



# WIPO Arbitration and Mediation Center

## ADMINISTRATIVE PANEL DECISION

### Infinity Broadcasting Corporation v. Joey Boots Productions

Case No. D2001-0228

#### 1. The Parties

The Complainant is Infinity Broadcasting Corporation, a Delaware corporation with its principal place of business at 40 West 57th Street, New York, NY 10019, USA.

The Respondent is Joey Boots Productions, with an address of P.O. Box 1465, Massapequa, New York 11758, USA.

#### 2. The Domain Name and Registrar

The dispute concerns the domain name: <opieandanthony.com>, hereinafter the Disputed Domain Name. The Registrar with which this Domain Name is registered is Network Solutions, Inc. with a business address at 505 Huntmar Park Drive, Herndon, Virginia 20170, USA.

#### 3. Procedural History

On February 12, 2001, and February 15, 2001, respectively, the World Intellectual Property Organization

Arbitration and Mediation Center (the WIPO Center) received a Complaint electronically and by hard copy for a decision in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy), 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).

On February 16, 2001, the WIPO Center sent a Request for Registrar Verification to the Registrar. On February 21, 2001, the Registrar confirmed to the WIPO Center that it was the Registrar of the said Domain Names and that the current registrant of the said Domain Names was the Respondent.

On February 27, 2001, having found that the Complainant had satisfied the formal requirements of the Policy, the Rules, and the Supplemental Rules, the WIPO Center sent the Notification of Complaint and Commencement of Administrative Proceeding (the Notification) by post/courier, and e-mail to the Respondent and transmitted electronically copies of said documents to the Complainant, ICANN, and the Registrar. The said Notification particularized the formal date of the commencement of this administrative proceeding as February 27, 2001, and required the Respondent to submit a Response to the Complaint within 20 calendar days from the date of receipt of the Notification, failing which the Respondent would be considered to be in default.

On March 7, 2001, the time to file a Response was extended by the WIPO Center for five (5) days to March 23, 2001. The Respondent failed to file the Response with the WIPO Center by the last date. On March 26, 2001, the WIPO Center sent a Notification of Respondent Default to the Respondent by e-mail and copied the Complainant via e-mail. The Complainant elected to have the dispute decided by a single-member panel (the Panel). On April 18, 2001, the WIPO Center appointed Mr. Terrell C. Birch to be the panelist after receiving a Statement of Acceptance and Declaration of Impartiality and Independence from him and sent a Notification of Appointment of Administrative Panel and Projected Decision Date to the Complainant and the Respondent and copied it to the Panel by e-mail. On the same day, the WIPO Center sent a Transmission of Case File to the Panel.

The Panel finds that the WIPO Center has discharged its obligations and responsibility under the Rules. The Panel will hereby issue its Decision based on the Complaint, the Policy, the Rules, and the Supplemental Rules, without the benefit of any Response from the Respondent.

#### **4. Factual Background**

Complainant is a well-known radio broadcasting company, which owns and operates radio stations throughout the USA, including WNEW-FM ("WNEW"), a radio station located in New York, New York that broadcasts to the New York City metropolitan area.

Among the most highly-rated and popular radio programs produced and broadcast by WNEW is OPIE AND ANTHONY, a talk radio program that airs on weekday afternoons (*i.e.*, during the "afternoon drive" shift). The on-air hosts of OPIE AND ANTHONY are Complainant's employees Greg Hughes (a/k/a Opie) and Anthony Cumia (a/k/a Anthony).

Complainant has spent a substantial sum of money advertising and promoting its radio broadcasting services under the OPIE AND ANTHONY mark, which has resulted in the creation of a great deal of goodwill and popularity for the mark. Complainant's advertising and promotional efforts have included, among other things, radio advertisements and promotions, as well as the use of promotional merchandise, such as T-shirts, hats and

bumper stickers, that display the OPIE AND ANTHONY mark.

Complainant also promotes OPIE AND ANTHONY through its website, located at <www.WNEW.com>, which devotes an entire section of the site to OPIE AND ANTHONY. Through the website, consumers can purchase a copy of the OPIE AND ANTHONY album entitled "Opie and Anthony's Demented World."

Over the years, Complainant's OPIE AND ANTHONY program has received widespread unsolicited media coverage, including hundreds of news reports published in newspapers and trade magazines, including *Crain's New York Business*, the *New York Daily News*, *M Street Daily* and the World Wide Wrestling Foundation magazine *Raw*. These news reports reflect that the ratings for OPIE AND ANTHONY have steadily increased over time, and that OPIE AND ANTHONY is now a leader in its afternoon drive time slot.

At Complainant's direction, its employees (including, but not limited to, Hughes and Cumia) have made countless live personal appearances to advertise and promote OPIE AND ANTHONY.

In November 2000, Complainant's OPIE AND ANTHONY show also received an award for Air Personality of the Year in the "alternative/rock" category at the 2000 Radio Music Awards held in Las Vegas, Nevada.

As a result of Complainant's use of the OPIE AND ANTHONY mark, its advertising and promotional efforts and expenditures in connection with the mark, and the wide recognition achieved for the mark, the public has come to associate the OPIE AND ANTHONY mark with services originating with, emanating from, sponsored by or otherwise associated with or approved by Complainant. In addition, the OPIE AND ANTHONY mark also has become distinctive, and is an extremely valuable symbol of Complainant with substantial commercial magnetism.

Complainant is the owner of all copyrights in the OPIE AND ANTHONY show. Complainant also owns common law trademark rights in the name and mark OPIE AND ANTHONY.

On April 26, 2000, Respondent registered the domain name <opieandanthony.com>.

Respondent has never been authorized by Complainant or anyone acting on its behalf to use the OPIE AND ANTHONY mark. On its site, Respondent not only uses the OPIE AND ANTHONY mark without permission, but also has unlawfully utilized Complainant's registered WNEW trademark. Moreover, Respondent also has displayed photographs from OPIE AND ANTHONY on its website without permission in violation of applicable copyright laws.

On or about September 26, 2000, Complainant sent a cease and desist letter to Respondent, demanding that it transfer the <opieandanthony.com> domain name to Complainant. Complainant received no response to this letter.

Respondent has no rights or legitimate interest in the trademark OPIE AND ANTHONY or the disputed domain name. Respondent is not commonly known by the name OPIE AND ANTHONY or <opieandanthony.com>, and has never been authorized by Complainant to use the name or mark.

After receiving Complainant's cease and desist letter, Respondent, for a time, redirected visitors to its site to <www.hankthedwarf.com>", a sexually explicit website. Respondent also added a disclaimer to the site which stated that: "This site is not affiliated with Opie and Anthony, CBS Broadcasting, Infinity Broadcasting,

Westinghouse Communications, or any company or persons affiliated with them." .

## 5. Parties' Contentions

### A. Complainant

Essentially, the contentions of the Complainant are as follows:

- 1) Complainant has valid and subsisting rights in its OPIE AND ANTHONY trademark/service mark.
- 2) Respondent has no rights or legitimate interests to the Disputed Domain Name.
- 3) The Disputed Domain Name was registered and is being used in bad faith.

### B. Respondent

In view of the fact that the Respondent has not filed a Response, the Panel is in no position to make out its contentions.

## 6. Discussion and Findings

### 6.1 Effect of Respondent's Default

By paragraph 5(b)(i) of the Rules, it is expected of the Respondent to:

"[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name..."

In the event of a default, under paragraph (14)(b) of the Rules:

"...the Panel shall draw such inferences therefrom as it considers appropriate."

As stated by the panel in *Mary-Lynn Mondich and American Vintage Wine Biscuits, Inc. v. Shane Brown, doing business as Big Daddy's Antiques* [WIPO Case No. D2000-0004](#) :

"Respondent's failure to present any such evidence or to deny complainant's allegations allows an inference that the evidence would not have been favorable to respondent."

In the instant administrative proceeding, the Respondent's default entitles the Panel to conclude that the Respondent has no evidence to rebut the assertions of the Complainant.

## 6.2 Elements to be proven

However, paragraph 4(a) of the Policy envisages that for the Complaint to succeed, the Complainant must establish that:

- i) the Respondent's Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights; and
- ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- iii) the Respondent's Domain Name has been registered and is being used in bad faith.

The Panel in *Cortefiel, S.A. v. Miguel Garcia Quintas* [WIPO Case No. D2000-0140](#) notes that under the Policy, even if the respondent is in default,

"...the complainant must prove that each of these three elements are present."

## 6.3 Identical or Confusingly Similar

The Complainant claims and has established first use and ownership of the OPIE AND ANTHONY marks. It has also shown substantial use. Ownership of these marks is clearly proved by the Complainant. Under the Policy, all that is required of the Complainant is to establish its rights in the marks, and the extent of the geographical area in which the rights accrue does not matter. The Panel has compared the Disputed Domain Name with the Complainant's marks and finds that the second level domains thereof are substantially identical to the Complainant's marks. The Panel finds that there is such similarity in sound, appearance, and connotation between the Complainant's marks and the Disputed Domain Name as to render said Disputed Domain Name confusingly similar to Complainant's OPIE AND ANTHONY marks.

## 6.4 Respondent's Rights or Legitimate Interests in the Disputed Domain Name(s)

Under paragraph 4(c) of the Policy, the Respondent may demonstrate its rights and interests in the said Disputed Domain Name(s) by showing:

- i) its use of, or demonstrable preparations to use, the said Disputed Domain Name(s) or a name corresponding to the said Disputed Domain Name(s) in connection with a bona fide offering of goods or services before any notice to him of the dispute; or
- ii) he (as an individual, business, or other organization) has been commonly known by the said Disputed Domain Name(s), even if he has acquired no trademark or service mark rights; or
- iii) he is making a legitimate noncommercial or fair use of the said Disputed Domain Name(s), without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

There is no evidence presented by Respondent in demonstrating any of the foregoing factors because Respondent is in default and has failed to respond in this action. Accordingly, the evidence available contains

nothing that may justify a legitimate noncommercial or fair use of the said Disputed Domain Name(s) by Respondent. Neither is there any evidence for any of the other two foregoing requirements.

Furthermore, in the absence of any license or permission from Complainant to use its marks or to apply for or use any domain name incorporating those marks, it is clear that no actual or contemplated bona fide or legitimate use of the contested domain names could be claimed by Respondent. *Guerlain S.A. v. Peikang*, [WIPO Case No. D2000-0055](#).

## 6.5 Registration and Use in Bad Faith

As stated by the panel in *World Wrestling Federation Entertainment, Inc. v. Michael Bosman*, [WIPO Case No. D1999-0001](#) in order for the Complainant to succeed:

"... the name must not only be registered in bad faith, but it must also be used in bad faith."

The Complainant must prove that the Respondent registered and also used the said Disputed Domain Name in bad faith in order to establish 'bad faith' on the part of the Respondent.

Respondent registered the <opieandanthony.com> domain name in bad faith, for the purpose of attracting Internet users to its website who were seeking either Complainant or its authorized OPIE AND ANTHONY site. By using <opieandanthony.com> to divert individuals looking for Complainant or its OPIE AND ANTHONY site to Respondent's website, Respondent improperly benefits from the goodwill that Complainant has developed in its OPIE AND ANTHONY mark. See, e.g., *Brookfield Comm. Inc. v. West Coast Entertainment Group*, 174 F.3d 1036 (9th Cir. 1999) (finding initial interest confusion in use of trademarks). See also *Gilmour v. Ermanno Cenicolla*, [WIPO Case No. D2000-1459](#) (finding "bad faith registration" where respondent registered the disputed domain name (<davidgilmour.com>) to trade off the name and reputation of recording artist David Gilmour, "by creating a false association between the domain name and the Complainant's trademark, so as to attract to the Respondent's site Internet users (being David Gilmour fans) seeking the first Complainant or his authorized site"); *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and <Madonna.com>*, [WIPO Case No. D2000-0847](#) (finding bad faith registration where domain name (<madonna.com>) was "selected and used by Respondent with the intent to attract for commercial gain Internet users to Respondent's website by trading on the fame of Complainant's mark").

While Respondent is free to express its opinion about Complainant or its OPIE AND ANTHONY show, Respondent cannot use the disputed domain name to confuse Internet users about the sponsorship of the website or to attract people to its cause through confusion. As the Panel held in *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and <Madonna.com>*, [WIPO Case No. D2000-0847](#), "[u]se which intentionally trades on the fame of another cannot constitute a 'bona fide' offering of goods and services."

Directly on point is the Panel's decision in *Monty and Pat Roberts, Inc. v. Bill Keith*, [WIPO Case No. D2000-0299](#). In that case, the respondent registered the domain name <montyroberts.net>, predominantly for the purpose of offering a website that contained information about Monty Roberts, a well-known horse trainer. The Panel rejected the respondent's argument that it was making legitimate use of the website solely to disseminate information about Monty Roberts, and ordered that the name be transferred to the complainant. In so holding, the Panel reasoned as follows:

[T]he right to express one's views is not the same as the right to use another's name to identify one's self as the

source of those views. One may be perfectly free to express his or her views about the quality or characteristics of the reporting of the *New York Times* or *Time Magazine*. That does not, however, translate into a right to identify one's self as the *New York Times* or *Time Magazine*.

In the instant case, Respondent is using as its identifier the domain name <montyroberts.net.>. When an Internet user searches for Complainant's mark, it will find Respondent's website address. There is nothing in the domain name to indicate that the site is devoted to criticism of Complainant, even though this criticism is apparent upon visiting Respondent's site. By using Complainant's mark, Respondent diverts Internet traffic to its own site, thereby potentially depriving Complainant of visits by Internet users.

The Panel's reasoning has subsequently been held to apply regardless of whether a website is devoted to praise or criticism of a particular performer or show. See *Gilmour v. Ermanno Cenicolla*, [WIPO Case No. D2000-1459](#) ("In this case one of the purposes for which the Respondent registered the disputed domain name was to provide a forum for David Gilmour fans, most of whom, one might think, would have favourable comment to make about the first Complainant and his artistic work. But whether the site be devoted to praise or to criticism, the reasoning in *Monty and Pat Roberts*, just quoted, is of equal application").

Respondent's use of a disclaimer on its website is insufficient to avoid a finding of bad faith. In fact, in *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and <Madonna.com>*, [WIPO Case No. D2000-0847](#), the Panel expressly rejected the respondent's argument that its use of a disclaimer on its site precluded a finding that the respondent intentionally sought to attract users to its site based on confusion with the complainant's mark. In so ruling, the Panel reasoned that:

First, the disclaimer may be ignored or misunderstood by Internet users. Second, a disclaimer does nothing to dispel initial interest confusion that is inevitable from Respondent's actions. Such confusion is a basis for finding a violation of Complainant's rights.

*Id.* (citing *Brookfield Communications Inc. v. West Coast Entertainment Corp.*, 174 F.3d. 1036 (9th Cir. 1999)). See also *The Chip Merchant, Inc. v. Blue Star Electronics*, [WIPO Case No. D2000-0474](#) (finding disclaimer to be "ineffective and disingenuous").

Based on the alleged facts, which have not been disputed, the Panel finds that the Respondent has engaged in the practices defined in Paragraph 4(b)(iv) of the Policy as evidencing the registration and use of the said Disputed Domain Name in bad faith.

## 7. Decision

For all the foregoing reasons and pursuant to the ICANN Rules, paragraph (15), the Panel finds that the Complainant has proved each of the three elements of paragraph 4(a) of the Policy. The Panel requires that the said Disputed Domain Name, namely, <opieandanthony.com>, be transferred to the Complainant pursuant to paragraph 4(i) of the Policy.

Terrell C. Birch  
Panelist

Dated: May 15, 2001