

**DISPUTE RESOLUTION SERVICE**

**D00013280**

**Decision of Independent Expert**

World Wrestling Entertainment, Inc.

and

Oversee Domain Management, LLC

**1. The Parties:**

Complainant: World Wrestling Entertainment, Inc.  
Address: 1241 East Main Street  
Stamford  
CT  
06902  
Country: United States

Respondent: Oversee Domain Management, LLC  
Address: 515 S. Flower Street Suite 4400  
Los Angeles  
CA  
90 071  
Country: United States

**2. The Domain Names:**

wweshop.co.uk (“Domain Name”)

**3. Procedural History:**

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the “Policy”) and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the “Procedure”) unless the context or use indicates otherwise.

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

09 September 2013	Dispute received
10 September 2013	Complaint validated and parties notified of the complaint
13 September 2013	Response received
19 September 2013	Notification of response sent to parties
19 September 2013	Reply received and parties notified of the reply
19 September 2013	Mediation started
19 September 2013	Mediation failed
19 September 2013	Respondent non-standard submission received
23 September 2013	Steve Ormand appointed as Expert with effect from 3 October 2013

The Respondent provided a written submission pursuant to §13b of the Procedure. Having considered the explanatory paragraph that was provided to me, I considered it appropriate to see the full submission and directed that the Complainant should provide any reply to it by 15 October 2013. Nominet notified the parties of my decision by email on 14 October 2013.

#### **4. Factual Background**

The Complainant is a media and entertainment company that is publically traded on the New York Stock Exchange with a market capitalisation of approximately US\$768 million. The Complainant owns a number of trade marks incorporating the term “WWE” dating from 2002 in the United States as well as trade marks in, amongst others, the United Kingdom and the European Union.

The Complainant first operated as the Capitol Wrestling Corporation in the United States in 1952 using the name World Wide Wrestling Federation, followed by World Wrestling Federation Entertainment and then, following a sale to Titan Sports company, as World Wrestling Entertainment from 2002. The Complainant changed its name to World Wrestling Entertainment at the same time.

The mark WWE is derived from “World Wrestling Entertainment”.

The Complainant provides wrestling entertainment which is broadcast in more than 145 countries, including through Sky Sports in the United Kingdom and pay per view events. The Complainant’s WWE mark is used in associated markets such as the manufacture and sale of branded toy wrestling figures.

The Respondent is a domain management company established in the United States.

The Respondent registered the Domain Name on 27 April 2005.

#### **5. Parties’ Contentions**

##### **The Complaint**

The Complainant contends that it has Rights in the names WWE and that the Domain Name is similar to this term, on the basis of the following submissions:

1. The Complaint is based on the Complainant's trade marks, company name, trade name and domain names (including www.wwe.com, www.wweshop.com and www.wweglobal.co.uk) and trade mark applications and registrations in more than 60 countries throughout the world for WWE or otherwise including the element WWE, including the United States where the Respondent is located (the Complainant presented evidence of many trade marks for WWE registered in 2002, 2003 and later, in the United States and other countries, as well as WWESHOP registered in February 2009 in the United States).
2. The Complainant is a recognised leader in global entertainment and has spent many years and hundreds of millions of dollars globally to promote its goods and services under the WWE Trade Marks and has a reputation in those trade marks.
3. The element WWE in the Domain Name is contained within the WWE Trade Marks and domain names such as www.wwe.com, www.wweshop.com and www.wweglobal.co.uk. Therefore there is similarity to the Complainant's WWE Trade Marks and domain names. The inclusion of the word "shop" within the Domain Name is not sufficient to overcome the similarity. Furthermore, the Domain Name is also identical to the Complainant's US Trade Mark Registration No. 3581284 WWESHOP.

The Complainant contends that the Respondent's registration and/or use of the Domain Name is an Abusive Registrations on the basis that:

1. The Domain Name includes a link stating "Inquire about this domain". Clicking on the link launches a web page where it is stated that "wwe.shop.co.uk is for sale" and the internet user is invited to make an offer (the Complainant provided a representative page of the Domain Name and the purchase web page taken on 5 September 2013).
2. The Domain Name www.wweshop.co.uk is hosted by DomainSponsor. DomainSponsor is a domain name parking service that offers a "domain monetization and services platform". Therefore, it is reasonable to assume that the Respondent appointed DomainSponsor to host the Domain Name as its agent. The Respondent is therefore responsible for the contents of the site according to normal principles of agency law.
3. The Domain Name also provides pay-per-click links to websites that offer products owned by the Complainant. The screenshots of the Domain Name shows pay-per-click links as a result of selecting the term "sin cara mask". 'Sin cara' is the name of a masked wrestler character featured in the Complainant's WWE branded entertainment.
4. The Respondent has registered or otherwise acquired the Domain Name primarily for the purposes of selling, renting or otherwise transferring them to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name:
  - a. It is submitted that the Respondent knew of, and sought to capitalize on, the fame and value of the WWE Trade Marks, at the time the Domain Name was registered for the purpose of selling, renting or otherwise transferring the Domain Name to the Complainant or one of its competitors as set out at paragraph 3 of the DRS policy.
  - b. The Domain Name is hosted by DomainSponsor, who state that they offer a "domain monetization and services platform", and the fact that internet user is invited to "Inquire about this domain" with the invitation to make an offer to purchase evidences that the Respondent intends to sell the Domain Name, if possible, to the best bidder.
  - c. In addition, it is submitted that the Respondent's use of pay-per-click advertisements is for its own commercial gain and is further evidence of the

intention to sell, rent or otherwise transfer the Domain Name to the Complainant or one of its competitors as set out at §3 of the Policy.

5. The Registrant has registered or otherwise acquired the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has Rights:
  - a. The Complainant has rights in the WWE Trade Marks and so it is submitted that the Registrant's registration of the Domain Name is primarily as a blocking registration against a mark in which the Complainant has rights.
  - b. For example, the Domain Name has been registered with the intention to intercept the internet traffic for the Complainant who will, understandably, believe that it is the Domain Name of the Complainant. Therefore, the registration of the Domain Name by the Respondent blocks the Complainant's legitimate registration of the Domain Name.
6. The Registrant has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant:
  - a. The Respondent's website hosted at the Domain Name not only incorporates WWE Trade Marks in the Domain Name, but also appears to provide pay-per-click links to products and events of the Complainant, and for which the Respondent does not have authorization to offer or display.
  - b. The Complainant's prospective customers will assume that the live website found at the Domain Name is connected to or authorized by Complainant. The Complainant has no control over what is offered to prospective customers. This must inevitably interfere with the business of the Complainant by diverting business or tarnishing its reputation; whether or not this was the Respondent's express intention, there is sufficient purpose for this provision.
7. Circumstances indicate that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorized by, or otherwise connected with the Complainant:
  - a. The Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use Complainant's WWE Trade Marks in a domain name or otherwise. The Complainant does not sponsor or endorse the Respondent in any manner.
  - b. The Respondent's use of the Domain Name is likely to confuse the Complainant's prospective consumers into believing that the Domain Name is registered to, operated or authorized by, or otherwise connected with the Complainant. It is submitted that people looking for the Complainant's goods are highly likely to come across Respondent's Domain Name and be confused as to authentic and legitimate sources of goods and services apparently offered by the Complainant.
  - c. The registration and use of the Domain Name is likely to confuse people or businesses because the Respondent has registered, and is using, a domain name that is highly similar to the Complainant's WWE Trade Marks. The Domain Name is also identical US Trade Mark Registration No. 3581284 WWESHOP.
  - d. The Domain Name invites users to "Inquire about this domain". Clicking on this link launches the web page that confirms that the Domain Name is for sale and invites offers. Furthermore, the Respondent has included pay-per-click links at the Domain Name for monetary gain.
  - e. There is no evidence the Domain Name was intended for any genuine use.
8. In view of:

- a. The Complainants' reputation and goodwill symbolised by its WWE Trade Marks and the absence of any denial thereof; and
- b. the use of the Domain Name by the Respondent for a webpage that clearly invites offers to purchase it and the inclusion of pay-per-click links,

it can be inferred the Respondent must have been aware of the Complainants' rights when the Domain Name was registered and to have been intending to exploit that reputation unfairly/detrimentally to his own ends. There is no other reasonable explanation for the Respondent's acts.

9. In particular, given the high degree of similarity of the Domain Name to the WWE Trade Marks, and the manner in which the website is actually set up, the Domain is clearly intended, or at the very least is highly likely, to attract and confuse persons seeking legitimate websites of the Complainant into thinking the www.wweshop.co.uk website is a genuine, authorised website of the Complainant.
10. Persons mistaking the Domain Name for the Complainant's domain name will be deceived into assuming there is a link to the Complainant's business, with a correspondingly detrimental effect on the reputation and integrity of the Complainant's business within the general definition of Abusive Registration. Further, the Respondent's activities:
  - a. Risk misleading Complainant's customers to the Complainant's detriment;
  - b. Risk diverting business from Complainant; and
  - c. Will take unfair advantage of and will be detrimental to the reputation and distinctive character of the Complainant's famous WWE Trade Marks.
11. It is not possible to obtain evidence of direct confusion. However, the circumstances indicate clearly that the Respondent is using the Domain Name in a way which is reasonably likely to confuse persons into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainants.
12. On the principles of the "One in a Million" case and others, the adoption of this Domain Name clearly amounts to trade mark infringement/passing off and as such are wholly in breach of the Policy.
13. In any event the list under §3 of the Policy is non-exhaustive. It is submitted the evidence establishes clearly that the unauthorized nature of Respondent's activities creates a presumption that the use takes unfair advantage of the Complainants' rights and is therefore abusive.
14. The Complainant has Rights as defined in the Policy. The Domain Name is an Abusive Registration within the meaning of §3 of the Policy.

## **The Response**

The Respondent submitted the following Response by email to the Complainant's representative:

*"We have just received the complaint regarding the domain name wweshop.co.uk. This is the first time we have heard of your claim to this domain name.*

*Without discussing the merits of the claim, it is our policy to expedite transfers whenever there appears to be any basis for a legitimate claim. We find that this best serves the Internet community as a whole, while saving costs for all parties.*

*If you are amenable to expediting the transfer and potentially saving costs for your client, please let us know at your earliest convenience."*

## **The Reply**

The Complainant submitted the following Reply:

*"For commercial reasons, the Complainant confirms that they wish to proceed with the complaint. The Complainant submits that the Respondent's willingness to transfer the domain name is because they are aware that it is an abusive registration."*

## **Respondent's Non Standard Submission**

The Respondent submitted the following explanatory paragraph pursuant to §13b of the Procedure:

*"Thank you in advance for taking into consideration the following short submission (13B Further Statement) outlining the exceptional need for full review. Our initial response was an offer to transfer as per our liberal company transfer policy. Complainant has clearly stated that they would prefer the case go to an expert in pursuit of "commercial reasons." Oversee would like the opportunity to provide a short explanation for our offer to transfer the domain name to the complainant."*

The full submission was provided to me as follows:

*"Respondent is a California company. It acquires domain names in high volume and through lawful and fair methods. As part of its business practice, it has a well-known dispute resolution policy, inter alia, whereby it invites putative complainants to contact it regarding domain names that complainants believe correspond to a trademark. And it has a liberal transfer policy whereby it typically agrees to voluntarily transfer domain names, typically irrespective of the legitimacy of the complainant's arguments, in an effort to avoid the needless time and expense associated with litigation and administrative hearings. Transfers are typically done within one (1) business day.*

*Respondent had never heard of either Complainant or its trademark prior to the filing of this matter. Upon learning of this matter and in an effort to resolve this matter expeditiously and without a substantial investment of time and expense by either party or the Panel, Respondent offered a voluntary transfer of the domain name at issue. Complainant rejected this offer for "commercial reasons" in order to proceed with a decision based on the inference that we offered to transfer out of guilt.*

*So, without admitting fault or liability and without responding substantively to the allegations raised by Complainant, to expedite this matter for the Expert so that its time and resources are not otherwise wasted on this undisputed matter, Respondent stipulates that it is willing to voluntarily transfer the Domain Name to the Complainant."*

## **Reply to Non Standard Submission**

The Complainant submitted the following reply to the Respondent's non-standard submission:

*"The Complainant denies that the Respondent has a well-known dispute resolution policy. It is not apparent from the domain name www.wvshop.co.uk that the Respondent can be contacted regarding domain names that correspond to a trade mark as submitted by the Respondent. As set out in the Complainant's complaint, the evidence at the domain name www.wvshop.co.uk is that the Respondent intends to sell the domain name or issue, if possible, to the best bidder.*

*The Complainant submits that the Respondent must have heard of the Complainant and/or their trade marks bearing in mind the Complainant's reputation and recognition as a leader in global entertainment. Furthermore, the links at the domain name www.wweshop.co.uk are to products and events of the Complainant. Therefore, it is submitted that the Respondent was aware of the Complainant and/or its trade marks prior to the filing of this matter.*

*For all of the reasons set out above, and as explained in further detail in the complaint, it is submitted that www.wweshop.co.uk is an abusive registration and that the Complainant has a reputation in its earlier trade marks and the registration of the domain name takes unfair advantage of and is detrimental to the reputation and distinctive character of the Complainant and the Complainant's trade marks."*

## **6. Discussions and Findings**

### **General**

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2 of the Policy, both limbs of the test that:

- 1. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- 2. The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

### **Complainant's Rights**

Rights is defined in §1 of the Policy as "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning".

The wholly generic suffix ".co.uk" is discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

I am satisfied on the basis of the submissions reproduced above and the substantiating paperwork that the Complainant has registered rights in the name and mark WWE which pre-date the registration of the Domain Name.

I am satisfied that the mark WWE is the distinctive part of the Domain Name and that the addition of "shop" does not detract from the dominance and distinctiveness of the mark. Further, the combination of WWE and "shop" would lead visitors to the website to expect to find WWE products available for sale.

Accordingly, I find that the Complainant has Rights in the mark WWE which is similar to the Domain Name.

### **Abusive Registration**

Abusive Registration is defined in §1 of the Policy as a Domain Name which either:

- 1. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*

2. *has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §3 of the Policy.

The Complainant's assertion of Abusive Registration is presented, more or less verbatim, in section 5 above.

The Respondent declined to respond to the Complaint, offering instead to transfer the Domain Name to the Complainant. The Complainant refused to accept the transfer for "commercial reasons" and elected to refer the matter to an expert. Accordingly, I will proceed with a decision pursuant to §16a of the Procedure.

The Complainant asserts that the Respondent's use of the Domain Name is likely to confuse the Complainant's prospective consumers into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. Thus, the Complainant submits, people looking for its goods or services are highly likely to come across the Domain Name and be confused as to authentic and legitimate sources of goods and services apparently offered by the Complainant.

In DRS 03027 (epson-inkjet-cartidge.co.uk and 13 others) the appeal panel considered that confusion may arise, irrespective of the content of the respondent's website, merely as a result of the adoption of a domain name incorporating the complainant's mark and that this "initial interest confusion" is admissible in DRS cases.

I am satisfied that an internet user typing "WWE shop" into a search engine and presented with the Respondent's website in a list of results would visit in the expectation that the website will offer WWE products for sale. On entering the website it will be apparent to some visitors that it is a parking site and that WWE products are not offered for sale at that site but via pay-per-per-click links to other sites. Nevertheless, this constitutes initial interest confusion and the visitor has been deceived by the Domain Name.

I am also satisfied that some visitors may not appreciate that it is a parking site and would view the page as a list of WWE products or services that are available to the visitor, not as links to other sites. The links include "WWE Shop", "WWE T Shirts", "WWE Wrestling Action Figures", "WWE Smackdown Wrestling", "WWE Tickets" and so on.

In the appeal decision in DRS 00248 (Seiko-shop.co.uk) the panel said that the use of a trade mark for a domain name without the consent of the trade mark owner for the selling of genuine products could make the false representation that there was something official or approved about the website which in turn could constitute unfair advantage being taken of rights in the mark by using that domain name.

The Respondent does not dispute that it used the Complainant's mark WWE in the Domain Name without the Complainant's consent.

Accordingly, I find that the Respondent's use of the Domain Name has caused confusion, which pursuant to §3a of the Policy is evidence that the Domain Name is an Abusive Registration.

Turning to the Respondent's non-standard submission, it says that it acquires domain names in high volume through lawful and fair methods and that it operates a "well known" dispute resolution policy whereby it voluntarily transfers disputed domain names, typically irrespective of complainants' arguments, in order to avoid needless time and expense. The Respondent says that it did not know of the Complainant or the mark WWE prior to this Complaint.



This explanation is not good enough. It suggests that the Respondent acquires domain names in high volume but does not check whether such domain names may infringe the Rights of others. The Respondent appears to rely instead on owners of Rights to raise a complaint, at which point it offers to transfer the domain name. This may appear at first sight to be a fair and reasonable policy. However, in the period before a complaint is raised the Respondent has earned pay-per-click revenue. Undoubtedly some of this revenue will arise from abusive registrations. In this matter, the Respondent is likely to have earned revenue from an Abusive Registration for up to 8 years.

I also find it difficult to accept that the Respondent did not know of the mark WWE prior to the Complaint. It is possible that it did not know that it had incorporated the mark in the Domain Name because it does not operate procedures to check but this does not absolve the Respondent of responsibility for the registration or use of a domain name, whether on a parking site operated by a third party or otherwise.

When a company registers or acquires domain names in such large quantities that it becomes economically inefficient for it to identify and weed out Abusive Registrations individually, it is necessarily running the risk that some of those domain names will be the subject of adverse decisions under dispute resolution procedures such as the DRS. On the evidence before me I am satisfied that the Domain Name is one such example.

## **7. Decision**

In light of the foregoing findings, namely that the Complainant has Rights in a name which is similar to the Domain Name, and the Domain Name, in the hands of the Respondent, is an Abusive Registration, I direct that the Domain Name (wweshop.co.uk) be transferred to the Complainant.

**Signed: Steve Ormand**

**Dated: 24<sup>th</sup> October 2013**