WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

COMSAT Corporation v. TELE Satellite

Case No. DTV2001-0011

1. The Parties

The Complainant:

COMSAT Corporation, 6560 Rock Spring Drive, Bethesda, MD 20817, United States of America.

The Respondent:

TELE Satellite, Prinzregentenstr. 128 Munich, Bavaria 81677, Germany.

2. The Domain Name and Registrar

The domain name in issue is <comsat.tv> (hereafter "the domain name").

The domain name was registered with dotTV Corporation, 130 West Union Street, Pasadena, California 91103, USA.

The domain name was registered on or about July 10, 2000.

3. Procedural History

(1) The Complaint in Case No. DTV2001-0011 was filed in email form on April 12, 2001, and in hardcopy on April 18, 2001.

(2) The WIPO Arbitration and Mediation Center has found that:

- The Complaint was filed in accordance with the requirements of the Rules and Supplemental Rules for the Uniform Domain Name Dispute Resolution Policy;

- Payment for filing was properly made;

- The Complaint complies with the formal requirements;

- The Complaint was properly notified in accordance with the Rules, paragraph 2(a);

- A Response to the Complaint was not filed;

- The Respondent was appropriately served with a Notice of Default; and that

- The Administrative Panel was properly constituted.

As Panelist, I accept these findings.

(3) As Panelist, I submitted a Statement of Acceptance and Declaration of Impartiality and Independence.

(4) There have been neither further submissions nor communications from the Complainant and Respondent, or their representatives, after the appointment of the Panel.

(5) The date scheduled for issuance of a decision is: June 6, 2001.

(6) No extensions have been granted or orders issued in advance of this decision.

(7) The language of the proceedings is English.

4. Factual Background

A. The Complainant and its marks

Complainant was created by the United States Congress pursuant to a 1962 statute to design, develop and implement a worldwide satellite telecommunications system, with the intention that every country in the world have access to satellite communications capabilities. The Complainant is known worldwide as one of the principal initial developers of the entire field of satellite communications technology and as a major continuing participant in that field.

Since beginning operations in 1963, as the Communications Satellite Corporation, Complainant has been universally known and referred to as "COMSAT." The

Complainant has been using COMSAT as a trademark, service mark and trade name since at least as early as 1964. The Complainant's COMSAT mark and name is used extensively worldwide, including the United States and Canada, in advertising, promotional materials, informational literature, signs, on publications and on goods and equipment relating to communications services in the communications and related fields. The Complainant is the registered proprietor of a number of United States trademarks and service marks, all for the mark "COMSAT" or "COMSAT" with a device; including No. 828,366; No. 840,195; No. 1,200,243; No. 1,666,705; No. 1,964,981; 1,974,971. The Complainant is the proprietor of numerous marks throughout the world. (Hereafter all of the registrations will be referred to as "the Complainant's marks" or "the COMSAT marks").

The Complainant has been diligent in protecting its mark over the years, and has successfully pursued all infringers. There are no third party trademark registrations for COMSAT in the United States or, on information and belief of the Complainant, outside the United States.

B. The Respondent

According to the Whois database of the concerned registrar, dotTV, the Respondent in this administrative proceeding is "TELE Satellite", of the address given above. No Response was filed and so no further information is known about the Respondent.

C. The Domain Name

The <comsat.tv > domain name resolves to a site at <sat-news.com>, which offers commercial services including news services in connection with the names "TELE-Satellite" and "Sat News".

5. Parties' Contentions

A. The Complainant's assertions

The Respondent's domain name is identical or confusingly similar to the Complainant's mark.

The Respondent has no legitimate interest or rights in the domain names based on Complainant's continuous, long and exclusive prior use and registration of its mark COMSAT in the United States, Europe and the rest of the world.

The Respondent registered the domain name and is using it in bad faith. The Complainant specifically asserts that:

1. At the time the Respondent registered <comsat.tv>, it was on constructive notice of the Complainant's ownership of the COMSAT trademark and service mark and registrations. The web site to which <comsat.tv> resolves offers "Professional Satellite News and Information" to "satellite professionals and satellite enthusiasts." Given

the fame of the COMSAT marks in the satellite field, it is inconceivable the Respondent was unaware of the Complainant's COMSAT marks and name, at the time the Respondent registered <comsat.tv>.

2. The Respondent is not using <comsat.tv> as a domain name for a site at that address. Rather, typing in <comsat.tv> resolves to a site at <sat-news.com>, where satellite news is offered in connection with the names TELE-Satellite and Sat News. Respondent is thus using <comsat.tv> solely to lure those who are looking for Complainant to its site when a person types in Complainant's mark and name. This use is in bad faith, and it is an attempt to trade off the enormous goodwill and fame attendant the COMSAT mark in the satellite field.

Accordingly the Panel should order that the domain name be transferred to the Complainant.

B. The Respondent's assertions

The Respondent has not filed a Response.

6. Discussion and Findings

Paragraph 4a of the UDRP requires the Complainant to make out three elements:

A. The Complainant has rights in a trade or service mark, with which Respondent's domain name is identical or confusingly similar (Paragraph 4a(i)); and

B. The Respondent has no rights or legitimate interests in respect of the domain name (Paragraph 4a(ii)); and

C. The Respondent registered and is using the domain name in bad faith (Paragraph 4a(iii)).

A. The Complainant has rights in a trade or service mark, with which Respondent's domain name is identical or confusingly similar

There are two requirements that a Complainant must establish under this paragraph; that it has rights in a trade or service mark, and that the domain name is identical or confusingly similar to the marks.

The Complainant has provided the registration documents for its COMSAT marks, in multiple classes within the US and internationally. I conclude that the Complainant – as registered proprietor of the COMSAT marks – has established the first requirement of this paragraph.

The second requirement is that the domain name be identical or confusingly similar to the marks, and here the Complainant makes this bare assertion with no further

argument. It is clear on its face that the domain name is identical to the COMSAT marks. Hence the second requirement of this paragraph is made out.

The Complainant has shown that it has rights in trademarks, and that the domain name is identical to these marks. I conclude therefore that the Complainant has satisfied the requirements of paragraph 4a(i) of the UDRP.

B. The Respondent has no rights or legitimate interest in respect of the domain name

The Complainant asserts that the Respondent has no rights or legitimate interest in the domain name, as required under paragraph 4a(ii) of the UDRP. It makes no further assertions.

Though the Complainant bears the burden of proof in all matters under the UDRP, the practical effect of this paragraph is that once the Complainant makes a substantiated allegation the Respondent bears some responsibility to establish its interests. Of course here there has been no Response.

This however does not resolve the issue. In the absence of a Response, I consider it necessary to analyze whether any of the defenses provided in Paragraph 4c might apply. Paragraph 4c of the UDRP provides the following examples to the Respondent:

> "(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 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."

There is no evidence that any of the scenarios of Paragraph 4c apply here. In fact, two pieces of evidence specifically negative any assumption of legitimate use by the Respondent. First is the long-term use, fame, and significance of the COMSAT marks. It is essentially impossible to believe that, in the absence of specific, compelling evidence from the Respondent, that it could be legitimately using the domain name. Second, the domain name resolves to a commercial site located at <sat-news.com> which offers "Professional Satellite News and Information" to "satellite professionals and satellite enthusiasts." Clearly the Respondent is seeking to gain advertising or other revenues from the domain name. These pieces of evidence, together with the absence of other evidence in the Respondent's favor, removes any need to consider more closely whether the Respondent has satisfied the Paragraph 4c requirements.

As a result I conclude that, even having considered the possible application of Paragraph 4c, the Respondent has no rights or legitimate interest in the domain name. I conclude that the Complainant has satisfied the requirements of paragraph 4a(ii) of the UDRP.

C. The Respondent registered and is using the domain name in bad faith

The final issue is that of bad faith registration and use by the Respondent. For paragraph 4a(iii) to apply, the Complainant must demonstrate the conjunctive requirements that the Respondent registered the domain name in bad faith and continues to use it in bad faith.

Paragraph 4b of the UDRP provides exemplary scenarios which will be sufficient to establish the requirements of Paragraph 4a(iii). Pursuant to paragraph 4b(iv) where the Respondent has used the domain name in an attempt "to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion of the complainant's mark as to the source, sponsorship, affiliation or endorsement of [Respondent's] web site or location", bad faith will be established. As explained in the previous section, this has occurred here. The Respondent has set up a site for satellite news which clearly exploits the Complainant's trademark. This activity falls clearly into the exemplar of Paragraph 4b(iv), and no further analysis is necessary.

I therefore conclude that the Complainant has satisfied paragraph 4a(iii) of the UDRP.

7. Decision

The Complainant has made out all of the elements of paragraph 4a of the Uniform Domain Name Dispute Resolution Policy.

Pursuant to Paragraph 4i of the Uniform Domain Name Dispute Resolution Policy and Rule 15 of the Rules for the Uniform Domain Name Dispute Resolution Policy, the requested remedy is granted.

I hereby order that the domain name <comsat.tv> be transferred forthwith to the Complainant.

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Dan Hunter
Sole Panelist

Dated: June 7, 2001