

Decision for dispute CAC-UDRP-104405

Case number CAC-UDRP-104405

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Domain names faktytvn.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization TVN S.A.

Complainant representative

Organization WKB Wierciński, Kwieciński, Baehr sp. k.

Respondent

Name Robert Jałocha

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant – TVN S.A. – is one of the leading broadcasters in Poland, a part of Discovery, Inc. The Complainant provides its broadcast also abroad – among other via iTVN TV channel, that is available in USA, EU, UK and Australia. TVN S.A. is the owner of the registered Polish national trademark "Fakty TVN" (Reg. No. 198799), a combined word and figurative mark with priority date of 10.07.2004, registered for goods and services in classes 3, 9, 16, 25, 28, 35, 38, 41, 42 of the Nice Classification. This trademark was in use by the Complainant since its registration in 2004. "Fakty TVN" is a name of a nation-wide news programme and a website serving content produced by the Complainant. The news programme is being broadcasted by the Complainant in the linear terrestrial and satellite technology since 1997 as well as online since 2007 (originally in a domain name <fakty.tvn.pl>). The Complainant also runs a website under the domain name <fakty.tvn24.pl>, where the Complainant broadcasts the news in both audiovisual and written form. The brand "Fakty TVN" benefits from a widespread recognition in Poland and appreciation of the audience in respect to the delivered services. A study conducted by the media business portal wirtualnemedi.pl showed that in 2021 "Fakty TVN" was watched by an average of 2.64 million viewers.

The disputed domain name <faktytvn.com> was registered by the Respondent on 23 February 2020. The Respondent is a

former employee of the Complainant and currently there is a dispute between them (N.B. it is not related to the disputed domain name). The disputed domain name incorporates the Complainant's trademark "Fakty TVN" (Reg. No. 198799) in its entirety. The generic Top-Level Domain ("gTLD"), which in this case is ".com" is a technical requirement for domain name registrations and not relevant to the issue of the identity or confusing similarity between the disputed domain name and the Complainant's trade mark.

The Complainant underlined that the Respondent is not sponsored by or affiliated with Complainant in any way. Complainant has not licensed, authorized, or permitted Respondent to use Complainant's trademarks in any manner, including in domain names.

The Respondent is planning to use the disputed domain name, which is identical to Complainant's trademark, to post information of a negative nature regarding Complainant and its business practices. This is indicated by the information posted on the website available under the disputed domain name: "The whole truth about working at TVN and Fakty's editorial office coming soon at FaktyTVN.com" (in Polish: Cała prawda o pracy w TVN i redakcji Faktów już wkrótce na FaktyTVN.com).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Complainant filed the Complaint in English rather than in Polish (i.e. the language of the registration agreement). Pursuant to paragraph 11(a) of the Rules, unless otherwise agreed by the parties, or otherwise specified in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. Paragraph 10(b) and (c) of the Rules requires the Panel to ensure that the proceeding takes place with due expedition and that the parties are treated fairly and given a fair opportunity to present their respective cases.

The Complainant filed its Complaint in English and then requested that English be the language of the proceeding.

The Complainant noted the following factors supporting English as the fair language of the proceeding:

- (a) The Complainant is a part of the global media company Discovery Inc. with headquarters in New York, USA, and the Respondent is an English-speaking person;
- (b) Pursuant to the gTLD domain registration agreement with NetArt Registrar Sp. z o.o. (located at: <https://www.netart-registrar.com/>) any disputes arising from infringement of third parties' rights shall be settled amicably in accordance with the UDRP and RDRP documents adopted by ICANN. The language version of the documents binding on the subscriber shall be the original version of the documents, i.e. English (as required by ICANN).;
- (c) The Respondent of the disputed domain name has sufficient knowledge of the English language (has a competency in English). The Respondent is a former reporter/journalist of TVN broadcaster. Respondent's work consisted of conducting interviews, and other press materials for which the Respondent used English language. English competency is nowadays basically essential for the journalist's task.
- d) the Respondent participated in voluntary work abroad (<https://eks.org.pl/>)
- e) the Complainant has already incurred significant expenses in preparing the English translation of the proofs. English is also one of the most popular/most widely used languages in the world and English is the official language of the arbitral

tribunal. Thus, there are no contraindications to conducting proceedings in English.

The Panel also admits additional important factors in favour of the Complainant's option of English language for this proceeding:

- (a) the CAC has notified the Respondent of the proceeding solely in English;
- (b) thus, the Respondent has been given the opportunity to present its case in this proceeding and to respond formally to the issue of the language of the proceeding;
- (c) however, the Respondent has not responded to the Complainant's request for a change of the language from Polish to English;
- d) in his non-standard communication the Respondent is not complaining anyhow about the language of the proceedings.

Considering the above circumstances, the Panel finds that the choice of English as the language of the present proceeding is fair to both parties and is not prejudicial to either one of the parties in his or her ability to articulate the arguments for this case.

The Panel has also taken into consideration the fact that insisting the Complaint and all supporting documents to be re-filed in Polish would cause an unnecessary burden of cost to the Complainant and would unnecessarily delay the proceeding. Having considered all the above matters, the Panel determines under paragraph 11(a) of the Rules that (i) it will accept the Complaint and all supporting materials as filed in English; and (ii) English will be the language of the proceeding and the decision will be rendered in English.

In view of all of the above, The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. The Panel agrees with the Complainant that the disputed domain name is identical to the Complainant's trademark "Fakty TVN".
2. The Panel acknowledges that the Complainant presented prima facie evidence that the Respondent is not sponsored by or affiliated with Complainant in any way. The Respondent's name and surname does not resemble the disputed domain name in any manner. The fact that the Respondent was an employee of the Complainant does not create any license, authorization or permission for the Respondent to use Complainant's trademark in any manner, including in domain names.
3. As no administratively compliant response has been provided to the Panel and the prima facie evidence was not challenged by the Respondent, the Panel concludes that the Respondent meant Complainant's trademark „Fakty TVN“ when he registered the disputed domain name <faktytvn.com>. The fact that the Respondent was an employee of the Complainant evidences he knew or should have known that the brand „Fakty TVN“ is the trademark of the Complainant. Respondent's use of the disputed domain name does not constitute a bona fide offering of goods or services or a legitimate non-commercial or fair use. The Respondent might have intended to use this domain name to criticize the business of the Complainant or even reveal negative facts about the Complainant based on his working experience. Indeed, UDRP jurisprudence recognizes the use of a domain name as non-commercial free speech, however, such use may be regarded as legitimate non-commercial and fair use only if it meets certain criteria. First, and the most important, such use should not create an impermissible risk of user confusion through impersonation. As the WIPO Overview 3.0 makes clear, in assessing whether a registrant has a right or legitimate interest in a domain name used for a criticism website, it is critical to assess whether the domain name communicates that the website at issue is a criticism site, or whether the domain name instead impersonates Complainant and purports to be the Complainant's own site. In Joseph Dello Russo M.D. v. Michelle Guillaumi (WIPO Case No. D2006-1627), a UDRP case involving criticism websites, the panel found that respondent had no legitimate interest in the domain name <dellorusso.info> because it would cause confusion and would mislead consumers into believing the website was from, or sponsored by, complainant. However, the panel found that respondent did have a legitimate interest in the domain name <dellorussosucks.com> because that name is expressive and made clear on its face that it referred to a criticism website. Therefore, the Panel agrees with the Complainant that the disputed domain name <faktytvn.com> may mislead Internet users into believing that this website is associated with the Complainant and/or will resolve to the official website of the Complainant. The disputed domain name is identical to Complainant's trade mark and it does not include any

additional word or term that may identify as resolving to a criticism website. As a result, the Respondent is using the disputed domain name to falsely convey an association with the Complainant in order to divert internet users to the website. The gTLD <.com> suggests also that under the disputed domain name the user can access the international version of the domestic website provided by the Complainant, which is obviously misleading. In conclusion, the Respondent has registered and used the disputed domain name in bad faith as provided in paragraph 4(b)(iv) of the Policy.

4. The Panel also agrees with the Complainant's contention that Respondent's conduct also violates paragraph 4(b)(iii) of the Policy, which deems it bad faith if a respondent registers a "domain name primarily for the purpose of disrupting the business of a competitor". The business of the Complainant is the news agency, which stands for collection and dissemination of information, dissemination of information through information networks, etc. The Respondent, who is a journalist, is planning to use the disputed domain name to post information of a negative nature regarding Complainant and its business practices. Thus, the Respondent is acting as a direct "competitor" at least with respect to collection and dissemination of information, dissemination of information through information networks. Therefore, the Panel is of the view that such conduct (intended posting of information of a negative nature regarding Complainant and its business practices) by a journalist with respect to the news agency shall be regarded as having "the purpose of disrupting the business of a competitor" and this leads to the conclusion that the disputed domain name was registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. FAKTYTVN.COM: Transferred

PANELLISTS

Name	dr. Darius Sauliūnas
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DATE OF PANEL DECISION 2022-05-18

Publish the Decision
