Panel Decision for dispute CAC-ADREU-005757

Case number	**CAC-ADREU-005757**
Time of filing	**2010-07-12 09:04:46**
Domain names	**mgmrecords.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Metro-Goldwyn-Mayer Studios Inc.**

Respondent

Organization / Name	**Parrothouse, Ware, P**

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 other legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is an independent, privately-held motion picture, television, home video and theatrical production and distribution company. The Complainant owns the world's largest library of modern films, comprising approximately 4,000 titles, and over 10,400 episodes of television programming.

Due to its historical success and more recent success (such as the latest James Bond film - Quantum of Solace), the Complainant enjoys a very strong worldwide reputation in relation to motion picture, television, home video, and theatrical production and distribution, including in the European Union, and has extensive goodwill and a high level of brand recognition around the world.

The Complainant, through its subsidiary Metro-Goldwyn-Mayer Lion Corp., owns many trade mark applications and registrations around the world that consist of or contain MGM. These include Community Trade Mark registration number 000141820 for MGM in Classes 9, 38 and 41; Community Trade Mark registration number 000141895 for MGM in Classes 14, 16, 18, 21, 25, 28 and 42 and Community Trade Mark registration number 002203529 for the figurative mark of the word “MGM” in conjunction with the famous “Leo the Lion” figure in Classes 38 and 41. Extracts for these registrations were attached as annexes to the Complaint.

MGM Records was a record label started by the Complainant in 1946, for the purpose of releasing sound track albums of its musical films. Among the most notable MGM Records soundtrack albums were those of the films Easter Parade, Annie Get Your Gun, Singin' in the Rain, Show Boat, and Seven Brides for Seven Brothers. When the film The Wizard of Oz was first shown on television in 1956, MGM Records issued a soundtrack album of songs and dialogue excerpts recorded directly from the film. MGM Records also issued albums of film scores, including Ben-Hur, King of Kings, and How the West Was Won.

MGM Records later became a pop label, lasting into the 1970s. MGM Records, Inc. was incorporated in Delaware on 13 April 1972 and sold to PolyGram (now part of Universal Music Group) in May 1972. Polygram received perpetual rights to the "MGM Records" name and a ten year licence to use the MGM trade marks and logos. The company merged and ceased to exist on 01 January 1981. An example of recent use of the MGM Records name is on the collectors edition CD cover of the original soundtrack recording for the 1988 motion picture Masquerade, released by Prometheus Records in 2005 under licence from the Complainant and/or related entities.

The Complainant continues its link with the world of music through its MGM Music arm. MGM Music has two main departments, MGM Creative and MGM Music Catalog Development. MGM Music's Creative Team provides an integral connection between the music industry and the filmmakers, from choosing composers to discovering the latest singers and songwriters.

The Complainant has registered many domain names around the world (including in the EU) that consist of or contain MGM, including but not limited to:

• <mgm.com> registered on 07 January 1997; and
• <mgmrecords.com> registered on 24 January 2000.

The Respondent

EURid's WhoIs database shows that the Disputed Domain Name was registered on 20 June 2010.

The Respondent has made no attempt to use the website to which the Disputed Domain Name resolves (“Website”) since it was registered. The only content on the Website is the statement:

“123-reg has registered this domain for one of its customers.”

The Respondent and Registrant is "Ware, P" of Parrothouse. Peter Ware is associated with Parrothouse (www.parrothouse.co.uk), which appears to be a recording studio in Spain. Given his involvement in the music industry, there can be no doubt that the Respondent was aware of the Complainant and its marks at the time that he registered the Disputed Domain Name.

A. COMPLAINANT

Under Article 21(1) of Commission Regulation 874/2004 of 28 April 2004 (the “Public Policy Rules”) a registered domain name is subject to revocation or transfer when:

• 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; and

• either it has been:

o registered without rights or legitimate interest in the name; or

o registered or is being used in bad faith.

Identical and confusingly similar names

The Complainant has rights in names which are recognised by national and/or Community laws including as Community Trade Marks.

The Disputed Domain Name is confusingly similar to the registered trade marks which contain the letters MGM, which are rights recognised by Community law. The Disputed Domain Name would be understood as an expansion of the mark MGM, leading consumers to perceive a nexus between the Complainant and the Disputed Domain Name.

The Disputed Domain Name is confusingly similar to the Complainant’s registered trade marks, its own name, names of subsidiaries and affiliates of the Complainant, and is identical to the record label MGM Records that was created by the Complainant. Such names are capable of being protected by a UK action in passing off in the sense that the Complainant has a reputation that has been misrepresented by the Respondent which is likely to result in damages being incurred.

The Disputed Domain Name is confusingly similar to the Complainant’s registered trade marks, its own name, names of subsidiaries and affiliates of the Complainant, and is identical to the record label MGM Records that was created by the Complainant. The use of the MGM Records label (which is identical the record label that was created by the Complainant) and use of the Disputed Domain Name would constitute a tortious act under the unfair competition laws of many European countries, including France and Spain.

The Complainant therefore fulfils the criteria in the first element of Article 21(1) of the Public Policy Rules.

No rights or legitimate interest

There is no legal or business relationship between the Complainant and the Respondent which would give rise to any licence, permission or authorisation for the Respondent to use the Disputed Domain Name or any of its registered marks.

So far as the Complainant is aware, the Respondent has never been commonly known by the Disputed Domain Name. He has not made legitimate and non-commercial or fair use of the Disputed Domain Name (and there is no explicable reason as to why the Respondent chose the Disputed Domain Name) without intent to mislead consumers or harm the reputation of the MGM marks.

In summary, there is no justification for the Respondent's registration of the Disputed Domain Name: it is a commercial exploitation of the MGM marks and the history of MGM Records, with all of their positive associations and goodwill. The Complainant therefore submits that the Respondent has no rights or legitimate interests in the Disputed Domain Name: the Complainant fulfils the criteria in Article 21(1)(a) of the Public Policy Rules.

Disputed Domain name was registered and is used in bad faith

The Complainant submits that the Disputed Domain Name was registered and is being used by the Respondent in bad faith.

Under Article 22(3) of the Public Policy Rules, "bad faith" may be demonstrated where the domain name was:

• registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the earlier rights holder (Article 22(3)(a)); or

• registered in order to prevent the earlier rights holder from reflecting its name in a corresponding domain name, provided that the domain name has not been used in a relevant way for at least two years from the date of registration (Article 22(3)(b)(ii)).

While the Complainant is unaware of an approach from the Respondent regarding selling, renting, or otherwise transferring the domain name to the Complainant, the effect, rather than the intention of the registration is to prevent the earlier rights holder from reflecting its name in a corresponding domain name: the Complainant fulfils the criteria in Article 22(3) of the Public Policy Rules.

B. RESPONDENT

Respondent did not file a response in the matter

DISCUSSION AND FINDINGS

According to article 21,1 of the Public Policy Rules (Commission Regulation (EC) No 874/2004 with later amendments and paragraph B 11 (d) of the ADR Rules a registered domain name shall be subject to revocation provided that each of the three following elements are satisfied:

(A) The domain name is identical or confusingly similar to a trademark or service
mark in which the Complainant has rights that are recognised or established by national a
and/or Community law; and
(B) Respondent has no rights or legitimate interests in respect of the domain name; and
(C) The domain name has been registered or is being used in bad faith.

The Respondent is in default and paragraph B 10 (a) of the ADR Rules states that the Panel may consider the failure to comply with the time limits for filing a Response as grounds to accept the claims of the Complainant. Paragraph B 10 (b) of the ADR Rules further states that if a party does not comply with any provision of, or requirement under, the Rules or the Supplemental Rules or any request from the Panel, the Panel shall draw such inferences there from as it considers appropriate.

A. Identical or Confusingly Similar

The contested domain name contains the Complainant's distinctive and protected trademark MGM in full. Neither the addition of the descriptive term "records" as suffix nor the inclusion of the gTLD denomination ".eu" alters the fact that the domain name is confusingly similar to the Complainant's trademark.

Consequently, the Panel finds that the disputed domain name is confusingly similar to names in which the Complainant has registered rights. Under those circumstances the Panel does not need to address whether the Complainant holds non-registered rights under the UK rules of passing off that may be invoked as additional legal basis for the Complaint.

B. Rights or Legitimate Interests

The Complainant alleges that the Respondent has no rights or legitimate interests in the domain name. The Respondent has not rebutted this allegation, nor is there any material before the Panel demonstrating that such rights or interests may exist.

The Panel therefore finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered or Used in Bad Faith

The burden of proof that all the requirements of Article 21, 1 of the PPR are fulfilled lies with the Complainant.

The Complainant's trademarks are registered in the European Union and thus also in the home country of the Respondent, Spain.

The Respondent has not rebutted the substantiated allegations put forward by the Complainant. The Panel finds that it is unlikely that the contested domain name has been registered without prior knowledge of the Complainant and the Complainant's rights and further finds that the registration and current use of the domain name is likely to disrupt or otherwise harm the business interests of the Complainant. The registration thus prevents the Complainant from reflecting its name MGM RECORDS in a corresponding domain name.

The Panel is therefore satisfied that the domain name has been registered in bad faith.

In conclusion, considering all the facts and evidence, the Panel finds that all the requirements of paragraph 21, 1 of the PPR and of paragraph B 11(d) of the ADR Rules are met.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name MGMRECORDS be revoked.

PANELISTS

Name	**Knud Wallberg**

DATE OF PANEL DECISION 2010-10-12

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The contested domain name contains the trademark MGM in which the Complainant holds rights. The Complainant filed a Complaint alleging that the domain name was confusingly similiar to a trademark or service mark in which the Complainant had right, that Respondent had no rights or legitimate interests in respect of the domain name; and that the domain name had been registered or was being used in bad faith. The Respondent was in default and thus did not rebut the allegations put forward by the Complainant. Since the allegations were substantiated in the Complaint the Panel found that all the requirements of Paragraph 21, 1 of the Public Policy Rules and Paragraph B 11 (b) and (d) of the ADR Rules were met and thus decided that the contested domain name should be revoked.