

DISPUTE RESOLUTION SERVICE

D0020639

Decision of Independent Expert

Warner Media, LLC

and

Domain Management MIC

1. The Parties:

Complainant: Warner Media, LLC
One Time Warner Center
New York, NY 10019
New York
United States of America

Respondent: Domain Management MIC
15 5th street
Closter
NJ 07624
United States of America

The Domain Name:

warnermedia.co.uk

Procedural History:

I 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 into question my independence in the eyes of one or both of the parties.

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| December 22, 2018 | Dispute received |
| December 27, 2018 | Complaint validated |
| December 27, 2018 | Notification of complaint sent to parties |

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|------------------|---|
| January 16, 2019 | Response reminder sent |
| January 21, 2019 | No Response Received |
| January 21, 2019 | Notification of no response sent to parties |
| January 29, 2019 | Expert decision payment received |

Factual Background

The factual background is taken from the Complaint.

The Complainant, under the name Warner Media, LLC, is the successor-in-interest to Time Warner, Inc. The Complainant is a major provider of entertainment, owning or associated with brands including Home Box Office, Inc., Turner Entertainment Company, Inc., Warner Bros. Entertainment, Inc., Batman, Superman, Harry Potter, and Game of Thrones.

The Complainant applied for the trademark WARNERMEDIA on June 29, 2018 at the European Intellectual Property Office (EUIPO), in classes 9, 38 and 41, and on June 18, 2018 at the United States Patent and Trademark Office (USPTO), in three applications covering respectively classes 9, 38 and 41. The Complainant also registered the domain name <warnermediagroup.com> on October 5, 2017.

The disputed Domain Name was registered on June 15, 2018 and does not appear to resolve to an active website.

Parties' Contentions

Complainant

Complainant's Rights

The Complainant contends that apart from having made the European and United States trademark applications referenced above, it has common law rights and the trademark has acquired secondary meaning. The succession from Time Warner, Inc., to Warner Media LLC was publicly announced on June 15, 2018 and was widely reported by the major media outlets. The word "Warner" has been widely used in entertainment and media contexts since the formation of Time Warner, Inc., in 1990. The popularity of the Complainant's productions has been widely discussed in the media and they are well advertised.

The Complainant says the Domain Name is identical to the Complainant's trademark.

Abusive Registration

The Complainant contends that at the time of registration, the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's rights. The Domain Name was registered primarily as a blocking registration that, if used, would cause confusion with the Complainant.

The Complainant says the Domain Name (and also the domain name warnermedia.group) was registered by the Respondent one day after the Complainant filed its United States trademark applications, and on the day that the change of name to Warner Media, LLC., was publicly announced following the anticipated merger of AT&T, Inc., and Time Warner, Inc.

The Complainant says the Respondent has engaged in a pattern of the registration of domain names corresponding to well-known trademarks in which the Respondent has no apparent rights such as Foot Locker, Yahoo, Radio Shack, and Bloomberg. Of 43 UDRP proceedings against the Respondent, 42 have resulted in transfer or cancellation.

The Complainant further contends that the Respondent's primary purpose of registering the Domain Name was to sell it to the Complainant for USD 1,250, being in excess of registration costs.

The Complainant says the Domain Name, when an attempt was made to visit it, caused the appearance of a website (clickconfirmation.com) displaying an announcement to the effect that the Domain Name may be a suspicious website. The Complainant believes this warning page itself may appear to be malware and a device on the part of the Respondent to induce the Complainant to buy the Domain Name.

The Complainant has cited a number of previous decisions under the Policy that it considers to support its position.

The Complainant requests the transfer of the Domain Name.

Respondent

The Respondent has not replied.

Discussions and Findings

Under paragraph 2.1 of the Policy the Complainant must prove, on the balance of probabilities, that:

“2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.”

Complainant's Rights

In paragraph 1 of the Policy rights are defined as follows:

“Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.

Ideally, the Complainant should demonstrate rights in a relevant trademark. The Complainant does not in fact have a registered trademark for WARNERMEDIA, and trademark applications (which were in any case dated later than the Domain Name registration) are not sufficient.

The Complainant asserts common law rights and secondary meaning in an unregistered trademark for WARNERMEDIA. As discussed at section 2.2 of the Experts' Overview, v3, there would need to be supporting evidence that “(a) the Complainant has used the name or mark in question for a not insignificant period and to a not insignificant degree (e.g. by way of sales figures, company accounts etc) and (b) the name or mark in question is recognised by

the purchasing trade/public as indicating the goods or services of the Complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/ orders/invoices from third parties and third party editorial matter such as press cuttings and search engine results)".

The Complainant refers the Expert to a number of media articles disseminating and commenting on the announcement of the formation of the entity Warner Media, LLC. All are dated on or after June 15, 2018, the date of the announcement. This being the date of registration of the Domain Name, the Complainant is not in a position to demonstrate use of WARNERMEDIA as a trademark for a "not insignificant period" prior.

Alternatively, the Complainant might produce evidence of rights in a trademark for WARNER and argue that the Domain Name features that trademark prominently, and that the generic or descriptive word "media" does not avoid confusing similarity. The Expert cannot look outside of the evidence presented, and if the Complainant has trademarks for WARNER, then it has not produced direct evidence of them.

A registered or unregistered trademark is not essential under the Policy, which provides for the Complainant to demonstrate rights in respect of a "name or mark". Implicitly the criteria of duration and substance for there to be rights in an unregistered trademark apply also to a name, and whilst "Warner Media" can scarcely qualify, it may be that the name "Warner" alone may do so. The Complainant claims extensive use of the name "Warner" in association with its goods and services since the inception of Time Warner, Inc., in 1990.

The media articles annexed by the Complainant concentrate heavily on Warner Media, LLC and plans for the future, but a few wider mentions of other related Warner enterprises may be found, albeit in the nature of hearsay.

A CNN news item on the website cnn.money.com dated June 15, 2018, produced in evidence, is headed: "Time Warner unveils its new name: WarnerMedia", and indicates the restructuring was completed the previous day.

An article on the forbes.com website is titled "Harry Potter Tour Conjures Up \$435 Million Of Revenue For Time Warner" and refers to the period since 2012. There are references to "Warner" (Time Warner Entertainment) having taken over the Harry Potter production studio in 2010. The lavish Harry Potter backstage public tour, on which Time Warner Entertainment has spent over USD 100 million, is said to attract up to 6,000 visitors a day in peak season.

A BBC news website article dated June 12, 2018, is headed "Judge clears AT&T takeover of Time Warner". Part of the article reads: "Judge Leon's decision comes more than 18 months after AT&T announced in 2016 its plans to buy Time Warner in a transaction then valued at about \$85bn. The deal is set to unite AT&T's significant wireless, satellite television and internet business with Time Warner's media properties, which include HBO and CNN".

On an overview, and taking into account the modest bar presented by paragraph 2.1.1 of the Policy, the Expert can discern a sufficient indication that the name Warner has been associated by the public internationally with entertainment "for a not insignificant period and to a not insignificant degree". The Domain Name, comprising "Warner" and the related descriptive term "media", is found to be confusingly similar to the Complainant's name under paragraph 2.1.1 of the Policy.

Abusive Registration

Under paragraph 1 of the Policy, Abusive Registration means a Domain Name that either:

- i. 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
- ii. is being used or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.”

Paragraph 5.1 of the Policy provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration, including:

“5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name 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;

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 Circumstances indicating 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 authorised by, or otherwise connected with the Complainant;

5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

5.1.4 It is independently verified that the Respondent has given false contact details to us;

5.1.5 The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:

5.1.5.1 has been using the Domain Name registration exclusively; and

5.1.5.2 paid for the registration and/or renewal of the Domain Name registration;

5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.

5.2 Failure on the Respondent's part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration.

5.3 There shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three (3) or more DRS cases in the two (2) years before the complaint was filed. This presumption can be rebutted (see paragraphs 8.1.4 and 8.3)".

Paragraph 8 of the Policy sets out how the Respondent may demonstrate in its Response that the Domain Name is not an Abusive Registration, but the Respondent has not replied.

Paragraph 1(i) of the Policy refers to the time of registration of the Domain Name, which in the present instance is highly significant. As alluded to above, the intended takeover of Time Warner, Inc., by AT&T, Inc., in a high profile transaction valued at about \$85bn, had been public knowledge for more than 18 months. Apart from the Complainant's registration of the domain name warnermediagroup.com on October 5, 2017, the Complainant's earliest public notification of its existence under the name Warner Media, LLC was, by its own statement, on June 15, 2018, and was made to numerous news media internationally.

The Domain Name was registered on the same date of June 15, 2018, and does not appear to have been used productively. In the absence of any explanation to the contrary by the Respondent, the inescapable conclusion is that the Domain Name was registered in consequence of the Complainant's release of the news of its new name and the Respondent did so in order to obtain the Domain Name before the Complainant, thereby taking unfair advantage of the Complainant's potential rights in its new name. The Expert finds the Respondent's action to constitute a blocking registration under paragraph 5.1.1.2 of the Policy, and that the most probable purpose was in turn to secure a profitable sale of the Domain Name to the Complainant or a competitor under paragraph 5.1.1.1 of the Policy.

Furthermore, the Complainant has produced evidence that the registration of the Domain Name was part of a pattern of the registration of domain names (which need not be ".uk" registrations) comprising well known names or trademarks, within the contemplation of paragraph 5.1.3 of the Policy. The list of 42 sustained complaints against the Respondent produced by the Complainant includes the company names Accor, AXA SA, Bloomberg Financial LP, LEGO Juris A/S, Fox Broadcasting Company, and Reed Elsevier Inc. About 20 of these complaints were within the past two years (paragraph 5.3 of the Policy).

Accordingly the Expert finds Abusive Registration of the Domain Name in the hands of the Respondent under paragraph 1(i) of the Policy.

Decision

The Expert finds that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name warnermedia.co.uk and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Domain Name warnermedia.co.uk is ordered to be transferred to the Complainant.

Signed Clive Trotman

Dated February 15, 2019