

ADMINISTRATIVE PANEL DECISION

Mediaset S.p.A. v. Didier Madiba, Fenicius LLC
Case No. D2011-1954

1. The Parties

The Complainant is Mediaset S.p.A. of Cologno Monzese, Italy, represented by Studio Associato Carlo Sala, Italy.

The Respondent is Didier Madiba, Fenicius LLC of Wilmington, Delaware, United States of America, represented by ESQwire.com Law Firm, United States of America.

2. The Domain Name and Registrar

The disputed domain name <mediaset.com> is registered with Moniker Online Services, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 8, 2011. On November 9, 2011, the Center transmitted by email to Moniker Online Services, LLC a request for registrar verification in connection with the disputed domain name. On November 9, 2011, Moniker Online Services, LLC transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on November 11, 2011 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On November 11, 2011, the Center also notified the Complainant of a minor deficiency and requested the Complainant to amend the Complaint accordingly. The Complainant filed an amended Complaint by email on November 11, 2011. The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with paragraphs 2(a) and 4(a) of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 16, 2011. In accordance with paragraph 5(a) of the Rules, the due date for Response was December 16, 2011 after a mutual agreement of the Parties to extend the time for filing a response. The Response was filed with the Center December 16, 2011.

On January 31, 2012, the Center received Supplemental submissions from both parties, which refer to court proceedings in Rome, Italy, initiated by the Complainant against the Respondent.

The Center appointed Brigitte Joppich, Fabio Angelini and The Hon Neil Brown QC as panelists in this matter on January 26, 2012. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with paragraph 7 of the Rules.

4. Factual Background

The Complainant is the biggest Italian and Spanish private TV group, which controls a number of TV stations, *inter alia* Reti Televisive Italiane S.p.A. and Telecinco.S.A.

The Complainant is registered owner of several Italian, International and European Community trademark registrations for MEDIASET, including Italian trademark registration no. 634037 MEDIASET, applied for on October 19, 1994 and registered on November 18, 1994, International Registration no. 631719 MEDIASET, registered on November 18, 1994 (hereinafter referred to as the "MEDIASET Marks"). The MEDIASET Marks have already been found to be well-known (cf. *Mediaset S.p.A. v. MustNeed.com*, WIPO Case No. D2008-0723 (<mediaset.com>). Furthermore, the Complainant is registered owner of numerous domain names for "mediaset", including <mediaset.it>, <mediaset.net>, and <mediaset.info>.

The Respondent backordered the domain name <mediaset.net> and probably also the domain name <mediaset.com> on August 29, 2006, and acquired the disputed domain name on March 19, 2011 after winning an auction through Snapnames.com, Inc.

The disputed domain name is presently inactive showing a header "Coming soon...".

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy has been proven in the present case:

- (1) the disputed domain name is identical or confusingly similar to the MEDIASET Marks as the TLD ".com" is to be disregarded in determining identity.
- (2) the Respondent has no rights or legitimate interests in the disputed domain name as it has no connection with the Complainant, as it received no license or consent to use the MEDIASET Marks, as it is not the owner of any registered trademark or common law rights containing the term "Mediaset" or any permutations thereof, as it is not commonly known by the disputed domain name and as "Mediaset" is not the Respondent's name or nickname.
- (3) the disputed domain name was registered and is being used in bad faith, as the disputed domain name is inactive, as the Respondent's identity is concealed by a privacy service, and as the MEDIASET Marks have a strong reputation.

B. Respondent

The Respondent denies most of the Complainant's contentions and asserts that it has own rights or legitimate interests in respect of the disputed domain name. It states that the Complainant failed to renew the disputed domain name and that it was obtained through an auction. The Respondent further argues that, under the UDRP, absent proof of bad faith registration, a party may register a domain name that a party fails

to renew, and that settled trademark law supports a “common sense” approach to the treatment, use, and protection of descriptive common word terms such as “media set”. The Respondent states that where a domain name is made up of a common term composed of English words, and is subject to third party use, a party that registers and uses a domain name in good faith and without intent to target the trademark holder is entitled to keep the domain name. It states that before acquiring the disputed domain name, the Respondent’s business plan was to sell “media sets” and utilize the disputed domain name to capitalize on its inherent value as a generic or descriptive common term, which refers to “backup media of complete operating systems”, but that it was unable to execute his business plan because Didier Madiba was diagnosed with cancer. It states that it is not attempting to compete with the Complainant, disrupt its business, or prey on its mark in any way.

The Respondent further states that it had sought to acquire the disputed domain name before the Complainant even owned the domain and that the Complainant has set forth no evidence demonstrating that the Respondent registered it for any other reason. Finally, the Respondent states that it is well-established under the Policy that the use and registration of descriptive term domain names is an extremely common and permissible business practice because of the inherent value of the common word domain names.

6. Discussion and Findings

The first point to be dealt with is the admissibility of the parties’ supplemental submissions, which refer to court proceedings in Rome, Italy, initiated by the Complainant against the Respondent. The Rules do not allow the parties to file supplemental submissions on their own volition, and paragraph 12 of the Rules provides that a panel may in its sole discretion request further statements or documents from either of the parties. Thus, no party has the right to insist upon the admission of additional arguments or evidence.

The Complainant itself states that the supplemental submission was for information purposes only. As the Complainant’s actions in Italy do not have any influence on the present proceedings under the UDRP, the Panel elects not to accept the Complainant’s supplemental submission, which, by the way, was submitted in Italian language only, and has not relied on it in reaching this decision. As a consequence, the Panel has not considered the Respondent’s supplemental submission, a reply to the Complainant’s supplemental submission, either.

Under paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

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

A. Identical or Confusingly Similar

The disputed domain name fully incorporates the Complainant’s MEDIASET Marks and is identical to such marks. It is well established that the specific top level domain name is generally not an element of distinctiveness that can be taken into consideration when evaluating the identity or confusing similarity between the complainant’s trademark and the disputed domain name (cf. *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525; *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. D2000-0429; *Phenomedia AG v. Meta Verzeichnis Com*, WIPO Case No. D2001-0374).

Therefore, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

In the light of the Panel's finding below (cf. 6.C.) it is not necessary for the Panel to come to a decision in this regard.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which are evidence of the registration and use of the domain name in bad faith for purposes of paragraph 4(a)(iii) of the Policy, i.e.:

- (i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the Respondent has registered the disputed domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on its website or location.

In the present case, the Respondent had monitored the disputed domain name for years and must have been aware that the domain name was registered in the name of the Complainant before it was acquired by the Respondent in 2011. Furthermore, the evidence before the Panel shows that the Respondent's legal representative, Didier Madiba, indicated an address in Italy (where the Complainant is undisputedly well established) for service purposes when filing a European Community trademark application and when registering another domain name. However, in the light of the Panel's finding below re bad faith use, it is not necessary for the Panel to come to a decision in this regard either.

With regard to the bad faith use element, having carefully considered the facts contained in the case file, the Panel finds that the Complainant failed to meet its burden of proof. It is well established that general allegations or mere assertions of bad faith without supporting facts or specific examples do not supply a sufficient basis upon which a panel may conclude that a respondent acted in bad faith.

According to the Complainant, the Respondent's bad faith is supposed to result from the facts that the disputed domain name is inactive, that the Respondent's identity is concealed by a privacy service, and that the MEDIASET Marks have a strong reputation. The Complainant also cites a few precedents, without, however, explaining why the Panel should rely on them.

In turn, the Respondent argues that the term "media set" is merely generic, providing evidence of use of the term by third parties, *inter alia* IBM, Apple, HP and Microsoft, and states that it registered the disputed domain name in order to sell "media sets" and utilize the disputed domain name to capitalize on its inherent value as a generic or descriptive common term. It further states that it was unable to execute its business plan because Didier Madiba was diagnosed with cancer.

In the view of the Panel, the Complainant's arguments are not sufficient to infer bad faith use. The Respondent's identity was disclosed by the registrar upon receipt of the Complaint and thus already disclosed when the Complaint was amended. Furthermore, the use of privacy services in general is not to


be objected. Only if a respondent uses a privacy service primarily in order to hinder legal proceedings, this may be an additional argument supporting bad faith behavior. Finally, the fact that the disputed domain name is inactive is, by itself, not sufficient to prove bad faith use either. The Panel is well aware that it is consensus view that the lack of an active use of a disputed domain name does not as such prevent a finding of bad faith. In such cases, the panel must examine all the circumstances of the case to determine whether a respondent is acting in bad faith. Examples of circumstances that can indicate bad faith include a complainant having a well-known trademark, no response to the complaint, concealment of identity and the impossibility of conceiving a good faith use of the domain name (cf. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, *Jupiters Limited v. Aaron Hall*, WIPO Case No. D2000-0574, *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. D2002-0131). In the present case, there are, however, various possibilities to use the disputed domain name in good faith in connection with its generic meaning. Even if future users landed on an active website of the Respondent, there would be no unfair advantage over the Complainant, as long as the Respondent uses the disputed domain name *bona fide* in connection with its generic meaning. However, should the Respondent start to use the disputed domain name in bad faith, this may constitute a material new development pursuant to which the Complainant could well have the possibility to re-file a new complaint under the Policy (if applicable principles on re-filed complaints and relevant previous panel decisions contained, for example, in paragraph 4.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0").)

Consequently, the Panel concludes that the third element of the Policy has not been met on the present record in these Policy proceedings and that the Complaint must be denied.

7. Decision

For all the foregoing reasons, the Complaint is denied.


Brigitte Joppich
Presiding Panelist


Fabio Angelini
Panelist


The Hon Neil Brown QC
Panelist
Dated: February 4, 2012