

## **ADMINISTRATIVE PANEL DECISION**

Itv Studios Limited, ITV Rights Limited v. craig dalziel  
Case No. D2024-1916

### **1. The Parties**

The Complainant is Itv Studios Limited, ITV Rights Limited, United Kingdom, represented by Helen Stanwell Smith, United Kingdom (“UK”).

The Respondent is craig dalziel, UK .

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

The disputed domain name <thismorning-itv.com> is registered with 123-Reg Limited (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 7, 2024. On May 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 7, 2024, 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 (Respondent details unknown, details on WHOIS listed as ‘Registrant Private, Domains by Proxy LLC (abuse@123-reg.co.uk)) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 8, 2024, 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 May 10, 2024.

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 May 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 4, 2024. The Respondent sent an email communication to the Center on June 5, 2024.

The Center appointed Clive Duncan Thorne as the sole panelist in this matter on June 12, 2024. 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.

On June 12, 2024 the Center received an email from a Rachael Bell, using the Respondent's email address kraigdielmusic@gmail.com, stating; "Just take the domain. Why is this such a big deal?". The Panel notes this communication but in its view it does not affect the issues in the Complaint.

#### 4. Factual Background

The two companies comprising the Complainant are both wholly owned subsidiaries of ITV plc. ITV Rights Ltd is the rights holding entity in the ITV Group and owns the rights in the "ITV" brand. ITV Studios Ltd is a production company who are the producers and owners of the "This Morning" television show and brand.

ITV is one of the largest commercial linear television broadcasters in the UK with six television channels and has been active in the UK television broadcasting market since 2006 under its trade mark ITV. The mark ITV owned by ITV Rights Ltd. is registered and protected in several classes in the UK and in several regions and other countries including the European Union ("EU").

This Morning is a daytime television show produced by ITV Studios Ltd and broadcast on the ITV1 television channel. It has been broadcast since October 1988, making it one of the longest running daytime television programmes on British television. It features a variety of news, as well as subjects including show business, fashion, beauty, lifestyle, home and garden, food, tech, live phone-ins and competitions. ITV Studios Ltd. owns various UK trade marks for THIS MORNING.

The Complainant adduces evidence of the registered trade mark ITV as follows;

- i. UK registration UK00003477225 for ITV registered on August 9, 2020, in classes 9,16,35,38,41,42 and 45.
- ii. UK registration UK00003526818 for ITV in logo form registered on January 22, 2021, in classes 3,6,9,11,14,16,18,20,21,24,25,28,29,30,32,33 and 35.
- iii. EU registration 012115796 for ITV registered on January 30, 2014, in classes 9,16, 35, 38, 41, 42 and 45.

The Complainant adduces evidence of the registered mark THIS MORNING as follows;

- i. UK registration 00003183238 registered on January 13,2017, in classes 3,5,7,8,9,16,18,20,21,24,25,30,31, 38,41,43 and 44.
- ii. UK registration 00002552003 registered on October 8,2010, in classes 21,24 and 31.
- iii. UK registration 00002144524 registered on May 21,1999, in classes 5,9,16,18,21,30,38 and 41.

Since 1994 ITV has been the owner of numerous domain names across the world for the name ITV and/or THIS MORNING either alone or in combination with other terms relating to its brand. The domain names are registered by ITV Studios Ltd, ITV Rights Ltd and other members of the ITV Group. A list of these domain names are set out at Annex 5 to the Complaint and a number are listed in the Complaint. Examples include <thismorning.co.uk> registered on January 17,2006 and <thismorning-live.co.uk> registered on July 15, 2016.

The disputed domain name <thismorning-itv.com> was registered on February 26,2024 which is after the dates of registration of the trade marks and domain names cited and relied upon by the Complainant.

The Complainant became aware of the disputed domain name on February 26, 2024, which was also the date of its registration, when a member of the public contacted the Complainant having received an Instagram message from a “Luka Johnson” asking if he would like to appear on the “This Morning” programme.

After corresponding with the member of the public via Instagram “Luka Johnson”, it appears that the Respondent registered the disputed domain name. He emailed the member of the public from an email address connected with the disputed domain name. “Luka Johnson” in his email, which is exhibited at Annex 7 to the Complaint, impersonates an ITV producer. He represents that this was his “work account” to prove his identity and proposes discussing the possibility of the recipient “appearing live on This Morning, which is broadcast from ITV Studios in Manchester”.

The matter was passed to the ITV Brand Protection Team who on March 8, 2024 emailed a cease-and-desist notification to “Luka Johnson”. A copy is also exhibited at Annex 7. There is no evidence of a response to the cease-and-desist notification.

In the absence of a Response, the Panel finds the evidence adduced by the Complainant to be true.

## **5. Parties’ Contentions**

### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

- i. On the evidence the disputed domain name is confusingly similar to trade marks and domain names owned by it consisting of or containing the words “ITV” and “THIS MORNING” and which predate the date of registration of the disputed domain name;
- ii. On the evidence the Respondent has no legitimate interest in and is not known by the disputed domain name;
- iii. On the evidence the disputed domain name has been registered by the Respondent in bad faith.

### **B. Respondent**

The Respondent did not formally reply to the Complainant’s contentions. However, on June 5, 2024, the Respondent sent a standard settlement form requesting the disputed domain name to be cancelled. The Complainant confirmed that it wishes the proceedings to continue.

## **6. Discussion and Findings**

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the Complainant has also established, by its use of ITV and THIS MORNING in the course of its business and the registration of domain names incorporating those marks, unregistered trade mark or service mark rights for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.3.

The entirety of the marks ITV and THIS MORNING are reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel also finds the marks ITV and THIS MORNING are recognizable in their entirety within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: impersonation/passing off, or other types of fraud can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. The uncontested evidence of the unauthorized use of the disputed domain name by the Complainant using the name “Luka Johnson”, impersonating an ITV producer, in order to persuade a member of the public to participate in a television programme with the same name as the Complainant’s own THIS MORNING programme is compelling evidence of impersonation or passing off by the Respondent conceivably for fraudulent purposes.

The Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: impersonation/passing off, or other types of fraud, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent’s registration and use of the disputed domain name constitutes bad faith under the Policy.

The Complainant draws attention to the fact that both ITV and THIS MORNING were well known as marks used to represent the Complainant and its activities; ITV as the trading name of the broadcaster and THIS MORNING as the name of one of its leading programmes which had been used since 1988. In the Panel's view the Respondent must have been aware of this since on the same day it both registered the disputed domain name and then approached a member of the public to appear in "This Morning". It had no authorization to do so as the Complainant subsequently set out in the cease-and-desist email.

The Complainant submits that the only intention of the Respondent was to impersonate an employee of the Complainant and that this is evidence of registration and use in bad faith. The Panel agrees with this submission and also takes into account that it is not possible on the facts to conceive of any legitimate use to which the Respondent could put the domain name especially the Respondent has not objected the Complainant's allegation in his communication in this proceeding.

The Panel finds that the Complainant has established 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 name <thismorning-itv.com> be transferred to the Complainant.

*/Clive Duncan Thorne/*

**Clive Duncan Thorne**

Sole Panelist

Date: June 20, 2024