



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

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Version
 Decision ID DE-0900224
 Case ID HK-0900245
 Disputed Domain Name www.tvbfinder.com
 Case Administrator Dennis CAI
 Submitted By Neil Brown
 Participated Panelist

Date of Decision 23-06-2009

Language Version : English

The Parties Information

Claimant Television Broadcasts Limited
Respondent TVBFINDER / Kelvin Sun

Procedural History

The Complaint was filed with the Hong Kong Office of the ADNDRC (Asian Domain Name Dispute Resolution Center) [the 'Center'] on March 17, 2009.

The Center transmitted by email to the Registrar a request for Registrar verification in connection with the contentious domain name on April 2, 2009.

The Registrar transmitted by email to the Center its verification response confirming that the Respondent, described as TVBFINDER, is listed as the registrant and providing the details for the administrative matter on April 3, 2009.

On February 19, 2009, the Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy ("the Rules") and the ADNDRC Supplemental Rules (the "Supplemental Rules"). The Panel finds that the description of the Respondent is in compliance with paragraph 3 (b) (v) of the Rules.

On February May 4, 2009, the Center transmitted the "Complaint Transmittal Sheet" along with the Complaint to the Respondent by email, and the Center also sent a copy of the Complaint to the Respondent by courier, notifying the Respondent of the commencement of the proceedings as well as the due date, May 25, 2009, for the Respondent to submit its Response.

The Respondent did not submit its Response by May 25, 2009 or at all and the Center notified the Respondent of its having missed the due date for the Response by email on June 6, 2009.

On June 5, 2009, the Center requested The Honourable Neil Anthony Brown QC to be the sole panelist for this proceeding and The Honourable Neil Anthony Brown QC submitted the Statement of Acceptance and Declarations of Impartiality and Independence on June 6, 2009.

On June 6, 2009 the Center informed the parties by notice that a Panel would shortly be constituted in this proceeding; and on June 11, 2009, the Center legitimately established the Panel in this proceeding in accordance with paragraph 6 of the Rules.

On June 11, 2009, the Center sent all the documents and materials relating to the Complaint to the Panelist and the Panelist confirms that they were delivered to him on or about June 13, 2009.

Factual Background

For Claimant

The Complainant, established in 1967, is the first wireless commercial television station in Hong Kong. It is engaged in television broadcasting, programme production and other broadcasting related activities such as programme licensing, audio and video product rental, selling and distribution its programmes are internationally acclaimed, distributed to more than 30 countries and accessible to 30 million people every day. It also owns and operates a range of satellite television channels.

The Complainant is the registered proprietor of a series of trademarks and service marks for TVB throughout the world. Among these trademarks and service marks are the following:

- (a) Registered trademark No.08823/96, registered in Hong Kong on June 8, 1992 for TVB;
- (b) Registered trademark No.0884/96, registered in Hong Kong on June 8, 1992 for TVB;

both with respect to television broadcasting.

All of the said trademarks and service marks are hereinafter collectively referred to as “the TVB trademark.”

The Complainant has also registered a series of some 30 domain names that include the trademark TVB, such as <tvbnews.com.hk> and which it uses for the purposes of its own websites to provide online services.

For Respondent

The Respondent registered the disputed domain name on November 6, 2008.

Parties' Contentions

Claimant

The Complainant alleges that the disputed domain name <tvbfinder.com> should no longer be registered with the Respondent but that it should be transferred to the Complainant.

It contends that this should be done because, within the meaning of paragraph 4 of the Policy, the domain name is confusingly similar to the Complainant's registered TVB trademark, that the Respondent has no rights or legitimate interests in the domain name and that the domain name has been registered and subsequently used in bad faith. The Complainant maintains that it can prove all three of these requirements and that the appropriate remedy is to transfer the domain name to the Complainant.

In support of its case on the first of these three elements, the Complainant relies on the TVB trademark and says that the domain name is confusingly similar to it, because the Respondent has simply taken the entirety of the trademark and added to it the generic or common word ‘finder’, which does not make any distinction between the goods and services of the Complainant and the goods and services being promoted by the domain name. This, the Complainant says, gives rise to inevitable confusion with the Complainant's trademarked products. That confusion arises because internet users would naturally think when seeing the domain name that it could be used to find the Complainant's television programmes on the website to which the domain name resolved and to do so lawfully and indeed that such website would be the Complainant's official website.

The Complainant contends, to establish the second element, that the Respondent has no rights or legitimate interests in the domain name because it has no connection to the Complainant as trademark owner and the Respondent's use of the trademark in its domain name is a breach of trademark law, for the Complainant has never authorised it to use the TVB trademarks in a domain name or anywhere else. Moreover, the Complainant contends that on the known facts the Respondent could not bring itself within any of the provisions of paragraph 4(c) of the Policy to establish a right or legitimate interest in the domain name.

Finally, the Complainant contends that the domain name was registered and is being used in bad faith. It contends that this is so because the domain name contains the Complainant's entire trademark, the Respondent obviously intended to mislead the public and to divert online traffic from the Complainant to its, the Respondent's, website and the very use of the domain name by someone with no connection to the Complainant and without permission shows opportunistic bad faith. In particular, the Respondent registered the domain name and has been using it, with the intention of setting up an internet platform where the Complainant's programmes may be viewed illegally and without the permission of the Complainant, thereby adversely affecting its business and income.

Respondent

The Respondent did not reply to the Complainant's contentions.

Findings

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. In that regard, the Panel also notes that the fact that the Respondent has not made a submission does not avoid the necessity of examining the issues and of doing so in the light of the evidence. The onus remains on the Complainant to make out its case and past WIPO UDRP panels have said many times that despite the absence of a submission from a Respondent, a Complainant must nevertheless show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

However, as the Panel will illustrate later, it is possible to draw inferences from the evidence that has been submitted and in some cases from silence.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

A. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

B. The Respondent has no rights or legitimate interests in respect of the domain name; and

C. The domain name has been registered and are being used in bad faith.

It is to be noted that paragraph 4 of the Policy provides that the Complainant must prove that each of the three elements is present. The Panel will therefore deal with each of these requirements in turn.

Identical / Confusingly Similar

The Panel finds that the domain name <tvbfinder.com> is confusingly similar to the TVB trademark, which has been wholly incorporated into the domain name and to which only the word 'finder' has been added.

In that regard, it has been held many times that the addition to a trademark of a common or generic word or a term which does no more than describe some aspect of the trademarked goods, will not negate a finding of confusing similarity that is otherwise present on the evidence. Thus, in *Dr. Ing. h.c.F. Porsche AG v. Gary Charles Brown, a k a Gary Brown, a k a Charlie Brown, a k a Gary Charlie Brown*, WIPO Case No. D2001 0919, it was held that the domain name <porscheimporter.com> was confusingly similar to the trademark PORSCHE because, as the Panel said:

“...The combination “Porsche Importer” uses Complainant's mark as the principal identifier of a business that engages in trade of Complainant's products. (There is thus)... a likelihood that the public, viewing the domain names, will draw that conclusion that Complainant is the enterprise that is undertaking to provide the subject products. The public (in this case Internet users) will be confused as to the source of the products or sponsorship of the activities.”

Likewise, in *Victoria's Secret, et al. v. GU*, FA096311 (Nat. Arb. Forum Feb. 8, 2001) the panel held that the domain name <victoriasscretirect.com>, incorporating as it did the entirety of the relevant trademark, to which was added the generic word 'direct', was for that reason confusingly similar to the trademark. For the same reason, a similar conclusion must be reached in the present case.

That is so because, in the present case, the public would conclude from seeing the disputed domain name that it can be used legitimately to find the Complainant's programmes and indeed that it is the Complainant that is undertaking to provide the TVB programmes invoked by the use of the TVB trademark used in the domain name. There is therefore a confusion added to the similarity already created by the use of the entire trademark in the domain name, making the domain name confusingly similar to the TVB trademark.

It has also been held many times in UDRP proceedings that suffixes such as '.com' may not be used to negate a finding of confusing similarity that is otherwise present on the evidence, as it is in the present case.

The Complainant has therefore established that there is a confusing similarity between the disputed domain name and the TVB trademark and, as the Complainant is the registered owner of the trademark, it has accordingly made out the first of the three elements that it must establish.

Rights and Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(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 [Respondent] (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 [Respondent] 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.

Thus, if a respondent proves any of these elements or indeed anything else that shows she has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

The Panel's task in deciding if a registrant has any rights or legitimate interests in a domain name is made more difficult when the registrant is in default and does not file a Response or any other form of submission. The Respondent in the present case was given notice that it had until May 25, 2009 to send in its Response.

It is also well established that, as it is put in paragraph 2.1 of the Overview of WIPO Panel Views on Selected UDRP Questions, "...a complainant is required to make out an initial prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP".

The Panel, after considering all of the evidence in the Complaint and the extensive exhibits attached to it, all of which is persuasive, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the domain name <tvbfinder.com>. That prima facie case is made out from the following considerations.

The Respondent chose for the domain name, without the Complainant's authorisation, the Complainant's prominent trademark TVB and merely added to it the word "finder". The domain name thus declares expressly that the service available by using the domain name is the ability to find and view television programmes marketed under the well-known TVB brand name and by implication that this may be done lawfully. The Respondent then linked the domain name to a website where those programmes could be viewed, but illegally, for they were being presented without the approval of the Complainant and by denying it the financial benefits of exhibiting its own programmes.

Nor, as the Complainant contends, was there any licensing or other relationship or arrangement between the Complainant and the Respondent under which it could be said that the Complainant gave permission to the Respondent to use its trademark in this way or illegally announce the availability of the Complainant's programmes.

These facts give rise to the prima facie case made out by the Complainant. The Respondent has not made any attempt to rebut this prima facie case, and the Panel therefore concludes that the Respondent has no rights or legitimate interests in the domain name.

The Complainant has thus made out the second of the three elements that it must establish.

Bad Faith

The Complainant must prove on the balance of probabilities both that the domain name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. Further guidance on how to implement this requirement is to be found in paragraph 4(b) of the Policy, which sets out four circumstances, any one of which shall be evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 Respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, respondent has intentionally attempted to attract, for commercial gain, internet users to respondent's 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 the respondent's website or location or of a product or service on the site or location.

The starting point in this inquiry must surely be that the Respondent must be presumed to have known of the Complainant's prominent TVB trade mark. Indeed, that must be the reason why it registered the domain name in the first place.

That being so, it could not have chosen or used the word "tvbfinder" in its domain name for any reason other than to trade on the TVB name. Moreover, it must be inferred that the domain name was registered to confuse internet users and by that means to attract them to a website with a name which is substantially the same as that of the prominent TVB mark. That is, in itself, evidence of bad faith, both generally and specifically within the meaning of both paragraphs 4(b) (iii) and (iv) of the Policy.

The Panel's view is that the facts bring the case squarely within both paragraph 4(b) (iv) and that accordingly it is not necessary to consider other arguments.

The case comes within sub-paragraph 4(b) (iv) because the whole effect of the operation set up by the Respondent through registering and using the domain name has been to give the false impression that the domain name will lead to an official website of the Complainant where the well known TVB programmes may be found and viewed lawfully. That is untrue as, although the programmes are the Complainant's, it has not given permission for them to be located and viewed in this manner and certainly not in a manner that deprives the Complainant of the financial benefit to which it is entitled. In particular, as the Complainant submits, the Complainant licenses its programmes to be viewed under licence arrangements in, for example Malaysia and the Peoples' Republic of China and the Respondent's activities prevent these licensing arrangements from being properly implemented. Thus the Respondent is using the domain name for the illegal exhibition of the Complainant's programmes and it must clearly have known that this would be the consequence of its registration and use of the domain name in the manner in which it has been using it.

Moreover, the Respondent has attracted potential customers by using and promoting the Complainant's TVB trademark without the consent of the Complainant and by creating the impression in the minds of potential customers that it has the endorsement of the Complainant. Indeed, it has gone into business in competition with the Complainant, using the Complainant's own name and trademark and even using its own products. This conduct brings the matter squarely within the provisions of sub-paragraph 4(b) (iv) and applies both to the registration and the use of the domain name. This view, that the conduct just described amounts to bad faith, is consistent with the view taken by other UDRP panels on analogous facts and particularly in cases where the names of well-known motorcar manufacturers have been used to sell spare parts made by them and by other manufacturers. Thus, in *Toyota Motor Sales, U.S.A., Inc. v. Pick Pro Parts Inc*, WIPO Case D2005-0562, the owner of the domain name <lexus--parts.com>, an unauthorized dealer in Lexus parts, was directing the domain name to its website <pickproparts.com>, where Lexus parts could be bought, but alongside parts for other brands. On the issue of bad faith that inevitably arose for decision, the Panel said:

'The Respondent confusingly employs the Complainant's marks in the Domain Names to attract Internet users to the Respondent's commercial site, where the Respondent attempts to sell Complainant's parts, as well as those of its competitors, evidently for commercial gain. This constitutes bad faith under paragraph 4(b) (iv) of the Policy. See *Toyota Motor Sales U.S.A., Inc. v. I.E. Mann d/b/a Everything Internet*, FA0411000370902 (Nat. Arb. Forum, January 11, 2005), <autotoyotaparts.com> (respondent "commercially benefits from this diversion by selling products and services to Internet users who are searching under Complainant's mark"); *Toyota Motor Sales U.S.A., Inc. v. Indian Springs Motor*, FA0305000157289 (Nat. Arb. Forum, June 23, 2003), <glennstoyota.com> and <usedtoyotalexus.com> (bad faith may be inferred where a respondent profits from its "diversionary use" of the complainant's mark in a domain name that resolves to a commercial website and the respondent fails to respond with a plausible good-faith reason for using the mark).'

Those observations are equally applicable to the present case and show that, within the meaning of paragraph 4(b) (iv) of the Policy, there has been both bad faith registration and use.

The Complainant has therefore proved both that the domain name was registered in bad faith and that it is being used in bad faith and has therefore made out the third of the three elements that it must establish.

Status

www.tvbfinder.com

Domain Name Transfer

Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <tvbfinder.com> be transferred to the Complainant.

The Honourable Neil Anthony Brown QC
Sole Panelist
Date: June 18, 2009