

.nz Dispute Resolution Service

DRS Reference: 546

Live Nation Worldwide Incorporated v Kasser Riaz

Key words – Registered mark; identical; demonstrable preparations to use; legitimate non-commercial or fair use; generic; blocking registration.

1. Parties

Complainant:

Live Nation Worldwide Incorporated

9348 Civic Centre Drive
Beverly Hills
CA 90210
United States of America

Respondent:

Kasser Riaz
8 Ashgrove House Lindsay Square
London
GB (UNITED KINGDOM)

2. Domain Name

livenation.co.nz ("the Domain Name")

3. Procedural history

The Complaint was lodged on September 17, 2010, and Domain Name Commission Limited (DNC) notified the Respondent of the validated Complaint on September 20, 2010. The Domain Name had been locked on September 17, 2010, preventing any changes to the record until the conclusion of these proceedings.

The Respondent filed a timely Response to the Complaint by email, and DNC so informed the Complainant on October 19, 2010. A hard copy of the Response was received on October 26, 2010. The Complainant filed a Reply to the Response on November 4, 2010.

DNC informed the parties on November 24, 2010 that informal mediation had failed to achieve a resolution of the dispute.

The Complainant paid DNC the appropriate fee for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy"), on December 8, 2010.

Mr Warwick Smith, the undersigned, (“the Expert”) confirmed to DNC on December 13, 2010 that he knew of no reason why he could not properly accept the invitation to act as expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality. The Expert was appointed by DNC under the Policy on December 13, 2010.

4. Factual background

The Complainant

The Complainant is an American corporation. It is one of the world’s largest live entertainment companies, dealing with concert promotion, venue operations, sponsorships, ticketing, e-commerce, and artist management, in numerous countries around the world.

The Complainant operates a website or websites at over 20 domain names, including <livenation.com>, <livenation.net>, <livenation.org>, and <livenation.co.uk>.

The Complainant’s worldwide operations are clearly substantial. It said (and the Respondent did not dispute) that in 2009 it achieved an average of 25 million hits every month on its various websites.

In 2008, the Complainant announced plans to start a ticketing service to compete with the service provided by Ticketmaster Entertainment Inc. That move attracted considerable media attention around the world, as the Complainant had until then been Ticketmaster’s largest client. The Complainant produced extracts from a number of publications from 2008 commenting on this commercial move, including articles from The Times and Wall Street Journal Asia.

The Complainant’s Service Marks

The Complainant is the registered proprietor of the word mark LIVE NATION in New Zealand. That mark, registered with effect from June 13, 2006, covers a variety of services in international classes 35, 38, and 41, including “production of live entertainment events, live concerts, festivals, theatrical shows ... sporting events ... entertainment news and personality profiles of touring talent available in print form and over a global computer network”.

The class 38 registration covers “broadcasting services, including Internet broadcasting services”.

The Complainant holds registrations of a LIVE NATION (or “LIVENATION”) mark in numerous other jurisdictions, including the European Union and the United States.

The Respondent and the Domain Name

The Domain Name was registered on January 23, 2009. The Complainant says that it first became aware of the registration of the Domain Name in May of 2010.

The Domain Name is not currently put to any active use – it simply resolves to a parking page.

The Complainant's representatives sent cease and desist letters to the Respondent on May 13, 2010 and (when they had received no reply to the first letter) on July 9, 2010.

The Respondent replied by letter dated July 13, 2010. He denied any infringement of the Complainant's intellectual property rights, and stated that he had no intention of using the Complainant's "design mark" (this appears to be a reference to a figurative mark which the Complainant has registered with the United States Patent and Trademark Office (the "USPTO") – the Complainant's New Zealand-registered mark is a word mark). The Respondent went on to assert that "Live Nation" is a generic term which cannot be monopolised, and he assured the Complainant's representatives that his intended use of the Domain Name would not infringe their client's IP rights. The Respondent claimed that "our project for the domain name" had been under development for almost 18 months, and he said that "we have every intension [sic] to protect our brand, including confronting any legal case that arises".

The Complainant's representatives wrote again to the Respondent on July 23, 2010. They denied that "Live Nation" is a generic term, and pointed out that their client holds trademark registrations for the word mark LIVE NATION in many countries, including New Zealand. The Complainant's representatives asked the Respondent to explain his intended use for the Domain Name, and they requested that he provide full evidence in support of his assertion that a project for the Domain Name had been under development for almost 18 months. The Complainant's representatives noted that the Domain Name still resolved to a parking page, and that the Respondent had refused an offer made by the Complainant to pay the Respondent's out-of-pocket costs directly associated with transferring the Domain Name to the Complainant.

The Respondent replied briefly on July 30, 2010. He did not provide any information about his "project", but asserted that he had "the unquestionable right for the use of the brand which again I confirm does not infringe your client's IP rights". He said that he would deal with any claim in the Courts.

The Complainant produced with the Complaint a copy of a short form decision issued on August 18, 2009 by an expert appointed by Nominet to resolve a dispute relating to the United Kingdom domain name <studica.co.uk>. The Respondent was named as respondent in the case. In the decision, the expert held that it had been established to his reasonable satisfaction that the <studica.co.uk> domain name was an abusive registration in the hands of the

Respondent. The expert directed a transfer of the disputed domain name to the complainant in the case. As is normally the case with the Nominet “short form” decisions, the decision did not disclose either the facts on which it was based or the expert’s reasons for the decision.

In his formal Response in this proceeding, the Respondent said that his sole purpose in registering the Domain Name was to celebrate the Maori nation within New Zealand. He said that a project is currently being developed to provide a source of information about the history, origins, archaeological history, New Zealand colonisation, modern period and challenges, language, culture, and further extensive references to a civilisation “that is very much a live nation”. The Respondent went on to say that his small company has every right to define the “Moari” [sic] nation as a Live Nation, and that the website which he has under development has nothing to do with entertainment. No viewer could be misled.

The Respondent provided with his Response extracts from Oxford Dictionaries Online, giving a number of definitions of the word “live”. He also produced a volume of material downloaded from Wikipedia relating to the words “Nation” and “Maori”.

The Respondent produced with the Response extracts from the USPTO database relating to the Complainant’s registrations of the mark LIVE NATION in the United States. One of the United States registrations was for the word mark LIVE NATION. A second United States registration produced by the Respondent was for a figurative version of the LIVE NATION mark, with the letter “i” in the word “LIVE” stylised.

The Respondent also produced with the Response extracts from the websites at www.livenation.us and www.livenation.gr. The latter website appeared to be parked with Sedo, and contained a number of sponsored links to third party websites. There was a claim on this website: “the Domain Name livenation.gr may be for sale by its owner!”

The Respondent acknowledged that it “may be correct” that the Complainant has a trademark, but emphasised that it was not his intention to capitalise on the Complainant’s brand.

Notwithstanding the Respondent’s assertion that nobody could be confused, the Respondent offered to put a “disclosure” on the website to be established at the Domain Name, stating that the website has nothing to do with the Complainant.

The Complainant’s Reply

In its Reply, the Complainant pointed out that if the establishment of a website celebrating the Maori nation had really been the Respondent’s intention, he could have registered any of the following available domain names – <maorination.com>, <maorination.co.nz>, <maoridom.co.nz>, <maorihistoryfacts.co.nz>, or <maoriinformation.co.nz>.

5. Parties' contentions

a. Complainant

The Complainant contends:

1. The Complainant has both registered and common law rights in the service mark LIVE NATION. The obvious domain name for that mark is the Domain Name. The term "Live Nation" is not generic, as the Complainant's LIVE NATION mark has been registered as a trade mark. An expert should not "second guess" a decision of the Registrar of Trade Marks to grant registration of a trade mark (citing *InterCity Group (NZ) Limited v Traction Group Limited*, NZDRS Case No. 101).
2. The Domain Name was acquired in a manner which, at the time of the registration, took unfair advantage of, or was unfairly detrimental to, the Complainant's rights. The Complainant relies on the following matters:
 - (i) The Respondent has previously been held to have made an abusive registration of a domain name in the United Kingdom.
 - (ii) The Complainant already had existing rights in its LIVE NATION mark in New Zealand when the Domain Name was registered by the Respondent.
 - (iii) The Complainant's LIVE NATION brand is very well known.
 - (iv) By registering the Domain Name, the Respondent has sought to block the use of the Domain Name by the Complainant. This is likely to mislead and deceive the public into believing that the Complainant is in some way associated with the Respondent. That is damaging to, and takes advantage of, the Complainant's brand and goodwill.
 - (v) It is inconceivable that the Respondent was unaware of the existence of the Complainant's brand, as the Complainant has a very well-known website in the United Kingdom that advertises various Live Nation promotions. The Complainant also owns multiple trade mark registrations in the European Union. A respondent's knowledge of the complainant's trade mark when registering a domain name containing that trade mark, constitutes a bad faith registration (*ACCOR v Eliah Zusstone*, WIPO Case No. D2006-0362).
 - (vi) The Respondent's use of such a well-known, long-registered (and much longer-used) mark as the basis of the Domain Name gives rise to an inference that the Respondent registered the Domain Name with actual and constructive knowledge of the

Complainant's mark. That is in itself evidence of bad faith registration.

3. The Domain Name is likely to be used in a manner which takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights. The Complainant relies on the following:

- (i) The Complainant has on a number of occasions asked the Respondent for clarification of the exact use to which he intends to put the Domain Name. The Respondent has refused to reveal any details of his proposed business.
- (ii) The Respondent intends to use the Domain Name to try to attract, for commercial gain, Internet users to a website at the Domain Name, 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 of a product or service on the Respondent's website.
- (iii) Given the Complainant's extensive goodwill in its mark, any use of the Domain Name for trading purposes would amount to infringement of the Complainant's mark, and constitute a passing off.
- (iv) It is conceivable that Internet users in countries other than New Zealand may also visit any website established at the Domain Name, when they are planning to attend concerts in New Zealand. The Internet is global, and is accessed from multiple jurisdictions (citing *Insurance & Go Insurance Services Limited v 1 cover NZ Limited*, NZ DRS Case No. 443).
- (v) The Domain Name is a blocking registration, as the Respondent does not appear to be making a *bona fide* offering of goods or services from any website at the Domain Name. The use of a free parking facility is sometimes taken to imply that a Domain Name is available for sale by negotiation (citing *Pacific Bereavement Solutions (NZ) Limited v Clive Cooper and Andrew Breaker*, NZ DRS Case No. 145).

b. Respondent

The Respondent contends:

- 1. The Respondent lawfully registered the Domain Name for the sole purpose of celebrating the Maori nation within New Zealand. At no stage did the Respondent infringe, interrupt, or try to capitalise on the Complainant's brand.

2. At no stage has the current holding page to which the Domain Name resolves misled, diverted, or confused anyone who has visited that holding page.
3. The Complainant has fabricated a false claim that the Respondent has infringed its IP rights.
4. The Complainant's contention that it has been prevented from developing its business in New Zealand is unfounded (referring to the Complainant's website page at www.livenationinternational.com/Home/Index.asp, at which the site visitor is referred to the websites at www.livenation.com.au and www.ticketmaster.co.nz for information relating to the Complainant and its activities in New Zealand).
5. The word "Nation" means a large body of people united by common descent, history, culture or language, inhabiting a particular state or territory.
6. One of the definitions of the word "live", used as an adjective, is "not dead or inanimate; living" (Oxford Dictionaries Online).
7. Having regard to those definitions, the Respondent has every right to define the Maori nation as a "Live Nation".
8. The website which the Respondent has under development has nothing to do with entertainment, and no viewer could be misled.
9. The Respondent would be happy to put a "disclosure" on the website at the Domain Name when it goes live, stating that the website has nothing to do with the Complainant.

c. The Complainant's Reply

1. The Respondent's contention in the Response that he proposes to use the Domain Name for a site celebrating the Maori nation, was the first that the Complainant had ever heard of the proposal. The Respondent's failure to mention his claimed proposal earlier raises concerns as to whether he has any genuine intention to use the Domain Name for the purpose described in the Response.
2. The Respondent has failed to provide any credible documentation to support the intended use of the Domain Name to which he referred in the Response. The Respondent has held the Domain Name since January 23 2009, and if he actually intended to make the use of the Domain Name which he now says he intends to make, documents must surely exist to support his claim (beyond the exhibit containing the Wikipedia printout of the definition of "Maori").

3. If the Respondent genuinely intended to use the Domain Name for the purpose claimed in the Response, he could have registered a number of other domain names (some including the expression “maorination”) which would have been more appropriate to such a use than the Domain Name.
4. The evidence shows the distinctiveness of the Complainant’s brand, and points to likely confusion rather than a lack of confusion. That likely confusion is not alleviated by the fact that the Domain Name points to a parking page, and nor would it be alleviated if the Domain Name pointed to a page relating to the Maori culture. (It is in any event not a requirement for a finding of Unfair Registration that a person visiting a website at a disputed domain name would be likely to be confused – a likelihood of confusion is only one form of evidence which may assist a complainant in establishing Unfair Registration.) The Complainant maintains its case of abusive [sic] registration, with or without confusion.
5. Under section 10 of the Trade Marks Act 2002 (NZ), the owner of a registered trade mark has the exclusive right to use that mark in relation to all or any of the goods in respect of which the trade mark is registered. In this case, the description of the Respondent’s supposed use of the Domain Name, while vague, is likely to fit into one of the following categories covered by international class 41: “education information”, “entertainment information”, “organisation of exhibitions for cultural or educational purposes”, or “exhibitions for cultural or educational purposes”. Even if the proposed use which the Respondent has put forward is one which he genuinely intends to make, the proposed use would amount to trade mark infringement and would self-evidently be an Unfair Registration.

6. Discussion and findings

A. General – Relevant Provisions of the Policy

The Policy applies to a Respondent when a Complainant asserts that:

- “(i) *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- “(ii) *The Domain Name, in the hands of the Respondent, is an Unfair Registration.*” (Policy, paragraph 4.1)

The Complainant is required to prove, on the balance of probabilities, that both elements are present (Policy, paragraph 4.2).

The expressions “Rights” and “Unfair Registration”, are both defined in paragraph 3 of the Policy. The expression “Rights” is defined to include (but

is not limited to), rights enforceable under New Zealand law. The definition continues:

However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business."

The expression "Unfair Registration" means a Domain Name which either:

- (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR
- (ii) has been, or is likely to be, used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

At paragraph 5.1, the Policy sets out a non-exhaustive list of factors which may be evidence that a domain name is an "Unfair Registration". The list includes the following:

"5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

- (a) *for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name; or*
- (b) *as a blocking registration against a name or mark in which the Complainant has Rights; or*
- (c) *for the purpose of unfairly disrupting the business of the Complainant.*

5.1.2 Circumstances demonstrating that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant."

Paragraph 6.1 of the Policy sets out a list of factors which may be evidence that the Domain Name is *not* an Unfair Registration. This list, which is again non-exhaustive, contains the following:

"6.1.1 Before being aware of the Complainant's cause for complaint (not necessarily the Complaint itself), the Respondent has:

(a) *used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a genuine offering of goods or services;*

...

(c) *made legitimate non-commercial or fair use of the Domain Name.*

6.1.2 *The Domain Name is generic or descriptive and the Respondent is making fair use of it in a way which is consistent with its generic or descriptive character.”*

B. Application of the Policy in this Case

Rights

The Expert is satisfied that the Complainant has made out its case under paragraph 4.1.1 of the Policy – it has Rights in respect of a name or mark which is identical to the Domain Name.

The Complainant has established that it is the registered proprietor of the word mark LIVE NATION in New Zealand, and that mark is identical to the Domain Name. The Expert accepts the Complainant’s submission (citing the *InterCity Group (NZ) Limited* case) that it is not appropriate in an administrative proceeding such as this for the Expert to second guess the decision of the Intellectual Property Office of New Zealand that the Complainant’s mark is capable of being distinctive of the services in the specification, and is not purely generic or descriptive.

Is the Domain Name, in the Hands of the Respondent, an Unfair Registration?

The Expert is satisfied that it is. He has reached that view for the following reasons:

1. The statements in the Response about the Respondent’s intentions for the future use of the Domain Name are simply not credible. First, the Respondent has not explained why he would have an interest in establishing a website devoted to celebrating a “Maori nation” within New Zealand. On the face of the proceeding, the Respondent lives in London, and he has not asserted any Maori tribal affiliation or other connection with New Zealand Maori. If the Respondent were genuine in the claims made in the Response, his motivation for establishing such a website could have and should have been explained. Secondly, the Respondent registered the Domain Name as long ago as January 23, 2009. If his purpose in registering the Domain Name at that time was to establish a website celebrating the “Maori nation”, one would have expected him to have generated at least some

contemporaneous documents over the ensuing period of approximately 20 months which could have been provided with the Response, and so demonstrate the veracity of the Respondent's claims. No such documents have been produced: all the Respondent has produced are extracts from an online dictionary, Wikipedia, and the USPTO online database, all of which appear to have been printed after the Respondent would have received a copy of the Complaint. Thirdly, the Respondent referred in his July 13 and July 30, 2010 emails to protecting "our brand", and "the unquestionable right for the use of the brand" To the Expert's mind, the word "brand" is an expression more likely to be used by a trader in goods or services than by the creator of a (presumably) not-for-profit website designed to spread knowledge and understanding of the culture and language of a particular indigenous people. Fourthly, the Expert can see no reason why, if the Respondent really registered the Domain Name for the purpose claimed in the Response, he did not simply advise the Complainant's representatives in July of 2010 that that was his intention. Fifthly, the Expert notes that the Domain Name does not identify the Respondent in any way, and nor does it appear to be an obvious choice for anyone wanting to signal to Internet users that they would find at the Domain Name a website devoted to the celebration of Maori history, culture, and language. In the Expert's view, there is force in the Complainant's submission that the Respondent could have registered several other domain names, each containing the expression "maorination", which would have been far more likely choices for a website of the kind described in the Response. Certainly one might describe the Maori tribes of New Zealand collectively as a "nation", and if one were to stretch ordinary English usage one might perhaps use the expression "live" to describe a flourishing indigenous population. But that is all after-the-event analysis – the Respondent has not denied that he was aware of the Complainant at the time he registered the Domain Name, and in those circumstances it was clearly incumbent upon him to explain how and why he actually chose the Domain Name. Considering all of the circumstances discussed in this paragraph, the Expert considers it probable that the Respondent chose the Domain Name because it is identical to the Complainant's mark, and not because he had some intention to establish at the Domain Name a website celebrating Maori history, culture, and language.

2. If the Respondent was aware of the Complainant and its LIVE NATION mark when he registered the Domain Name, which the Expert finds was probably the case, the Respondent must have appreciated that a significant number of Internet users who were familiar with the Complainant would be likely to assume that any website at the Domain Name would either be operated by the Complainant or would be endorsed or approved by the Complainant. If the Respondent appreciated that likelihood, it follows that he must have *intended* to attract Internet users looking for a website concerned with the Complainant's operations in New Zealand, to any website he established at the Domain Name. Add the facts that the Respondent

has (i) failed to establish *any* website at the Domain Name over a period spanning some 20 months, and (ii) advanced an explanation for his registration of the Domain Name which the Expert has found implausible, and the inference that the Respondent was targeting the Complainant in some way when he registered the Domain Name, is difficult to resist. Whether his intention was to provoke an offer from the Complainant for the purchase of the Domain Name at a profit to the Respondent, or whether he simply intended to profit by attracting to a website at the Domain Name additional Internet users who were looking for a New Zealand website operated by the Complainant, does not in the end matter. In either event, the Respondent's actions in registering the Complainant's New Zealand mark as a domain name, and then sitting on that domain name for 20 months without using it, amount to a blocking registration against a mark in which the Complainant has Rights, within the meaning of paragraph 5.1.1(b) of the Policy.

3. Having regard to all of the foregoing circumstances, the Expert is satisfied that the Domain Name was registered by the Respondent in a manner which at the time when the registration took place, was unfairly detrimental to the Complainant's Rights. Given the fact that the Respondent has done nothing with the Domain Name since January 2009, and has advanced an implausible reason for registering it, the Expert is also satisfied, on the balance of probabilities, that if the Domain Name is not transferred to the Complainant it is likely to be used by the Respondent in a way which is likely to confuse, mislead, or deceive people into believing that the Domain Name is registered to, operated, or authorised by, or otherwise connected with, the Complainant, and that any such use would be unfairly detrimental to the Complainant's Rights.

For the foregoing reasons, the Expert is satisfied the Domain Name, in the hands of the Respondent, is an Unfair Registration.

7. Decision

For the foregoing reasons, the Expert directs that the Domain Name, <livenation.co.nz>, be transferred to the Complainant.

Place of decision Auckland, New Zealand

Date 17 December 2010

Expert Name Mr Warwick Smith

Signature