrar with which the disputed domain name is registered is BulkRegister.com of 10 East Baltimore Street, Suite 1500, Baltimore, Maryland 21202, U.S.A.

The current status of the domain name <kiro7.com> is "Registrar LOCK".

3. Procedural History

The Complaint was received on December 10, 2001, by the WIPO Arbitration and Mediation Center by e-mail. A hard copy was received by the Center on December 13, 2001. The Center acknowledged receipt of the Complaint on December 14, 2001.

The Complainant also sent the original Respondent a copy of the Complaint by e-mail and courier on December 10, 2001. A copy of the Complaint was also sent by facsimile and first-class mail to the Registrar, Network Solutions, Inc.

A request for Registrar verification was forwarded to Network Solutions, Inc. on December 19, 2001. On December 20, 2001, Network Solutions, Inc. advised that NSI was not in receipt of the Complaint sent by the Complainant. Network Solutions, Inc. further advised that NSI is not the Registrar of the domain name <kiro7.com> and that the Registrar is BulkRegister.com, Inc. On December 21, 2001, the Center forwarded a request for Registrar verification to BulkRegister.com, Inc. BulkRegister.com, Inc. responded to the Center on January 10, 2002, by e-mail advising that the "Complainant listed Andrey Vasiliev as the Respondent which is not the registrant to the domain name". On January 11, 2002, the Center requested BulkRegister to answer all the questions in the request for Registrar verification.

On January 11, 2002, the Complainant's representative requested the Center by telephone and e-mail to amend the Complaint to show the Respondent's name in the caption and the text as "Private" and requested the Center to amend paragraph 4(b) of the Complaint to show that the Registrar as BulkRegister.com. The Complainant's representative also requested amendment of paragraph 10 of the Complaint to read: "Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the principal place of business of the registrar, the State of Maryland".

On January 14, 2002, the Center acknowledged receipt of the Amendment to the Complaint.

On January 14, 2002, the Center compiled a Formal Requirements Compliance checklist and confirmed that formal requirements had been complied with.

A printout dated January 14, 2002, from the Uwhois.com site providing information on the domain name <kiro7.com> shows the registrant as Private, Parkovaya Str. 12a-24, Moscow, Russia, 312022.

On January 14, 2002, the Center forwarded Notification of the Complaint and Commencement of Administrative Proceedings, together with a copy of the Complaint and Amendment to the Complaint to the Respondent Private, by e-mail and also by courier to Private at Parkovaya Street 12a-24, Moscow 312022 Russia. The Notification, Complaint, and Amendment to the Complaint (without attachments) were copied to the Complainant and the Registrar by e-mail. The Center advised the Respondent that the formal date of the commencement of the administrative proceeding was January 14, 2002, and that the last day for sending a Response to the Complainant and to the Center was February 3, 2002.

The Notification of the Complaint and Commencement of Administrative Proceedings was returned to the Center by Federal Express marked "Returned/Not Delivered". The shipping label shows that the package was addressed to Private at Parkovaya

Street 12a-24, Moscow 312022 Russia. The e-mail delivery system advised that the message could not be delivered to "postmaster@kiro7.com".

On January 15, 2002, the Registrar BulkRegister.com confirmed receipt of the Complaint, confirmed that the domain name is registered with BulkRegister.com and also confirmed that the Respondent is the current registrant of the domain name <kiro7.com>. The Registrar also confirmed the above-noted details of the registrant Private.

On February 5, 2002, the Center notified the Respondent that the Respondent was in default and attached a formal Notification of Respondent Default. The Notification of Default was forwarded by e-mail and courier. The courier package addressed to Private at Parkovaya Street 12-24, Moscow, Russia was returned by Federal Express marked "not delivered".

The Complainant elected to have the dispute decided by a single-member Panel. The Center appointed Ross Carson as the Sole Panelist. Mr. Carson duly submitted a Statement of Acceptance and Declaration of Impartiality and Independence. On February 26, 2002, the Center forwarded Notification of Appointment of Administrative Panel to the Parties.

Also on February 26, 2002, the Center e-mailed the Transmission of Case File, the Complaint, and Amendment to Complaint to the Panelist and forwarded a hard copy by courier. The date scheduled for the Panel's decision is March 12, 2002. The language of the proceedings is English.

4. Factual Background

The Trademarks

Complainant has common law trademark rights in the marks KIRO, KIRO7 and KIRO 7 which are used by Complainant primarily for television broadcast and entertainment services focused on the Seattle, Washington market. The mark KIRO indicates the call letters of Complainant's broadcast station, located on Channel 7 in Seattle, Washington, and the marks KIRO7 and KIRO 7 are also used by Complainant in conjunction with the same.

Complainant has continuously and extensively used the KIRO, KIRO7 and KIRO 7 marks to identify, advertise and promote its products and services since at least as early as 1958.

5. Parties' Contentions

A. Complainant

(a) The Complaint is based on the common law trademarks KIRO, KIRO7 and KIRO 7. These common law trademarks are used by Complainant primarily for television broadcast and entertainment services focused on the Seattle, Washington market which is the twelfth largest television market in the United States.

(b) Complainant submits that it has continuously and extensively used the KIRO, KIRO7 and KIRO 7 marks to identify, advertise and promote its products and services since at least as early as 1958.

(c) Complainant submits that it has invested a substantial amount of time and resources to promote and advertise its KIRO, KIRO7 and KIRO 7 marks, products, services, and website. Complainant spends the equivalent of several million dollars annually to promote the KIRO, KIRO7 and KIRO 7 brand through its own on-air use as well as through outside media. Complainant also spends millions of dollars annually in advertising and in-kind donations to community service organizations for public service campaigns and joint community projects.

(d) Complainant submits that it has developed extremely valuable goodwill and an outstanding reputation in its KIRO, KIRO7 and KIRO 7 marks which are associated exclusively with Complainant and/or its affiliated entities and have contributed to the popularity and fame of Complaint's television broadcast station. For the last two Neilsen Media Research rating periods, Complainant's KIRO 7 television station was the most watched television station in the Seattle market.

(e) Complainant also operates a website, accessed through the domain name <kiro.com> which as first registered in January 1995, promotes its KIRO, KIRO7 and KIRO 7 products and services and is itself branded under the KIRO 7 mark. In October 2001, there were 140,000 unique visitors to Complaint's KIRO 7 website. A true copy of Complainant's KIRO 7 website is attached as Annex C.

(f) Complainant submits that its KIRO, KIRO7 and KIRO 7 marks are also well-known nationally, outside its primary Seattle market. Attached as Annex D are print-outs of nationally circulated newspaper or wire stories that either identify Complainant KIRO news broadcasts as the source of a story or discuss Complaint's KIRO news broadcasts.

Respondent's Use and Registration of the Domain Name

(g) According to the WhoIs record, Respondent registered the <kiro7.com> domain name on March 13, 2000, well after Complainant's first use of the KIRO, KIRO7 and KIRO 7 marks.

(h) Respondent is not a licensee of Complainant, nor is it authorized to use Complainant's KIRO, KIRO7 or KIRO 7 marks. Respondent registered the <kiro7.com> domain name without the authorization, knowledge or consent of Complainant.

(i) When the use and registration of the <kiro7.com> domain name came to Complainant's attention, the domain name resolved to a website that contains framed content from the "Half.com" website (Half.com is an eBay company). Currently, the <kiro7.com> domain name resolves to a website that frames content from the eBay.com website. Before an Internet user can enter Respondent's website, he or she must first click through a "pop up" box for a "virtual reality" gambling casino. True copies of screen shots of the website located at "www.kiro7.com", as well as the "pop-up" forced on consumers while the website is loading, are attached as Composite Annex E.

(j) Complainant has contacted eBay and confirmed that eBay and Half.com have no relationship with Respondent. A true copy of the e-mail from eBay is attached as Annex F.

(k) On October 4, 2001, counsel for the Complainant sent a letter via Federal Express to Alex Vorot, who was then the listed Administrative and Technical Contact for <kiro7.com>. A true copy of this letter is attached as Annex G. Delivery of this letter was attempted at two different addresses: Free Domains Parking, Mira Prospect 120-14, Moscow, Russia 180012 and Parkovaya Str., 12a-24, Moscow, Russia 312022. The letter was returned by Federal Express as undeliverable. A true copy of the Federal Express record is attached as Annex H. Counsel for the Complainant also sent a copy of the above letter via e-mail to the address listed for Alex Vorot in the WhoIs database. A true copy of this e-mail is attached as Annex I. Counsel for the Complainant never received a response to this letter.

(l) On October 4, 2001, counsel for the Complainant attempted to send the above letter via fax and United States mail to Frances Ziegler, who was listed as the Technical Contact in the WhoIs database for the gambling website whose name pops up before visitors are connected to the <kiro7.com> website. The letter was returned as undeliverable and the fax number was unreachable. A true copy of the envelope for this returned letter is attached as Annex J.

(m) On November 6, 2001, the contact information for <kiro7.com> was updated in the WhoIs database. A true copy of the updated listing is attached as Annex A. Counsel for the Complainant sent a letter to the new listed contact on November 7, 2001, via Federal Express to Andrey Vasiliev, Free Domains Parking, Glavpochtamt, d/v Vasiliev Andrey Vladimirovich, Moscow, Russia 101000. A true copy of this letter is attached as Annex K. The letter was also returned by Federal Express as undeliverable. A true copy of the Federal Express record is attached as Annex L. Counsel for the Complainant also sent a copy of the above letter via e-mail to the address listed for Andrey Vasiliev in the WhoIs database. A true copy of this e-mail is attached as Annex M. Counsel for the Complainant never received a response to this letter.

(n) The telephone number listed by Respondent as the Administrative Contact and Technical Contact for <kiro7.com> in the WhoIs database is a telephone number that is unreachable.

Grounds

(a) The <kiro7.com> Domain Name is Virtually Identical and Confusingly Similar to the KIRO7, KIRO 7 and KIRO Marks in which Complainant has Rights.

Complainant has common law trademark rights in the KIRO, KIRO7 and KIRO 7 marks. It is established that a Complainant may have common law trademark rights in broadcast station call letters that are used in a trademark sense. *See, e.g., Capital Broadcasting Company, Inc. v. Momm Amed Ia*, WIPO Case No. D2000-1610 (January 24, 2001), (finding that Capitol Broadcasting had created common law trademark rights in the terms “WRAL”, “WRAL5” and “WRAL-TV5” based on using those terms without interruption since 1956, spending significant amounts of money on advertising and promotional material

in respect to the marks, and using the call letters "WRAL" and the composite terms both on its written material, on its television broadcasts and on its website).

The <kiro7.com> domain name is confusingly similar Complainant's marks because it is identical to Complainant's KIRO7 mark, and virtually identical to Complainant's KIRO 7 mark, the only difference being the removal of the space. *See Capital Broadcasting Company, Inc. v. Momm Amed Ia*, WIPO Case No. D2000-1610 (January 24, 2001), (domain name <wral-tv5.com> was confusingly similar where it was identical to the Complainant's mark WRAL-TV5, and domain name <wral5.com> was confusingly similar to Complainant's mark WRAL 5 where it was virtually identical to Complainant's mark but for the lack of a space between the "L" and the "5").

In addition, the <kiro7.com> domain name is confusingly similar to Complainant's KIRO mark. The only difference lies in the addition of the generic symbol "7" that describes Complainant's products and services. *See, e.g., Capital Broadcasting Company, Inc. v. Private*, WIPO Case No. D2000-1609 (January 24, 2001), (domain name that was a combination of Complainant's mark WRAL and "weather," a term associated with Complainant's weather forecasting services, was confusingly similar to Complainant's mark); *Nicole Kidman v. John Zuccarini, d/b/a CupcakeParty*, WIPO Case No. D2000-1415 (January 23, 2001), (domain name that was a combination of Complainant's mark and "nude," a term associated with Complainant's performances, was confusingly similar to Complainant's mark); *General Electric Co. v. Normina Anstalt*, WIPO Case No. D2000-0452 (July 10, 2000), (domain name that consisted of Complainant's mark and the generic word "warehouse," which is associated with distribution of products, was confusingly similar to Complainant's mark).

Respondent's <kiro7.com> domain name may confuse Internet users because it is merely one keystroke away from <kiro.com> which connects to Complainant's website that promotes its KIRO, KIRO7 and KIRO 7 products and services. An Internet user seeking Complainant's website may therefore readily become confused and believe the domain name <kiro.com> is somehow associated, affiliated with, or sponsored by the Complainant.

(b) Respondent has No Rights or Legitimate Interests in the <kiro7.com> Domain Name

Respondent has never been authorized by Complainant to use the KIRO, KIRO7 or KIRO 7 marks in any way, shape, or form, much less as part of the domain name <kiro7.com>.

Respondent has not established rights or legitimate interests in the domain name by establishing use or preparations to use the domain name for any bona fide purpose. Respondent's <kiro7.com> domain name directs Internet users to a website that currently contains framed content from Half.com (an eBay company). Respondent does not have any authorization from eBay to use this content. This is not bona fide use of a domain name. Respondent, therefore, cannot meet the requirements of Section 4(c)(i) for establishing rights or legitimate interests in the Domain Name. *See CCA Industries, Inc. v. Bobby R. Dailey*, WIPO Case No. D2000-0148 (April 26, 2000).

Respondent also cannot establish rights in the <kiro7.com> domain name under Section 4(c)(ii) because it has never been commonly known by the domain name.

Complainant further submits that Respondent cannot establish rights in the <kiro7.com> domain name under Section 4(c)(iii) because it has made no legitimate non-commercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers. As discussed, Respondent's <kiro7.com> domain name directs Internet users to a website that contains unauthorized framed content. This is not legitimate use. Furthermore, connecting with Respondent's "www.kiro7.com" website causes a "pop up" box for a virtual reality gambling site to appear. An Internet user who arrives at the <kiro7.com> site must click on this advertisement before exiting. Respondent thus attempts to misleadingly divert users to another website for commercial gain.

(c) The <kiro7.com> Domain Name has been Registered and Used in Bad Faith

Respondent's registration of the <kiro7.com> domain name and failure to use such name for legitimate purposes establish that Respondent has used and registered the domain name in bad faith under the criteria set forth in Section 4(b)(iv) of the Policy. There is no evidence that Respondent was ever legitimately known as "KIRO7." The only evident reason for Respondent to have registered this domain name for a retail website was to attract users looking for Complainant's website for its own commercial gain.

Additionally, turning one's browser to the <kiro7.com> website causes a "pop up" advertisement for a virtual reality gambling casino to appear. Such activity is additional evidence of bad faith. *See Nicole Kidman v. John Zuccarini, d/b/a CupcakeParty*, WIPO Case No. D2000-1415 (January 23, 2001), (holding that diversion of Internet traffic to profit from fees paid by "pop up" and other advertisers demonstrated bad faith). In addition, Respondent's bad faith is established by its attempts to divert users to a gambling website through this "pop up" advertisement. *See Infospace, Inc. v. Dominion Hill, Inc.*, WIPO Case Nos. D2000-1475 and D2000-1477 (January 22, 2001), (holding that the nature of the domain names and the clear intention of the Respondent to use those names to divert people to Respondent's gambling sites demonstrated bad faith).

Respondent has submitted false contact information for the WhoIs Directory entry for the domain name by listing information for the Administrative Contact and Technical Contact that is not reachable through telephone, Federal Express or e-mail. Such action is also evidence of Respondent's bad faith. *See, e.g., A. H. Belo Corporation v. King TV and 5 Kings*, WIPO Case No. D2000-1336 (December 8, 2000), (registration of domain names <king5tv.com> and <king5news.com> using false registration information evidence of bad faith); *Home Director, Inc. v. Home Director*, WIPO Case No. D2000-0111 (April 11, 2000), ("Further evidence of Respondent's bad faith is Respondent's use of false or misleading information in connection with the registration of a domain name").

B. Respondent

The Respondent did not file a Response to the Complaint.

6. Discussion

In order for the Complainant to prevail and have the disputed domain name <kiro7.com> transferred to itself, Complainant must prove the following (the Policy, paragraph 4(a)):

(i) the domain name 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 interest in respect of the domain name; and

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

The first element which the Complainant must prove is that the domain name is identical or confusingly similar to the Complainant's trademark or service mark.

The Complainant is the owner of the common law trademarks KIRO, KIRO7 and KIRO 7. The mark KIRO indicates the call letters of Complainant's television broadcast and entertainment services broadcast station located on Channel 7 in Seattle, Washington, and the trademarks KIRO7 and KIRO 7 are used by Complainant in conjunction with the television broadcast and entertainment services. The Complainant has continuously and extensively used the trademarks KIRO, KIRO7 and KIRO 7 to identify, advertise and promote its products and services since at least as early as 1958. The Seattle, Washington market is the twelfth largest television market in the United States of America. A Complainant may have common law trademark rights in broadcast station call letters that are used as trademarks and service marks. (*Capital Broadcasting Company, Inc. v. Momm Amed Ia*, WIPO Case No. D2000-1610, (January 24, 2001)).

The domain name in dispute is confusingly similar to the Complainant's common law trademarks. The domain name <kiro7.com> is confusingly similar to the Complainant's trademarks KIRO, KIRO7 and KIRO 7. The first and inherently distinctive portion of the domain name <kiro7.com> is identical to Complainant's trademarks KIRO7 and KIRO 7.

The second element which the Complainant is required to prove is that the Respondent has no right or legitimate interests in respect of the domain name in dispute. The Complainant has established that the trademarks KIRO, KIRO7 and KIRO 7 were in wide use throughout America before the registration of the domain name in dispute <kiro7.com>. The Complainant's uncontested evidence is that the Respondent has not been authorized by the Complainant to use any of the Complainant's trademarks as part of a domain name or otherwise. The Respondent did not respond to the Complainant's cease and desist letter and did not file a Response submitting proof of rights or a legitimate interest in respect of the domain name.

The Respondent has asserted no rights or legitimate interest in the disputed domain name <kiro7.com>. Considering the non-exclusive list of factors in paragraph 4(c) of the UDRP Policy relating to how a Respondent may demonstrate rights and legitimate interests in the domain name in dispute in responding to a Complaint, the Panel finds that the Complainant has used the trademark and service mark KIRO and KIRO 7 for over 40 years. The Respondent registered the domain name in dispute <kiro7.com> on March 13, 2000. The Respondent is using the domain name to direct Internet users to a website that currently contains framed content from Half.com (an eBay company).

Respondent does not have any authorization from eBay to use this content. Furthermore, connecting with the Respondent's website causes a "pop up" box for a virtual gambling site to appear. The inference to be drawn from the evidence is that the Respondent is not using the domain name in connection with a bona fide offering of services. The Complainant has not authorized the Respondent to use the trademarks or service marks KIRO, KIRO 7 or KIRO 7. In spite of many attempts by courier, mail and e-mail it has not been possible to contact the Respondent which leads to the inference that the Respondent has not been commonly known by the domain name. Further, the Respondent is not making a legitimate non-commercial use of the domain name in dispute. The inference to be drawn from the evidence is that the Respondent has no right or legitimate interest in respect of the domain name <kiro7.com>.

The third element which the Complainant is required to prove is that the disputed domain name has been registered and is being used in bad faith.

The disputed domain name <kiro7.com> was registered many years after the Complainant's trademarks had become well known in the Pacific Northwest of United States by reason of extensive advertising of the call letters KIRO, KIRO7 and KIRO 7 for over 40 years. By using the domain name in dispute the Respondent has attempted to attract Internet users to Respondent's website and other on-line locations by creating a likelihood of confusion with the Complainant's well-known marks as to source. The confusion leads to a hit on the Respondent's web site or other on-line locations. Further, the subject matter on the Respondent's web site and other on-line locations involving gambling is damaging to the Complainant's goodwill in its business and trademarks. *Infospace Inc. v. Dominion Hill, Inc.*, WIPO Case Nos. D2000-1475 and D2000-1477 (January 22, 2001). *Capital Broadcasting Company, Inc. v. Momm Amed Ia*, WIPO Case No. D2000-1610.

By using the domain name <kiro7.com>, Respondent intentionally attempts to attract for financial gain Internet users to the Respondents' websites and other on-line locations, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's web sites and/or the goods or services offered therein.

7. Summary of Findings

a) The domain name in dispute is confusingly similar to the Complainant's trademarks and service marks KIRO, KIRO7 and KIRO 7.

b) The Respondent has no right or legitimate interest in respect of the disputed domain name. The disputed domain name promotes and suggests a connection or relationship of the Respondent with the Complainant, which does not exist.

c) The domain name has been registered and is being used in bad faith by the Respondent. Respondent is using the confusingly similar domain name in dispute to attract business to the Respondent's website and associated gambling sites.

8. Decision

In the Complaint, the Complainant requested that in accordance with Paragraph 4(i) "Remedies" of the Uniform Domain Name Dispute Resolution Policy, the Administrative Panel issue a decision that the disputed domain name be transferred to Complainant. The Complainant having proved each of the three elements set out in paragraph 4.a.(i)(ii) and (iii) of the Uniform Domain Name Dispute Resolution Policy is entitled to the remedy requested. The Panel requires that the domain name <kiro7.com> be transferred to Cox Holdings, Inc.

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Ross Carson
Sole Panelist

Dated: March 11, 2002