



NATIONAL ARBITRATION FORUM

DECISION

Capstar Radio Operating Company v. Namia Limited
Claim Number: FA0606000724378

PARTIES

Complainant is **Capstar Radio Operating Company** ("Complainant"), represented by **Kristi F. Nickel**, of **Cox Smith Matthews Incorporated**, 112 East Pecan Street, Suite 1800, San Antonio, TX 78205. Respondent is **Namia Limited** ("Respondent"), PO Box 533WB, West Bay, Grand Cayman WB KY.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**wamx.com**>, registered with **Signature Domains, LLC**.

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on May 31, 2006; the National Arbitration Forum received a hard copy of the Complaint on June 2, 2006.

On June 1, 2006, Signature Domains, LLC. confirmed by e-mail to the National Arbitration Forum that the <**wamx.com**> domain name is registered with Signature Domains, LLC. and that Respondent is the current registrant of the name. Signature Domains, LLC. has verified that Respondent is bound by the Signature Domains, LLC. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On June 8, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of June 28, 2006 by which Respondent could file a response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@wamx.com by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On July 6, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

This Complaint is based on the following factual and legal grounds: ICANN Rule 3(b)(ix).

- [a.] Specify in the space below the manner in which the domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights. ICANN Rule 3(b)(ix)(1); ICANN Policy ¶4(a)(i).

The Respondent has registered the domain name wamx.com utilizing the trademark owned by Complainant. Obviously, the Respondent's domain is identical to Complainant's mark and is therefore likely to cause confusion. Respondent registered the domain name wamx.com after Complainant had established common law rights in the mark WAMX.

- [b.] Specify in the space below why the Respondent (domain-name holder) should be considered as having no rights or legitimate interests in respect of the domain name(s) that is/are the subject of the complaint. ICANN Rule 3(b)(ix)(2); ICANN Policy ¶4(a)(ii).

Respondent's use of the domain name is not in connection with a bona fide offering of goods or services; and

Respondent is NOT commonly known by this domain name, by contrast, it appears Respondent is known by "Namia Limited."

Respondent is NOT making fair use of the domain name in that it is NOT using the domain name as part of a legitimate business. *See Clear Channel Communications, Inc. v. Russx Casting Company a/k/a ForSale*, FA01090000100145 (Nat. Arb. Forum November 16, 2001)(finding that infringing on another's mark to link to a site containing sexually explicit material is not a legitimate use); *see also National Football League Prop., Inc., et al. a. One Sex Entertainment Co.*, D2000-0118 (WIPO April 17, 2000)

(finding that Respondent had no rights to domain names where the Respondent linked the domain names to its pornographic website). Respondent is merely using the domain name to misleadingly capture and redirect Complainant's customers to a website that contains links to various other websites, including advertisements and pornographic materials, from which Respondent is presumably profiting; the offer of such links tarnishing the reputation and good name of Complainant. Complainant apologizes to the Panel for the graphic language in the evidence which follows, but felt it was necessary to show the nature of Respondent's use.

[c.] Specify in the space below why the domain name(s) should be considered as having been registered and being used in bad faith. ICANN Rule 3(b)(ix)(3); ICANN Policy ¶4(a)(iii).

As provided in paragraph 4(b) (iv) of the ICANN Policy, bad faith is demonstrated by Respondent intentionally attempting to attract, for commercial gain, Internet users to Respondent's website by placing on its website trademarks and words that mimic Complainant's services to glean financial gain from the good will Complainant has established in the Marks. As previously noted, Complainant's mark WAMX can be found throughout Respondent's web page. Additionally, Complainant has established common law rights in the marks WAMX 106.3 and BABE OF THE DAY and uses these marks on its web page. Respondent's web page contains several hyperlinks to "WAMX106.3," which is identical to Complainant's WAMX 106.3 mark and contains the terrestrial broadcasting frequency associated with Complainant's FM radio broadcasting services. Complainant submits that the unique identifying characteristic of the terrestrial frequency 106.3 and its use alongside WAMX offers further proof that Respondent is attempting to profit from Complainant's good will. Respondent's web page also contains several links to "BABE OF THE DAY," which is a promotional activity associated with Complainant's broadcasting services. Complainant has also established common law rights in the mark WAMX X-FEST and uses this mark in connection with a popular concert series. Not surprisingly, Respondent's web page also contains several hyperlinks to "WAMXXFEST," which is confusingly similar to Complainant's mark.

Complainant also notes that Respondent is currently the owner of record for over 1,700 domain names, some of which are pornographic, and some of which also contain registered trademarks belonging to parties other than Respondent. Additionally, Complainant has provided a condensed list of all domain names currently registered under the name "Namia Limited." The Lanham Act expressly provides that an accused cybersquatter's "registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others" is an important factor in determining whether the defendant demonstrated bad faith in using the mark. 15 U.S.C. § 1125(B)(i)(VIII).

Rather than point out every instance in which one of Respondent's listed domain names contains a registered third-party trademark, Complainant has compiled a short list containing one such instance for practically every letter of the alphabet. Particular notice should be given to the mark WYUU, owned by Infinity Radio License, Inc., which is used in connection with radio broadcast services in the Tampa, Florida area. Visitors to the domain name www.wyuu.com receive a list of misdirected links similar to the web

page in the instant case. It would appear that Respondent has made a habit of registering the call signs and trademarks of radio stations.

Additionally, the list of registered domain names owned by Respondent suggests that Respondent also practices typo-squatting, *i.e.*, exploiting common misspellings of registered trademarks to deceive and misdirect consumers. For example, Respondent owns the domain names GLAXOSMITHKLIEN.COM, a misspelling of Reg. No. 2,661,430 for GLAXOSMITHKLINE; ROYALCARIBIAN.COM, a misspelling of Reg. No. 1,397,148 for ROYAL CARIBBEAN; and STARBRUST.COM, a misspelling of Reg. No. 1,000,007 for STARBURST. Finally, Complainant notes that Respondent has been found guilty of cybersquatting in the past. *See Waterford Wedgwood plc. v. Namia Limited*, D2005-0134 (WIPO April 7, 2005) (Panel found that Namia was not making fair use of the mark WATERFORD, and that the mark was used in bad faith. Consequently, Panel ordered “that the domain name <waterfordchina.com> be transferred to the Complainant.”).

In conclusion, Respondent is NOT making fair use of the domain name in that it is NOT using the domain name as part of a legitimate business. Respondent has acquired the domain name solely for the purpose of commercial gain by misleadingly capturing consumers of the mark at issue and diverting unsuspecting consumers of Complainant’s services to Respondent’s web site.

B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant, Capstar Radio Operating Company, has used the WAMX mark in connection with the operation of its FM radio station, WAMX 106.3, since May 29, 1997. Complainant was assigned the WAMX station identifiers by the Federal Communications Commission (File No. BLH 19970529KA assigned May 29, 1997), and uses the identifiers as its mark in connection with radio broadcasting and with events and promotions sponsored by the radio station, including the popular “Babe of the Day” promotion, as well as the “WAMX X-Fest” concert series. Additionally, Complainant utilizes the WAMX mark in conjunction with various advertising and promotional materials, including signs, print advertisements and brochures. Complainant has registered the <x1063.com> domain name, and uses its website to inform Internet users about its radio broadcasts and accompanying events and promotions. The WAMX mark is used prominently throughout Complainant’s website.

Respondent registered the <wamx.com> domain name on April 1, 2002. Respondent is using the disputed domain name to redirect users to its website featuring links to third-party websites and advertisements for assorted goods and services, including gambling websites and adult-oriented websites. Respondent’s website incorporates the WAMX mark, as well as the “WAMX X-Fest” and “Babe of the Day” titles, which Complainant uses in the promotion of its offering of broadcasting services.

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

It is not necessary for Complainant to hold a registered trademark to establish rights in the WAMX mark. Common law rights in a mark are sufficient to satisfy Policy ¶4(a)(i). *See SeekAmerica Networks Inc. v. Masood*, D2000-0131 (WIPO Apr. 13, 2000) (finding that the Rules do not require that the complainant's trademark or service mark be registered by a government authority or agency for such rights to exist); *see also British Broad. Corp. v. Renteria*, D2000-0050 (WIPO Mar. 23, 2000) (noting that the Policy "does not distinguish between registered and unregistered trademarks and service marks in the context of abusive registration of domain names" and applying the Policy to "unregistered trademarks and service marks").

Complainant has established common law rights in its WAMX mark through extensive and continuous use since May 29, 1997. Complainant has used the mark in print advertising, brochures and promotional material. Complainant uses the mark on the website connected with its registered domain name <x1063.com>. While the mark is not a registered trademark, the WAMX mark is the combination of call letters assigned to Complainant by the Federal Communications Commission. The Panel finds Complainant has created substantial consumer recognition in the WAMX mark sufficient to establish Complainant's rights in the mark pursuant to Policy ¶4(a)(i). *See Tuxedos By Rose v.*

Nunez, FA 95248 (Nat. Arb. Forum Aug. 17, 2000) (finding common law rights in a mark where its use was continuous and ongoing, and secondary meaning was established); *see also Keppel TatLee Bank v. Taylor*, D2001-0168 (WIPO Mar. 28, 2001) (“[O]n account of long and substantial use of [KEPPEL BANK] in connection with its banking business, it has acquired rights under the common law.”).

Respondent’s <**wamx.com**> domain name is identical to complainant’s WAMX mark. The disputed domain name uses the WAMX mark in its entirety, adding only the top-level domain “.com.” The Panel finds the mark and disputed domain name are identical, despite the addition of a top level domain, pursuant to Policy ¶4(a)(i). *See Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the top level of the domain name such as “.net” or “.com” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar); *see also Gardline Surveys Ltd. v. Domain Fin. Ltd.*, FA 153545 (Nat. Arb. Forum May 27, 2003) (“The addition of a top-level domain is irrelevant when establishing whether or not a mark is identical or confusingly similar, because top-level domains are a required element of every domain name.”).

The Panel finds Policy ¶4(a)(i) satisfied.

Rights or Legitimate Interests

Complainant asserts Respondent lacks rights or legitimate interests in the disputed domain name. Complainant’s assertion creates a *prima facie* case and shifts the burden to Respondent to prove Respondent has rights or legitimate interests in the disputed domain name pursuant to Policy ¶4(a)(ii). The Panel may view Respondent’s failure to respond as evidence Respondent does not have rights or legitimate interests in the disputed domain name. *See G.D. Searle v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002) (“Because Complainant’s Submission constitutes a *prima facie* case under the Policy, the burden effectively shifts to Respondent. Respondent’s failure to respond means that Respondent has not presented any circumstances that would promote its rights or legitimate interests in the subject domain name under Policy ¶4(a)(ii).”); *see also Am. Express Co. v. Fang Suhendro*, FA 129120 (Nat. Arb. Forum Dec. 30, 2002) (“[B]ased on Respondent’s failure to respond, it is presumed that Respondent lacks all rights and legitimate interests in the disputed domain name.”). The Panel will evaluate the available evidence to determine whether Respondent has rights or legitimate interests in the disputed domain name pursuant to Policy ¶4(c).

Respondent is using the <**wamx.com**> domain name, which is identical to Complainant’s WAMX mark, to redirect Internet users to Respondent’s website. Respondent’s website includes the “WAMX X-Fest” and “Babe of the Day” titles, copying material on Complainant’s website and suggesting Respondent’s use of domain name and Complainant have some kind of relationship. Respondent’s use of Complainant’s mark in the disputed domain name, in combination with the some similarity between material on Complainant’s website and material on Respondent’s website suggests that

Respondent is intentionally infringing on Complainant's mark in order to redirect Internet users to Respondent's website. Respondent's website features advertisements and links to third-party websites. Presumably, Respondent receives payment for both the advertisements and the links. The Panel finds such use does not constitute a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i), or a legitimate noncommercial or fair use pursuant to policy ¶4(c)(iii). See *eBay Inc. v. Hong*, D2000-1633 (WIPO Jan. 18, 2001) (stating that the respondent's use of the complainant's entire mark in domain names makes it difficult to infer a legitimate use); see also *Bank of Am. Corp. v. Nw. Free Cmty. Access*, FA 180704 (Nat. Arb. Forum Sept. 30, 2003) ("Respondent's demonstrated intent to divert Internet users seeking Complainant's website to a website of Respondent and for Respondent's benefit is not a bona fide offering of goods or services under Policy ¶4(c)(i) and it is not a legitimate noncommercial or fair use under Policy ¶4(c)(iii)."); see also *Isleworth Land Co. v. Lost In Space, SA*, FA 117330 (Nat. Arb. Forum Sept. 27, 2002) (finding that the respondent's use of its domain name to link unsuspecting Internet traffic to an adult orientated website did not constitute a connection with a *bona fide* offering of goods or services or a noncommercial or fair use).

There is no evidence Respondent is commonly known by the <**wamx.com**> domain name. Complainant asserts there is no relationship between Complainant and Respondent that would justify Respondent's use of Complainant's mark. Respondent's WHOIS information identified Respondent as "Namia Limited," which is completely unrelated to <**wamx.com**>. The Panel finds Respondent is not commonly known by the disputed domain name and lacks rights or legitimate interests pursuant to Policy ¶4(c)(ii). See *Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name); see also *Tercent Inc. v. Lee Yi*, FA 139720 (Nat. Arb. Forum Feb. 10, 2003) (stating "nothing in Respondent's WHOIS information implies that Respondent is 'commonly known by' the disputed domain name" as one factor in determining that Policy ¶4(c)(ii) does not apply).

Registration and Use in Bad Faith

Respondent is using the <**wamx.com**> domain name to redirect Internet users to Respondent's website featuring advertisements and links to third-party websites, including websites involving gambling and adult content, all of which are presumably sources of revenue for Respondent. Not only is Respondent's domain name identical to Complainant's mark, but Respondent's website also incorporates the "WAMX X-Fest" and "Babe of the Day" titles identical to those used by Complainant to promote its broadcasting services on its website. Respondent is potentially confusing Internet users into believing that Respondent is affiliated with Complainant by copying Complainant's mark and promotional materials. Respondent is attempting to divert Internet users to its website for commercial gain by utilizing Complainant's mark to operate a website providing links to third-party websites featuring adult content and gambling (for which Respondent likely receives a referral fee). The Panel finds such use is evidence of bad

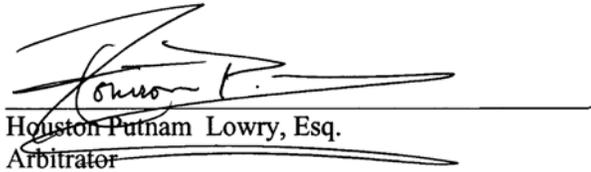
faith registration and use pursuant to Policy ¶4(b)(iv). *See Am. Univ. v. Cook*, FA 208629 (Nat. Arb. Forum Dec. 22, 2003) (“Registration and use of a domain name that incorporates another's mark with the intent to deceive Internet users in regard to the source or affiliation of the domain name is evidence of bad faith.”); *see also Qwest Comm’ns Int’l Inc. v. Ling Shun Shing*, FA 187431 (Nat. Arb. Forum Oct. 6, 2003) (“Respondent has attempted to commercially benefit from the misleading <qwestwireless.com> domain name by linking the domain name to adult oriented websites, gambling websites, and websites in competition with Complainant. Respondent’s attempt to commercially benefit from the misleading domain name is evidence of bad faith pursuant to Policy ¶4(b)(iv).”); *see also Mars, Inc. v. Double Down Magazine*, D2000-1644 (WIPO Jan. 24, 2001) (finding bad faith under Policy ¶4(b)(iv) where the respondent linked the domain name <marssmusic.com>, which is identical to the complainant’s mark, to a gambling website).

The Panel finds Policy ¶4(a)(iii) satisfied.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**wamx.com**> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: July 19, 2006

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