



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

MacNeil Lehrer Productions, Inc. v. Swallowlane Holdings, Ltd.

Case No. D2009-1465

1. The Parties

The Complainant is MacNeil Lehrer Productions, Inc. of Arlington, Virginia, United States of America, represented by Looper Reed & McGraw, United States of America.

The Respondent is Swallowlane Holdings, Ltd. of Road Town, British Virgin Islands, Overseas Territory of the United Kingdom of Great Britain and Northern Ireland.

2. The Domain Name and Registrar

The disputed Domain Name <pbsnewshour.org> is registered with Above.com, Inc.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 29, 2009. On October 30, 2009, the Center transmitted by email to Above.com, Inc. a request for registrar verification in connection with the disputed Domain Name. On November 2, 2009, Above.com, Inc. transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the 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 the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 9, 2009. In accordance with the Rules, paragraph 5(a), the due date for Response was November 29, 2009. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 30, 2009.

The Center appointed J. Christopher Thomas Q.C. as the sole panelist in this matter on

December 4, 2009. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

MacNeil Lehrer Productions, Inc (described by the acronym “MLP” in the Complaint and in this Decision) was founded in 1981 by newsmen Robert MacNeil and Jim Lehrer as a company related to their nightly Public Broadcasting Service (“PBS”) news broadcast, The MacNeil/Lehrer Report, which was broadcast on public television in the United States. Since the program has been broadcast from its inception on PBS, it has been identified by the public and the media since at least 1983 as “The PBS NewsHour.”

In May 2009, MLP announced that the program’s name would change to “PBS NewsHour”. A copy of the press release announcing the change was submitted with the Complaint.

The PBS NewsHour is broadcast by more than 300 PBS stations, reaching 98 percent of the United States’ television households, according to A.C. Nielsen. The program is also carried in Asia, Europe, Latin America and Africa and in the Middle East. The Erdos & Morgan Opinion Leader survey ranks The PBS NewsHour first among all television news programs in terms of credibility, objectivity, influence and currency. The program has won many awards. The PBS NewsHour’s web portal, The Online NewsHour, is the most visited of the more than 400 destinations on the PBS web site.

MLP’s rights in “PBS NewsHour” are demonstrated both by United States trademark registrations and MLP’s common law usage of the name for over 25 years. MLP first applied to register the mark THE NEWSHOUR WITH JIM LEHRER on May 8, 2000, and was granted Registration No. 2529284 on October 23, 2001. MLP has obtained subsequent registrations for THE NEWSHOUR WITH JIM LEHRER, under Registration No. 3401051, filed June 6, 2007, and THE ONLINE NEWSHOUR, under Registration No. 3497835, filed June 5, 2007.

MLP’s registration and actual use of NEWSHOUR as part of its brand name predate the Respondent’s registration of the disputed Domain Name by many years.

The mark PBS is registered in the United States Trademark Office in the name of Public Broadcasting Service, including Registration No. 2707600, filed on October 23, 2000, based on use of the mark in commerce since 1971. These dates are prior to the registration of the disputed Domain Name by the Respondent. By virtue of a contractual relationship between MLP and PBS, MLP is entitled to use the PBS mark as part of the program name “PBS NewsHour” and in the advertising and promotion of MLP’s services under the name “PBS NewsHour,” including as part of a top level Domain Name comprising “pbsnewshour.”

Separate and apart from trademark registrations, the name “PBS NewsHour” has been used to identify MLP’s services for decades. “The PBS NewsHour” incorporates both the network that carries the program and the name that has been part of the show for the last 26 years. In the Complainant’s view, outside of MLP’s program, “The PBS NewsHour” has no other use or meaning. Evidence was submitted on numerous references to the name “PBS NewsHour” in various media and in common parlance.

MLP does not know the actual identity of the Respondent other than a reference to Swallowlane Holdings, Ltd.

The disputed Domain Name <pbsnewshour.org> appears to be a parked page with the title “what you need, when you need it” providing the Respondent revenue each time one of its links is clicked through. Sometimes the links refer to television issues generally and other times they appear to refer to efforts to sell insurance or other non-related products. The page usually contains a tabbed link with the name “pbsnewshour” on the top right which, when clicked, redirects the consumer back to the main page with a new list of possible links.

A printout of the main page of the website “www.pbsnewshour.org”, as it appeared on October 21, 2009, was attached to the Complaint.

5. Parties’ Contentions

A. Complainant

In the Complainant’s view, the disputed Domain Name is identical or confusingly similar to a trademark or service mark in which MLP has rights. The components of the Domain Name “PBS NewsHour” were registered in the USPTO prior to the Respondent’s registration of the disputed Domain Name. MLP owns one Registered component and is licensed to use the other.

It is acknowledged that the disputed Domain Name is not exactly the same as MLP’s registered marks. Adding an additional distinctive phrase, such as PBS preceding NewsHour, does not dissipate MLP’s rights: “A Domain Name is ‘identical or confusingly similar’ to a trademark...when the Domain Name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the Domain Name.” *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662. Furthermore, it is observed that MLP has the right to use the PBS name and the Respondent does not.

Likewise, in the Complainant’s view, the fact that the Domain Name includes only a part of MLP’s registered marks (i.e., “Newshour” and not “Lehrer” or “Online”) does not affect its rights. Reference is made to *Levantur, S.A. v. Joe Fox, Fox Media Services*, WIPO Case No. D2008-0776. In that case, the complainant registered the mark “BAHIA PRINCIPE Clubs & Resorts.” The challenged domain name was <bahiaprincipe.org> which included only part of the complainant’s registered marks. The panel determined the important part of the complainant’s mark was the part being used by the respondent as shown by the complainant’s use of the shortened term. In the same fashion, MLP has consistently used the term “NewsHour” through usage and its other Domain Names – <pbsnewshour.com> and <newshour.org>.

Even though the exact phrase “PBS NewsHour” is not the subject of a singular registration, the Complainant argues that it has served as a common law mark for MLP’s services for many years. It points to UDRP cases that have examined claims to unregistered or unexamined marks as the basis for a UDRP complaint. Successful complainants need not have a trademark registration to assert valid trademark rights in a UDRP proceeding so long as there is a sufficient showing of common law rights in the subject mark. In this regard, under U.S. law rights in a trademark or service mark may be established by extensive or continuous use sufficient to identify particular goods or services as those of the trademark owner.

Turning to the first of the three elements that must be proved under the Policy, in MLP's submission the disputed Domain Name is confusingly similar to its own mark. Since the Domain Name is exactly the same as the mark (minus the .org which is not considered in UDRP analysis the confusion is obvious. The Domain Name incorporates the Complainant's mark in its entirety and in the Complainant's view, a viewer, knowing the program is broadcast on public television, is likely going to enter "www.PBSNewsHour.org" as a likely candidate for the Domain Name of the show. Without the program's prominence, the Domain Name is meaningless and of no value.

Given the repeated, extensive and continuous use in the past, present and planned use in the future of PBSNewsHour and the NewsHour in connection with the program and accompanying website, the viewing public has come to associate these names with MLP's products long before the Respondent registered the disputed Domain Name.

Turning to the second element, the Complainant asserts that, the Respondent lacks rights or legitimate interests in the disputed Domain Name, because the Respondent has never been commonly known by the Domain Name, has not been authorized to use MLP's PBSNewsHour name and mark, and has no connection whatsoever with MLP.

Other than MLP's program, there would be no point in registering the Domain Name. While it appears to be generally accepted that the use of a domain name to generate paid advertising revenues is not a *per se* violation of the Policy, in the absence of any intent to exploit and profit from another's trademark, in the Complainant's view the record in this case reflects no apparent reason for such use by the Respondent here other than to exploit and profit from MLP's mark through the creation of initial interest confusion.

In light of the foregoing, the Complainant asserts that the Respondent registered and is using the disputed Domain Name in bad faith for commercial gain and to profit from resulting consumer confusion. The Respondent could only have registered a Domain Name confusingly similar to MLP's PBSNewsHour name and mark to capitalize on the goodwill developed therein. The Respondent is using the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with MLP'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. Pursuant to the section 4(b)(iv) of the Policy, such use is evidence of bad faith.

The Complainant notes that this is not the first time the Respondent has engaged in such conduct or been a party to UDRP proceedings, referring to this regard to *Canadian Tire Corporation Limited v. Swallowlane Holdings Ltd.*, WIPO Case No. D2009-0828, where the Respondent was cyberflying to attract visitors to its parked page in bad faith. The National Arbitration Forum has also made similar findings against the Respondent in *Aeropostale, Inc. v. Swallowlane Holdings, Ltd c/o Hostmaster*, NAF Claim No. FA1271289 (citing the intentional effort to redirect traffic to its parked page based on a misspelling of another's famous mark).

The Complainant notes that an Internet search indicates the Respondent owns thousands of domain names. The circumstances in the record dispel any doubt that the Respondent was aware of the PBS Newshour prior to registering the disputed Domain Name. In the Complainant's view, it is a reasonable inference from the overall circumstances in the record that the Respondent knew or would have known of MLP's rights when registering the disputed Domain Name.

The Respondent lacks any connection to MLP, and has used the disputed Domain Name, which incorporates the MLP's mark, solely for the purpose of driving Internet traffic to a portal pay-per-click website. In the circumstances the Complainant argues, the Panel can ascribe no apparent motive for the Respondent's opportunistic registration and use of this confusingly similar Domain Name except to capitalize or otherwise take advantage of MLP's rights.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

The Panel has reviewed the Complaint and the documents annexed thereto. In the light of those materials the Panel finds that the Complainant has made out its case.

A. Identical or Confusingly Similar

The Domain Name <pbsnewshour.org>, incorporating as it does the "NewsHour" mark, is confusingly similar to the Complainant's registered trademarks. The addition of "PBS", which the PBS has authorized the Complainant to use, in fact compounds the matter in that while "NewsHour" in and of itself would tend to confuse an Internet user, its linking together with "PBS" makes it even more likely to mislead. The fact that the disputed Domain Name includes only a part of MLP's registered marks (i.e., "Newshour" and not "Lehrer" or "Online") does not affect its rights. An important part of the Complainant's mark is the part being used by the Respondent. The evidence is that MLP has consistently used the term "NewsHour" through usage and its other Domain Names – <pbsnewshour.com> and <newshour.org>.

B. Rights or Legitimate Interests

The disputed Domain Name <pbsnewshour.org> appears to refer to the presence on the Internet of MacNeil Lehrer Productions, Inc. under its trademark "NewsHour", or suggests the existence of a legal or economic relationship between the Respondent and the Complainant. The Complainant has led un-rebutted evidence to show that no such relationship exists.

The Panel is satisfied that the Respondent does not hold any rights or legitimate interests in the Domain Name in dispute.

C. Registered and Used in Bad Faith

There is also no doubt that the Domain Name has been registered and is being used in bad faith. The name is being used to attract, for commercial reasons, Internet users searching for a legitimate PBS "NewsHour" web site to a web site that generates click through revenues. The only connection the Respondent has to the Complainant is an illicit intention to exploit its intellectual property rights. This constitutes use in bad faith within the meaning of the Policy.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15

of the Rules, the Panel orders that the Domain Name <pbsnewshour.org> be transferred to the Complainant.

J. Christopher Thomas Q.C.
Sole Panelist

Dated: December 9, 2009