

## **ADMINISTRATIVE PANEL DECISION**

The British Broadcasting Corporation v. Domain Administrator, See  
PrivacyGuardian.org / Tien Doan, Tien Kieu  
Case No. D2022-2981

### **1. The Parties**

The Complainant is The British Broadcasting Corporation, United Kingdom, represented by Demys Limited, United Kingdom.

The Respondent is Domain Administrator, See PrivacyGuardian.org, United States of America / Tien Doan, Tien Kieu, Viet Nam.

### **2. The Domain Names and Registrar**

The disputed domain names <cbeebies.games> and <cbeebiesgames.net> are registered with NameSilo, LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 12, 2022. On August 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 15, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on August 16, 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 August 18, 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 August 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 8, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 9, 2022.

The Center appointed John Swinson as the sole panelist in this matter on September 22, 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 the national broadcaster of the United Kingdom. The Complainant is commonly known by the initialism "BBC". The Complainant operates a diverse portfolio of television channels around the world. One of those channels is broadcast under the name CBEEBIES, a free-to-air children's television channel targeted at young children aged six years and under. The CBEEBIES television channel is broadcast around the world in different languages. One of its shows is "CBeebies Bedtime Stories" in which a bedtime story is read by famous celebrities such as Steve Carrel, Sir Michael Palin, and Tom Hardy.

The Complainant owns registered trademarks for CBEEBIES, including United Kingdom Registration No. UK00911653367 with a registration date of July 24, 2013. The Complainant also uses and has a United Kingdom Registration No. 00002428953 for a figurative logo that includes the letters CBEEBIES in yellow font arranged in an arch, registered on February 9, 2007.

Both the disputed domain names were registered on May 22, 2018.

The Respondent did not file a response, so little information is known of the Respondent. The Respondent has been a party to at least one domain name dispute under the UDRP, *Scottgames, LLC v. Tien Kieu, Tien Doan / Domain Administrator, See PrivacyGuardian.org; Dung Danh Minh / Contact Privacy Inc. Customer 0146905890*, WIPO Case No. [D2017-0764](#).

At the present time, the disputed domain names resolve to active websites where Internet users can access and play different games, including games belonging to the Complainant. These websites include headings such as "Cbeebies Games" and "Bluey Cbeebies". There is also a section of the website at <cbeebies.games> that is titled "BBC For Kids". The "description" in the meta-tags for the <cbeebiesgames.net> website states: "Cbeebies games are fun and activities BBC games to play for babies, toddlers and young children. Play fun and educational games free for kids at your home." The websites at the disputed domain names also include advertisements for products and services not associated with the Complainant.

#### **5. Parties' Contentions**

##### **A. Complainant**

In summary, the Complainant makes the following submissions:

The Complainant owns trademark registrations for CBEEBIES.

One of the disputed domain names is identical to the Complainant's CBEEBIES trademark. The other disputed domain name incorporates the Complainant's CBEEBIES in its entirety.

The Respondent is not commonly known by the disputed domain names and does not own any trademark registrations that incorporate the term "cbeebies". The Respondent is not a licensee or reseller of the Complainant and has not received any permission or consent from the Complainant to use its trademarks. Even if the Respondent was a reseller, the Oki Data test does not apply here.

The Respondent's use of the disputed domain names is not *bona fide*. Some of the games offered on the Respondent's websites are the Complainant's games.

The disputed domain names and associated websites falsely suggest affiliation with the Complainant and that such use cannot constitute fair use under the Policy. The Respondent's websites are "bait and switch" websites.

The disputed domain names themselves are misleading, creating "initial interest confusion". The websites to which the disputed domain names resolve are themselves misleading and confusing. There is no suitable disclaimer on these websites.

## **B. Respondent**

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

## **6. Discussion and Findings**

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The onus of proving these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

Paragraph 3(c) of the Rules states that "the complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder". That is the situation here.

### **A. Identical or Confusingly Similar**

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant owns trademark registrations for CBEEBIES. The disputed domain names include the Complainant's trademark in its entirety.

Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy when the domain name includes the trademark, or a confusingly similar approximation. See, for example, *Consumer Reports, Inc. v. Wu Yan, Common Results, Inc.*, WIPO Case No. [D2017-0371](#); and *Captain Fin Co. LLC v. Private Registration, NameBrightPrivacy.com / Adam Grunweg*, WIPO Case No. [D2021-3279](#).

Additionally, the disputed domain name <cbeebiesgames.net> incorporates the Complainant's CBEEBIES trademark in its entirety with the addition of the word "games". The word "games" does not prevent a finding of confusing similarity.

The Panel concludes that the disputed domain name <cbeebies.games> is identical to the Complainant's CBEEBIES trademark and the disputed domain name <cbeebiesgames.net> is confusingly similar to the Complainant's CBEEBIES trademark.

The Complainant succeeds on the first element of the Policy.

## **B. Rights or Legitimate Interests**

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain names.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

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

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant.

Previous UDRP panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden of production will shift to the respondent to rebut that *prima facie* case.

The Complainant alleges that the Respondent is not commonly known by the disputed domain names and does not own any trademark registrations that incorporate the term "cbeebies". Further, the Complainant alleges that the Respondent is not a licensee or reseller of the Complainant and has not received any permission or consent from the Complainant to use its trademarks. The Complainant also alleges that the Respondent's use of the disputed domain names is not *bona fide*, and some of the games offered on the Respondent's websites are the Complainant's games. The Complainant also asserts that the disputed domain names and associated websites falsely suggest affiliation with the Complainant and that such use cannot constitute fair use under the Policy.

The Complainant has rights in its trademark which precedes the Respondent's registration of the disputed domain names.

The Complainant has established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the disputed domain names and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the disputed domain names.

The Panel finds that the Respondent has failed to produce any evidence to establish its rights or legitimate interests in the disputed domain names. Based on the evidence before the Panel, none of the circumstances listed in paragraph 4(c) apply in the present circumstances. Accordingly, the Panel finds that the Respondent has no rights or any legitimate interests in the disputed domain names.

### **C. Registered and Used in Bad Faith**

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain names in bad faith.

The Panel is of the view that the Respondent was aware of the Complainant and the Complainant's trademark when the disputed domain names were registered. This is because the Complainant has registered and used the trademark CBEEBIES many years before the Respondent registered the disputed domain names. This is supported by the fact that the disputed domain names resolve to websites that refers to the Complainant by name. Moreover, the websites at the disputed domain names have a similar look and feel to the Complainant's CBEEBIES webpages.

The Respondent's use of the disputed domain names to impersonate the Complainant or to imply sponsorship or endorsement of the Respondent by the Complainant, is evidence of bad faith use.

The Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's websites by creating a likelihood of confusion with the Complainant's CBEEBIES trademark. The Complainant meets paragraph 4(b)(iv) of the Policy.

The Complainant succeeds on the third 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 names <cbeebies.games> and <cbeebiesgames.net> be transferred to the Complainant.

*/John Swinson/*

**John Swinson**

Sole Panelist

Date: October 6, 2022