

ADMINISTRATIVE PANEL DECISION

Yleisradio Oy v. Danila Komarov

Case No. D2022-3843

1. The Parties

The Complainant is Yleisradio Oy, Finland, represented by Papula-Nevinpat, Finland.

The Respondent is Danila Komarov, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <yle-areena.com> is registered with Internet Domain Service BS Corp (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 13, 2022. On October 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 14, 2022, the Registrar 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 (Domain Admin, Whois Privacy Corp.) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 26, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 31, 2022.

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 the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 28, 2022.

The Center appointed Alistair Payne as the sole panelist in this matter on December 8, 2022. 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

The Complainant is Finland's national public broadcasting company and was founded in 1926. It is organized as a limited company almost fully owned by the Finnish state and operates four TV channels on three channel slots and six channels on the radio, and reaches 7 approximately 94% of Finns every week. The Complainant's operations are funded by a public broadcasting tax which is collected annually from private individuals and corporations together with their other taxes. In 2021, the Complainant's net turnover was EUR 499.9 million. Since 2007 the Complainant has provided a streaming service through which people in Finland can watch or hear live broadcasts or recordings. The service is launched more than 3 million times per day in a country with a population of 5.5 million and has been operated under the YLE AREENA mark since 2007. The Complainant owns EU trade mark registration No. 018344765 for YLE AREENA which was registered on April 14, 2021. The Complainant also owns various trade mark registrations for the YLE mark including European trade mark registration No 018141990 for YLE which was registered on February 27, 2020.

The disputed domain name was first registered on January 9, 2021 but according to the Whois record was "updated" on December 1, 2021. It resolves to a site that offers video streaming but which requires registration before the service will be provided.

5. Parties' Contentions

A. Complainant

The Complainant submits that it owns registered trade mark rights for its YLE and YLE AREENA marks as set out above. The Complainant submits that the disputed domain name fully incorporates its registered trade marks YLE or YLE AREENA, with the words "yle-arena" being separated by a hyphen and the suffix ".com" added. It says that the hyphen is a technical, non-distinctive element and cannot distinguish the disputed domain name from the Complainant's registered trade mark YLE AREENA and that the mere replacement of a space by a hyphen is not sufficient to avoid confusion between the disputed domain name and the Complainant's trade mark. It notes that the "arena" in Finnish means "arena" in English. As a result, says the Complainant, the disputed domain name is identical or at least highly similar to the Complainant's registered trade mark.

The Complainant submits that the letter combination YLE AREENA is inherently distinctive for its streaming services provided under the mark and as such there is no conceivable *bona fide* reason for the use of this distinctive mark, or a very minor variation of it, in the disputed domain name by a third party without prior consent which it has not given. It also submits that its YLE AREENA mark enjoys a very high level of repute and is even well-known in Finland, and it notes, in particular, that in 2019 this mark was selected as being Finland's number one Internet brand and in 2021 came second in a Finnish brand survey.

After searching trade mark registers to its best capability, the Complainant says that it has been unable to find any trade mark registrations in the name of the Respondent. The Complainant says that it is also unaware of, and does not find it plausible, that the Respondent would have been commonly known by the disputed domain name before the registration of the Complainant's trade marks on which this Complaint is based, or before the Complainant started using its trade mark YLE AREENA in 2007.

It says that the disputed domain name is not being used in connection with any *bona fide* offering of goods and services and the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. Instead, the Respondent is using the disputed domain name to falsely suggest an affiliation with the Complainant and to confuse and divert Internet users and tarnish the Complainant's trade marks by creating a website offering identical services and replicating therein the Complainant's trade mark.

The Complainant says that the disputed domain name duplicates its prior trade mark YLE AREENA, and is being used by the Respondent for identical services, including video streaming. Moreover, says the

Complainant, the language used on the website at the disputed domain name is Finnish. Especially taking into account the reputation and long-standing use of the Complainant's trade marks in Finland, it is in the Complainant's view not plausible that the Respondent would not have been aware of the Complainant's prior trade marks when registering the disputed domain name. The Complainant says that the registration of the disputed domain name which is identical and confusingly similar to the highly distinctive and well-known trade mark of the Complainant itself creates a presumption of bad faith.

The Complainant further says the fact that the Respondent registered the disputed domain name using a privacy shield is indicative of bad faith. Further, that the website offers the video streaming services of, *inter alia*, various recently released movies but requires registration before viewing (whereas the Complainant's does not) is not according to the Complainant consistent with likely legitimate activities.

In summary, says the Complainant, the Respondent is inappropriately and intentionally defrauding actual or potential visitors into believing that the disputed domain name is associated with the Complainant. It is thus submitted that the disputed domain name has been registered for the purpose of disrupting the business or activities of the Complainant by intentionally creating an association between the Complainant and the Respondent and applying the Complainant's trade marks in a corresponding domain name. Furthermore, says the Complainant, the Respondent has intentionally attempted to attract Internet users to its website by creating a likelihood of confusion with the Complainant's well-known trade mark.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns European trade mark registration No 018141990 for YLE registered in 2020 and also European trade mark registration No. 018344765 for YLE AREENA which was registered on April 14, 2021. The disputed domain name wholly incorporates the YLE and the YLE AREENA marks and is therefore confusingly similar to either of them. The only difference between the substantive part of the disputed domain name and the Complainant's registered trade marks in the first instance is the word "areena," meaning "arena" in English, and in the second is the incorporation of a dash. Neither difference prevents a finding of confusing similarity. Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trade mark right and the Complaint succeeds under this element of the Policy.

B. Rights or Legitimate Interests

The Complainant has submitted that the letter combination YLE or YLE AREENA is inherently distinctive for its streaming services and that there is no conceivable *bona fide* reason for the use of this distinctive mark, or a very minor variation of it, in the disputed domain name by the Respondent without its consent, which has not been given. The Panel notes that the YLE and YLE AREENA marks appear to enjoy a very high level of repute in Finland based on the evidence submitted with the Complaint.

The Complainant has submitted that it has searched but has found no trade mark registrations for the YLE AREENA mark in the name of the Respondent. The Complainant has also submitted that it is unaware of, and does not find it plausible, that the Respondent would have been commonly known by the disputed domain name before the registration of the Complainant's trade mark in 2007.

Finally, the Complainant has submitted that the disputed domain name is not being used in connection with any *bona fide* offering of goods and services and that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. Instead, says the Complainant, the Respondent is

using the disputed domain name to falsely suggest an affiliation with the Complainant and to confuse and divert Internet users and tarnish the Complainant's trade marks by creating a website which offers identical services and which replicates the Complainant's trade mark.

The Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. As the Complainant's case has not been rebutted by the Respondent, the Panel finds for these reasons and as set out under Part C below, that the Complainant has successfully made out its case and that the Complaint also succeeds under this element of the Policy.

C. Registered and Used in Bad Faith

It appears that the Respondent registered the disputed domain name in January 2021, or acquired it in December 2021 at which time the WHOIS record notes the register as having been "updated". This was long after the Complainant first started using the YLE AREENA mark in 2007 and also after the date of registration of EU trade mark No. 018344765 for YLE AREENA and for European trade mark registration No 018141990 for YLE. The YLE and YLE AREENA marks are very distinctive and based on the evidence provided by the Complainant are extremely well reputed in Finland. The marks are featured on the website to which the disputed domain name resolves and from which the Respondent purports to offer identical services to those offered by the Complainant. As a result, the Panel infers that the Respondent was well aware of the Complainant's mark and streaming services business at the date of registration/acquisition of the disputed domain name in 2021.

Under paragraph 4(b)(iv) of the Policy, there is evidence of registration and use of the disputed domain name in bad faith where a Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the website.

It is apparent in this case that the Respondent is using the disputed domain name to confuse and divert Internet users to a website from which it purports to offer the same or similar services to those offered by the Complainant. That this website even features representations of the Complainant's registered mark strongly suggests that the Respondent is trying to masquerade to Internet users arriving on the website that the website is the Complainant's or is endorsed by, or affiliated with, the Complainant. That the Respondent requires Internet users to register and provide information in doing so suggests that the purpose of the website is either commercial or is to enable the fraudulent collection of Internet user's information. The Panel notes that the Respondent has failed to respond or to otherwise explain this conduct, and the Panel therefore finds that the circumstances here fulfill the requirements of paragraph 4(b)(iv) of the Policy which is evidence of the registration and use in bad faith of the disputed domain name.

The fact that the Respondent registered the disputed domain name using a privacy shield only reinforces the Panel's view of the Respondent's bad faith.

Having found that that the disputed domain name has been both registered and used in bad faith, the Panel finds that the Complaint also succeeds under this element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <yle-areena.com> be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: December 29, 2022