Panel Decision for dispute CAC-ADREU-003299

Case number	**CAC-ADREU-003299**
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Domain names	**webtv.eu**

Case administrator

Name	**Josef Herian**

Complainant

Organization / Name	**Rupert Beckwith-Moore**

Respondent

Organization / Name	**Novak Antonio**

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 Complainant's representative produces some incomplete evidence of another ADR process under the .eu Dispute Resolution Rules involving the domain name webtv.eu. This appears to have been an application by the Complainant for annulment of Eurid's apparent refusal to reject the Complainant's application for the domain name during the Sunrise Period. Those proceedings would not appear to have been resolved. The reasons why the proceedings seem to have remained undetermined is not known but is unlikely to be material to consideration of the current application.

FACTUAL BACKGROUND

This decision arises from a complaint by the Complainant, Robert Beckwith-Moore, based in the UK, for the revocation or transfer of the Domain Name from the Respondent, Novak Antonio, who is based in Slovenia and who, on 22 August 2006, was registered as the registrant of the Domain Name.

The Complainant is the proprietor of various rights which he asserts entitle him to recover the Domain Name from the Registrant. He brings his Complaint pursuant to the provisions of Article 21(1) of Commission Regulation (EC) 874/2004 ("the Regulations") which provides that

" A registered domain name shall be subject to revocation, using an appropriate extra-judicial or judicial procedure, where that name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law, such as the rights mentioned in Article 10(1), and where it:

(a) has been registered by its holder without rights or legitimate interest in the name; or

(b) has been registered or is being used in bad faith."

A. COMPLAINANT

The Complainant owns various UK and European Community trade mark registrations and a Community Registered Design which it says give it rights in the name WEBTV. These are as follows;

(1) UK mark 2244401 for the word "0101011100101WEBTVx" and "010101100101WEBTVX";

(2) UK mark 2259494. This is for a highly stylised version of the word "webtvx". Part of the stylisation is a spider which is shown to be attached by a thick thread to the underside of the x in "webtvx"

(3) a Community Trade Mark Number 002358752 for an image of a doll/space-man-type character who has, across his chest, the words "www.webtv.co.uk"

(4) A registered design, registered on 25th April 2003 for a word logo. This is highly stylised. The primary word is "web". The words "TV" appear inside the "b" of "web".

The Complainant's representative explains at some length the nature of the rights it says are conferred by the United Kingdom and Community Trade Marks and the registered design. He says that use of webtv.eu by the Respondent will infringe those rights. He asserts that in relation to each of the marks owned by the Complainant the "dominant distinctive and memorable element is WEBTV". In relation to the CTM,it is said that the words "www." and "co.uk" are "so commonplace in everyday life as to be not distinctive and thus not at all memorable". The Complainant then explains the nature of the protection afforded by the Community Design Registration.

It is the Complainant's assertion that UK trade marks 224401 and 2259494 create a recognised right for it in relation to the word WEBTV for the purposes of Article 21 of the Regulations. The Complainant considers that the part of the marks which stands out is the word WEBTV, with the other elements of the trade marks acting merely as background. The Complainant therefore contends that the Domain Name is identical/confusingly similar to its marks for the purposes of Article 21(1) of the Regulations.

With regard to Community Trademark Registration 002358752, the Complainant argues that the mark clearly depicts the name WEBTV which can be separated from the rest of the mark so acting, it believes, as a recognised right in relation to the word WEBTV for the purposes of Article 21(1). The Complainant draws support for this contention from an extract from the UK Trademark Registry's Work Manual which states that where a word is surrounded by 'www.' or 'co.uk', these elements can be ignored when considering the distinctiveness of a mark.

The Complainant asserts that Community Design Registration 000032362.0001 which consists of a design where the only alphanumeric characters are WEBTV, gives the Complainant a prior right in relation to the word WEBTV for the purposes of Article 21(1). This is due to Complainant's contention that because, when viewed, the dominant element of the design is said to be the word WEBTV, a right is created for the Complainant in relation to that word.

On the basis of the above rights, the Complainant submits that the registration of the Domain Name in favour of the Respondent should be revoked under Article 21(1) of Regulations as the Respondent has registered a domain name which is identical or confusingly similar to the Complainants marks and the Respondent does not have any legitimate right or interest in the Domain Name.

Finally, the Complainant's representative asserts that "It is believed that the respondent applied for the domain name webtv.eu on a speculative basis and/or in bad faith". It does not provide any evidence in support of this assertion.

B. RESPONDENT

The Respondent contends that the Complainant can have no rights in the word WEBTV as the word is a descriptive term so cannot be registered as a trade mark. The Respondent supports this contention with a definition of a WEBTV which it has taken from the on-line encyclopaedia Wikipedia. This is as follows;

"A web TV is a specially-adapted television set designed to allow internet connection, or more commonly, a set-top box (i.e. cable decoder) which connects to a standard TV for the same purpose"

The Respondent has also provided search results using the Google and Yahoo search engines. These show 772,000,000 and 7,060,000 hits respectively when the term "WEBTV" is used for a search. The Respondent has stated that he believes these hits match the definition of WEBTV used in Wikipedia, therefore showing it is a widely used descriptive term. The Respondent has also provided an Office for Harmonization in the Internal Market ("OHIM") decision showing that OHIM refused to register the trademark WEBTV to support this contention.

The Respondent believes that the Complainant has no prior rights in relation the word WEBTV or any confusingly similar word and therefore cannot seek to revoke the Domain Name under Article 21(1) of the Regulations. The Respondent submits that as CTM 002358752 is a figurative mark and 000032362-001 is a Community Design Registration these will not confer any rights on the Complainant in relation the word WEBTV, but instead only give the Complainant rights to prohibit the use of similar or identical signs/designs.

The Respondent also asserts that the trade mark "01011100101WEBTVX/0101011100101WEBTVx" (TM No.2244401) and the figurative trade mark "webtvx" (TM No. 2259494) do not confer on the Complainant any rights in relation to the word WEBTV. In relation to TM No.

2259494 this is again due to its figurative nature, and in relation to TM No. 2244401 this is because it is not identical or confusingly similar to the word WEBTV.

For these reasons the Respondent maintains that the contested domain name is not identical or confusingly similar to a name in which the Complainant has a right which is recognised or established by national and/or Community law. Thus he says that the first requirement of Article 21(1) is not met.

The Respondent also states that the Domain Name was not registered in bad faith as the Respondent intends to use it for webtv services. The Respondent admits that the platform is not yet established and says that work on it has ceased due the Complainant's complaint. The Respondent therefore argues that the second requirement of Article 21(1) is thus not met either.

The Respondent accordingly maintains that as the requirements of Article 21(1) of the Regulations have not been met the Complainant's request should be denied.

DISCUSSION AND FINDINGS

To succeed in its complaint, the Complainant must show that it can fulfil both the requirements of Article 21(1) of the Regulations. First the Complainant must show that he is the owner of a name which is identical or confusingly similar to the Domain Name and has rights over that name which are recognised or established by Community and/or national law. Second the Complainant must show that the Respondent did not have a legitimate interest or right in registering the Domain Name or that he registered the Domain Name in bad faith.

Rights in a name

The Complainant has sought to show that it has a recognised right in the Domain Name by presenting the Panel with various trade marks and a registered design of which he is the proprietor. It is important to have regard to the fact that WEBTV is a word which, as the Respondent says, is essentially descriptive. This does not preclude the possibility of trade mark rights arising in the word but the Complainant's assertions in this respect need careful attention. The Panel's assessment of these rights is as follows;

UK Trade Mark No. 2244401

This is a mark which features the text 0101011100101 WEBTVX. The Panel does not consider that Trade Mark No. 224401 satisfies the Article 21(1) requirement that the mark be identical or confusingly similar to the domain name. The combination of zeros, ones and the X make trade mark 224401 very different from the Domain Name. This mark does not therefore give rise to a recognised right in relation to the word WEBTV.

UK Trade Mark 2259494 ("TM 2259494")

TM 2259494 is a figurative mark containing the text "webtvx". It is highly stylised and contains a spider dangling under the x of "webtvx". A figurative trade mark of this type does not, in the Panel's view, confer rights in the word WEBTV.

Community Trade Mark 2358752 ("CTM 2358752")

This is for the spaceman doll which has the words "www.webtv.co.uk" written across its chest. This mark does not convey rights in the word WEBTV. The mere fact that the word "webtv" happens to be part of a longer web address written across the chest of the doll does not serve to create trade mark rights in WEBTV.

Community Registered Design 000032362-0001 ("the Design")

The Design shows a very stylised embodiment of the word "web" with the word "tv" written within the "b" of "web". Under Article 10(1) of the Regulations prior rights are defined to include;

" Inter alia, registered national and community trademarks, geographical indications or designations of origin, and in as far as they are protected under national law in the Member States where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works."

A design right, as the name suggests, confers rights in a design and not in a name. In the view of the Panel, Community Design Rights do not come within Article 10(1) and therefore do not give rise to rights which can be used to challenge the registration of domain names

under Article 21(1) of the Regulations.

The Complainant has been unable to establish that it possesses any prior rights under Article 10(1) and is therefore unable to fulfil the first step of the Article 21(1) test.

In light of the above finding, it is not necessary for the Panel to consider the other steps within the Article 21(1) test. It is however, worth noting that no evidence has been submitted of bad faith.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Complaint is Denied

PANELISTS

Name	**Antony Gold**

DATE OF PANEL DECISION 2007-01-29

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant brought proceedings against the Respondent under Article 21 of the Regulations alleging that the Respondent's registration of the Domain Name should be revoked because of the Complainant's asserted rights in the word WEBTV and because the Respondent's application for the Domain Name was made in bad faith.

The Respondent contended that the various UK and Community Trade Marks and the Community Registered Design of the Complainant did not give rise to any prior rights over the word WEBTV.

The Panel held on these facts that none of the trade marks nor the design right adduced by the Complainant gave it a right in the word WEBTV .

Accordingly, the Panel refused to revoke or transfer the Domain Name.