Panel Decision for dispute CAC-ADREU-006820

Case number	CAC-ADREU-006820
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Domain names	TVBDO.EU

Case administrator

Lada Válková (Case admin)

Complainant

Organization

Respondent

Name	Michael Sing

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complaint was filled by 2 Complainants.

Television Broadcasts Limited (“the First Complainant”) is wireless commercial television station in Hong Kong that was established in 1967 and its shares have been publicly listed on the Hong Kong Stock Exchange since 1988.

The First Complainant has its principal website http://www.tvb.com (“TVB.COM”) on the Internet to provide worldwide viewers the latest information on the First Complainant’s Programmes and the First Complainant’s artistes.

The First Complainant is the owner of numerous trademarks and services marks containing “TVB”, including but not limited to the Community trademark “TVB” (Reg No 6307524) in classes 16, 35, 38 and 41 and French trademark „TVB“ (Reg No 95582925) in classes 9, 16, 38, 41, 42.

The Second Complainant is Chinese Channel Limited with postal address 11th Floor The Mile, 1000 Great West Road, Brentford, London TW8 9DW, United Kingdom (E-Mail: enquiries@tvbeurope.co.uk; phone: +44 (0) 20 8614 8300; fax: +44 (0) 20 8943 0982).

The Second Complainant is a private limited company wholly-owned by the First Complainant and incorporated in England in May 1990. It offers Chinese-language channels and supplies programmes to the UK and European countries through satellite broadcasting, cable TV system and IPTV. The Second Complainant is authorized to use TVB trademark on all its marketing, leaflet and social media platform to promote its services and broadcast First Complainant’s Programmes throughout Europe.

The First and Second Complainant have registered 81 domain names, containing the mark “TVB”, namely, “TVB.COM.AU”, “TVBIHK.COM.HK”, “TVBS.COM.TW”, “TVBS.NET”, “TVBSN.COM.TW”, “TVBSG.COM.TW”, “TVBUSA.COM”, “TVBUSA.US”, “TVBWKLY.COM”, “TVB.ASIA”, “TVBARTISTESBLOG.COM”, “TVBARTISTEBLOG.COM”, “TVBARTISTSBLOG.COM”, “TVBARTISTBLOG.COM”, “TVBARTISTESBLOG.COM.HK”, “TVBARTISTEBLOG.COM.HK”, “TVBARTISTSBLOG.COM.HK”, “TVBARTISTBLOG.COM.HK”, “TVBARTISTESBLOG.COM.CN”, “TVBARTISTEBLOG.COM.CN”, “TVBARTISTSBLOG.COM.CN”, “TVBARTISTBLOG.COM.CN”, “TVBARTISTESBLOG.CN”, “TVBARTISTEBLOG.CN”, “TVBARTISTSBLOG.CN”, “TVBARTISTBLOG.CN”, “TVBMUSIC.COM.HK”, “TVBNEWS.COM.HK”, “TVBN.COM.HK”, “TVBGROUP.COM.CN”, “TVBGROUP.CN”, “TVBCHINA.COM.CN”, “TVB.COM.CN”, “TVB.HK”, “TVB.COM.HK”, “TVB.COM”, “TVBNEWSROOM.COM.HK”, “TVBN.HK”, “TVBOF.COM.MO”, “TVBOP.COM.MO”, “TVBF.COM.HK”, “TVB.CO.IN”, “TVB.COM.VN”, “TVB.COM.SG”, “TVB.SG”, “TVB.AE”, “TVBIHK.COM”, “TVBCHINA.CN”,

“TVBVIETNAM.COM.AU”, “TVBC.COM.CN”, “TVBFINANCE.COM”, “TVBCHARITY.HK”, “TVBCHARITY.COM.HK”, “TVBCHARITY.ORG”, “TVBCHARITY.ORG.HK”, “TVBC.”, “TVBAPPSTORE.HK”, “TVBAPPSTORE.COM.HK”, “TVBAPPSTORE.COM”, “TVBAPPSTORE.NET”, “TVB.TM”, “TVBANYWHERE.COM”, “TVBANYWHERE.NET”, “TVBANYWHWERE.COM.HK”, “TVBANYWHERE.HK”, “TVBCORPORATE.HK”, “TVBCORPORATE.COM, “TVBCORPORATE.COM.HK”, “TVBEUROPE.ASIA”, “TVBEUROPE.CN”, “TVBEUROPE.CN.COM”, “TVBEUROPE.CO.IN”, “TVBEUROPE.COM.CN”, “TVBEUROPE.COM.TW”, “TVBEUROPE.IN”, “TVBEUROPE.NET.CN”, “TVBEUROPE.ORG.CN”, “TVBEUROPE.TW”, “TVBEUROPE.”, “TVBEUROPE.COM.HK” and “TVBEUROPE.HK”.

Domain name tvbdo.eu was registered on January 9, 2014 in the name of Michael Sing („the Respondent“) allegedly having an address in Denmark. The Respondent used the domain to set up an online social community for its users to view the First Complainant’s Programmes.

A. COMPLAINANT

The First Complainant claims that its name and trademark are well known worldwide. The Complainants enjoy trademark rights in the name “TVB” due to the goodwill and reputation accumulated through extensive use, advertising, promotion of the mark on or before its registration in the early 90s’. The Complainants consider the domain name „tvbdo.eu“confusingly similar to the First Complainant’s trademark “TVB”. The addition of letters “DO” to “TVB” does not remove the similarity between the trademark and the disputed domain name.

The Complainants find that the Respondent has no rights or legitimate interests in the registration of the domain names in dispute as (a) the Respondent is not in any way connected, associated or affiliated with the First Complainant and the First Complainant has not authorized, endorsed or otherwise permitted Respondent to register the domain names in dispute or use the First Complainant’s trade mark or any variation thereof, (b) there is no evidence that the Respondent has been commonly referred to as the disputed domain, and there is no reason why Respondent might reasonably be said to have any rights or legitimate interests in registering or using the disputed domain (c) the Respondent is not making any legitimate, non-commercial or fair use of the domain name in dispute as the Respondent has offered for viewing the First Complainant’s Programmes without authorization on the homepage.

The Complainants find that the Respondent has registered and used the domain name in bad faith. The Respondent, by setting up the platform for its user’s free sharing, distribution and viewing of the First Complainant’s Programmes online, is in fact using the domain name in dispute in direct competition with the Complainants’ business. The Respondent has distracted customers from the Complainants, who, instead of buying video products, set top box, subscribing VOD or visiting the Complainants’ authorized website, choose to visit the Infringing Website in order to get the First Complainant’s Programmes for free. It is obvious that the Respondent is riding on the reputation of the Complainants and uses the domain name in dispute deliberately to attract Internet users to the Infringing Website for commercial benefits. By aiding and abetting users to infringe the First Complainant’s copyright, the Respondent received revenue or other benefits from advertisers’ posting advertisements on the Website.

B. RESPONDENT

The Respondent has not submitted a response to the complaint.

DISCUSSION AND FINDINGS

In accordance with Article 21(1) of the Commission Regulation (EC) No. 874/2004 (the “Regulation”), the Complainant, in order to succeed, is required to prove that:
(i) The domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or Community law and; either
(ii) The domain name has been registered by the Respondent without rights or legitimate interest in the name; or
(iii) The domain name has been registered or is being used in bad faith.

According to Article 10 (a) of the ADR Rules in the event that a Party does not comply with any of the time periods established by these ADR Rules or the Panel, the Panel shall proceed to a decision on the Complaint and may consider this failure to comply as grounds to accept the claims of the other Party. In addition according to Article 10 (b) of the ADR Rules unless provided differently in these ADR Rules, if a Party does not comply with any provision of, or requirement under, these ADR Rules, the Supplemental ADR Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

Based on the foregoing, the Panel draws from absence of response by the Respondent that the factual allegations by the Complainants are true.

1. WHETHER THE DOMAIN NAME IS CONFUSINGLY SIMILAR TO A TRADEMARK IN WHICH THE COMPLAINANT HAS RIGHTS

According to Article 10(1) of the Regulation 'Prior rights' shall be understood to include, inter alia, registered national and community trademarks.

The Complainant has submitted evidences that it owns rights in registered Community Trademark "TVB" (Reg No 6307524) and French trademark „TVB" (Reg No 95582925).

It is well established that the extension „.eu" as such is irrelevant in assessing whether the domain name is identical or confusingly similar to the name in which Complainant has rights. The contested domain name tvbdo.eu consists of the First Complainant's the trademark „TVB" and the letters „do". The addition of a generic English word such as „do" particularly as it has no impact on the meaning of trademark part of a domain name, it does not distinguish the disputed domain name from the First Complainant's trademarks sufficiently.

The Panel accepts the Complainants´ submissions and finds that domain name „tvbdo.eu" is confusingly similar to the First Complainant's TVB trademarks.

2. WHETHER THE RESPONDENT HAS RIGHTS IN THE DOMAIN NAME

Article 21(2) of the Regulation provides that a legitimate interest may include:
(a) prior to any notice of an alternative dispute resolution (ADR) procedure, the holder of a domain name has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so; or
(b) the holder of a domain name, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established
(c) the holder of a domain name is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national law and/or Community law.

The evidence provided by the Complainants does not show that the Respondent would have made a genuine use of the domain name or a name corresponding to the domain name in connection with the offering of goods or services. Neither there is evidence that the Respondent being a natural person has been commonly known by the domain name.

As Paragraph B7 (a) of the ADR Rules expressly allows the Panel to conduct independent investigation at their own discretion the Panel has visited the website tvbdo.eu and in addition viewed the screenshots of the website filed by the Complainants as evidence.

The Respondent has allowed third party advertisements of commercial nature on his homepage and this activity serves usually the purpose to provide the domain name owner with revenue or other benefits. Thus the disputed domain name cannot be regarded as non-commercial. The homepage lists following categories as "Hongkong tvb drama", "tvb drama watch online", Watch Free tvb Series Online" etc. Thus the Respondent makes or allows extensive use of the First Complainants "TVB" trademarks in connection with goods and services the trademark is registered and used for.

The factual circumstances do not allow concluding that the Respondent is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national law and/or Community law.

Therefore, the Panel takes the view that where a prima facie case has been made out by the Complainant it falls to the Respondent to provide an explanation of its rights or legitimate interest in the domain name, if any. The Respondent has failed to submit a response to the Complaint and there is no evidence on the record which indicates that Respondent might be able to satisfy any of the tests in Article 21(2) of Regulation 874/2004 and paragraph B11(e) of the ADR Rules.

3. WHETHER THE DOMAIN NAME HAS BEEN REGISTERED OR USED IN BAD FAITH

For purposes of Article 21(1)(b) of the Regulation, the following circumstances as listed in Article 21(3) of the Regulation may be evidence of the registration or use of a domain name in bad faith:
(a) circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name, in respect of which a right is recognized or established by national and/or Community law, or to a public body; or

(b) the domain name has been registered in order to prevent the holder of such a name in respect of which a right is recognized or established by national and/or Community law, or a public body, from reflecting this name in a corresponding domain name, provided that:
(i) a pattern of such conduct by the registrant can be demonstrated; or
(ii) the domain name has not been used in a relevant way for at least two years from the date of registration; or
(iii) in circumstances where, at the time the ADR procedure was initiated, the holder of a domain name in respect of which a right is recognised or established by national and/or Community law or the holder of a domain name of a public body has declared his/its intention to use the domain name in a relevant way but fails to do so within six months of the day on which the ADR procedure was initiated;
(c) the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor; or
(d) the domain name was intentionally used to attract Internet users, for commercial gain to the Respondent's website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or Community law, or it is a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent; or
(e) the domain name is a personal name for which no demonstrable link exists between the Respondent and the domain name registered.

The Respondent by enabling free sharing, distribution and viewing of the First Complainant's Programmes online, is in fact using the domain name in dispute in direct competition with the Complainants' business. It is obvious that the Respondent is riding on the reputation of the Complainants and uses the domain name in dispute deliberately to attract Internet users to the Infringing Website for commercial benefits. By aiding and abetting users to infringe the First Complainant's copyright, the Respondent received revenue or other benefits from advertisers' posting advertisements on the Website.

Thus the domain name has been intentionally used to attract Internet users, for commercial gain to the Respondent's website, by creating a likelihood of confusion with the First Complainant's trademarks, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website within the meaning of Article 21(3)(d) of the Regulation.

4. PROCEDURAL QUESTIONS

The Panel notes that the First Complainant has address in the Hong Kong and is therefore not an "undertaking having its registered office, central administration or principal place of business within the Community" within the meaning of Article 4(2)(b)(ii) of Regulation (EC) No 733/2002.

The "Overview of CAC panel views on several questions of the alternative dispute resolution for .eu domain name disputes" published by the Czech Arbitration Court states that the consensus view is that "a]ccording to Art 22(1) PPR and Paragraph B 1 (a) of the ADR Rules, any person or entity can start and ADR proceeding. Therefore non-EU-entities have standing in ADR .eu proceedings. However, those entities cannot request a transfer of the domain name, but only revocation [...] The Panels have usually accepted joint complaints filed by non-EU-right holders and their EU subsidiaries or other related entities. If transfer was requested to the EU entity it was usually granted."

The Second Complainant is an "organization established within the Community" within the meaning of Paragraph 4(2)(b)(ii) of Regulation (EC) No 733/2002 and therefore eligible for transfer of the domain name.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name TVBDO be transferred to the Second Complainant Chinese Channel Limited.

PANELISTS

Name	**Ants Nõmper**

DATE OF PANEL DECISION 2015-01-06

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: tvbdo.eu

II. Country of the First Complainant: Hong Kong, Country of the Second Complainant: United Kingdom, country of the Respondent:

Denmark

III. Date of registration of the domain name: 09.01.2014

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. Word trademark "TVB" registered in European Union, reg. No. 006307524, for the term 25.09.2017, filed on 25.09.2007, registered on 05.01.2009 in respect of goods and services in classes 16, 35, 38, 41
2. Word trademark "TVB" registered in France, reg. No. 95582925, for the term of 10 years, renewed 2005, filed on 31.07.1995, registered in 1996 in respect of goods and services in classes 09,16,28,38,41,42

V. Response submitted: No

VI. Domain name is confusingly similar to the protected rights of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why: No evidence that the Respondent would have made a genuine use of the domain name or a name corresponding to the domain name in connection with the offering of goods or services or that the Respondent as a natural person has been commonly known by the domain name or the Respondent is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national law and/or Community law.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: domain name has been intentionally used to attract Internet users, for commercial gain to the Respondent’s website, by creating a likelihood of confusion with the First Complainant’s trademarks, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website.

IX. Other substantial facts the Panel considers relevant:

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: The Panel notes that the First Complainant has address in the Hong Kong and is therefore not eligible for domain name transfer. However, non-EU-entities have a standing in ADR .eu proceedings and the Panels have usually accepted joint complaints filed by non-EU-right holders and their EU subsidiaries or other related entities. The Second Complainant is an “organization established within the Community” within the meaning of Paragraph 4(2)(b)(ii) of Regulation (EC) No 733/2002 and therefore eligible for transfer of the domain name.

XII. Is Complainant eligible? Yes, the Second Complainant Chinese Channel Limited is eligible for transfer.