

ADMINISTRATIVE PANEL DECISION

Viacom International Inc. v. Domain Admin, Hong Kong Domain
Case No. D2024-3267

1. The Parties

The Complainant is Viacom International Inc., United States of America (“United States”), represented by Paramount Global, United States.

The Respondent is Domain Admin, Hong Kong Domain, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <spongebobsquarepants.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 August 9, 2024. On August 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 12, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on [August 16, 2024 providing the registrant and contact information disclosed by the Registrar.. The Complainant filed an amended Complaint on August 16, 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 August 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 11, 2024.

The Center appointed Ugur G. Yalçiner as the sole panelist in this matter on September 17, 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.

4. Factual Background

The Complainant is a wholly owned subsidiary of the global media company, Paramount Global, which provides entertainment content, services, and related branded products for consumers in targeted demographics attractive to advertisers, content distributors, and retailers. It owns and operates the world-renowned Nickelodeon family of television programming services, which is one of the most globally recognized and widely distributed multimedia entertainment brands for kids and family.

The Complainant is the owner and producer of the popular animated children's television series, Spongebob Squarepants, which has reigned as one of the most-watched animated series for 22 consecutive years, while generating several spin-off series, three feature films that grossed over USD 250 million, a Tony® Award-winning Broadway musical, a comic book series, original music, video games, theme park rides and theme hotels, and related clothing, toys, other merchandise and collectibles. Spongebob Squarepants has been seen in more than 180 countries and translated in over 30 languages.

The Complainant is the owner of SPONGEBOB and SPONGEBOB SQUAREPANTS trademark registrations in various jurisdictions, some of which are listed below:

- United States trademark registration SPONGEBOB SQUAREPANTS with registration No. 2355702 registered on June 6, 2000, in class 41;
- United States trademark registration SPONGEBOB with registration No. 2897977 registered on October 26, 2004, in class 25;
- European Union trademark registration SPONGEBOB SQUAREPANTS with registration No. 001360486 registered on January 16, 2001, in classes 9, 16, 25, 28, and 41; and
- Hong Kong (where the Respondent reportedly resides) trademark registration SPONGEBOB SQUAREPANTS with registration No. 200208080 registered on January 17 2002, in class 41.

The Complainant also owns the domain name <spongebobshop.com>, which was registered on May 3, 2006 and the domain name <spongebob.com>, which was registered on June 21, 1999. The Complainant's domain names are redirected to the Complainant's official website at <nick.com>.

The disputed domain name was registered on July 18, 2001, at the time of filing the Complaint, it resolved to a pay-per-click ("PPC") parking page, displaying third parties' sponsored links, that include "Nickelodeon SpongeBob", "Game Games" and "Cartoon TV" and etc., and indicating "The domain spongebobsquarepants.com may be for sale. Click here to inquire about this domain"

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.

The Complainant alleges that it owns and uses various trademarks incorporating SPONGEBOB SQUAREPANTS and SPONGEBOB, the trademarks are the subject of registrations and pending applications in the United States Patent and Trademark Office and in several other jurisdictions around the world, it is the owner and producer of the SPONGEBOB SQUAREPANTS, that is a popular animated children's television series ("Series"), its long and prominent use of its SPONGEBOB trademarks for and in connection with its Series, products and services, the SPONGEBOB trademarks have acquired worldwide recognition as identifying exclusively the entertainment, products and services of the Complainant.

The Complainant contends that the Respondent registered the disputed domain name in 2014 and beginning as early as August 2023 and continuing to date, the disputed domain name resolves to a landing page containing sponsored hyperlinks to third party websites which may offer unauthorized content and/or goods featuring Complainant's SPONGEBOB trademarks, it is also indicated that the disputed domain name may be purchased for a price of USD 5,951.

The Complainant asserts that it wrote to the Respondent at its privacy protected email address requesting, among other things, that Respondent deactivate the infringing website, transfer the disputed domain name to the Complainant, and cease use of the SPONGEBOB trademark, however the Respondent did not reply to the Complainant's letter.

The Complainant contends that given the fame of the Complainant's SPONGEBOB trademark and the fact that the disputed domain name incorporates the identical SPONGEBOB SQUAREPANTS trademark in its entirety, as well as the fact that the infringing website displays links to third party websites that may offer identical goods and services as those provided by the Complainant, there can be no doubt that the disputed domain name is likely to confuse consumers into believing that the disputed domain name is affiliated with or endorsed by the Complainant.

The Complainant asserts that it is not affiliated in any way with the Respondent, nor has the Complainant authorized the Respondent to use its SPONGEBOB trademarks or any domain name incorporating the SPONGEBOB trademarks or any other mark confusingly similar thereto, the Respondent has not been commonly known by the disputed domain name, the Respondent cannot demonstrate a bona fide offering of goods or services or a non-commercial or fair use of the disputed domain name, instead, the disputed domain name incorporates the Complainant's identical SPONGEBOB SQUAREPANTS trademark in its entirety and resolves to the infringing website, where third-party paid advertisements are displayed, it is clear that the Respondent is capitalizing on the confusing similarity to pass itself off as emanating from and/or associated with the Complainant, given the prior and exclusive rights owned by the Complainant in its SPONGEBOB trademarks and the lack of legitimate use, and in fact, disreputable commercial activities carried out by the Respondent under the disputed domain name, the Respondent can have no rights or legitimate interests in the disputed domain name.

The Complainant alleges the Respondent was aware of the Complainant's rights, it registered the disputed domain name with the specific intent to cause consumer confusion and to trade upon the goodwill associated with the SPONGEBOB trademarks and prevent the Complainant from registering and using the disputed domain name, the Respondent uses the disputed domain name to resolve to the infringing website, which resolves to a landing page having links to third party websites, and to generate revenue through third-party paid advertisements, the Respondent registered and uses the disputed domain name to free ride on the vast goodwill associated with the Complainant's famous SPONGEBOB trademarks and divert internet traffic intended for the Complainant's SPONGEBOB websites, such use constitutes bad faith use and registration on the part of the Respondent.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three elements are present:

(i) the disputed domain name registered by the Respondent is 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 name; and

(iii) the disputed domain name has been registered and are being used in bad faith.

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 names. 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 for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The Panel is satisfied that the Complainant is the owner of the trademarks SPONGEBOB and SPONGEBOB SQUAREPANTS registered in several jurisdictions.

The disputed domain name entirely incorporates the Complainant's trademark SPONGEBOB SQUAREPANTS, without any addition. As numerous prior UDRP panels have held, the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity. In accordance with section 1.11.2 of the [WIPO Overview 3.0](#), the practice of disregarding the generic Top-Level Domain ("gTLD") in determining identity or confusing similarity is applied irrespective of the particular TLD, thus addition of gTLD ".com" to the disputed domain name does not impact the identity or confusing similarity. Disregarding the gTLD ".com", the Panel notes that the disputed domain name is identical to the Complainant's trademark.

In the light of the above, the Panel finds that the disputed domain name is identical to the Complainant's registered trademarks and that the requirements in paragraph 4(a)(i) of the Policy are fulfilled.

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 names such as those enumerated in the Policy or otherwise.

The Panel notes that the Respondent does not have any registered trademarks or trade names and no license or authorization of any other kind has been given to the Respondent by the Complainant to use its registered trademark.

The Panel also notes that there is no evidence of the Respondent's 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. Rather, the disputed domain name resolves to a PPC parking page which

contains third parties' sponsored links through the listed keywords related to the trademarks and business field of the Complainant according to the Complainant's assertion and the Exhibit F of the Complaint. When the website to which the disputed domain name resolves, is checked, it is seen that there is a statement "The domain spongebobsquarepants.com may be for sale. Click here to inquire about this domain" on the website and when it is clicked, it redirects to a third party's website that has been selling domain names and it is offered to sell the disputed domain name within the range of USD 5,175 and USD 6,883. The Panel points that hosting a PPC parking page with links that compete with or capitalize on the reputation and goodwill of the Complainant's trademark and from which the Respondent most probably derives commercial revenue neither represent a bona fide offering nor constitute rights or legitimate interests to the Respondent in the disputed domain name in the circumstances of this case.

Furthermore, UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation. Here, noting the disputed domain name is identical to the Complainant's trademark, there is a high risk of implied affiliation and such composition cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

As a result, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name, and the requirements of paragraph 4(a)(ii) of the Policy are therefore fulfilled by the Complainant.

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.

In the present case, the Panel is satisfied with the relevant evidence filed by the Complainant showing that it owns trademark rights for SPONGEBOB and SPONGEBOB SQUAREPANTS, which have been registered and used prior to the registration of the disputed domain name and the Panel confirms the Complainant's trademarks SPONGEBOB and SPONGEBOB SQUAREPANTS are well known around the world.

The Panel is of the opinion that it is implausible for the Respondent to be unaware of the Complainant and its well known trademark when the disputed domain name was registered, and the Respondent's aim of the registration was to take an unfair advantage of the Complainant's trademark. As the disputed domain name wholly incorporates the Complainant's well-known trademark SPONGEBOB SQUAREPANTS, that gives an impression that the disputed domain name is owned and used by the Complainant. Several UDRP panels have held that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

As stated above the disputed domain name resolves to a parking page which contains third parties' sponsored links through the listed keywords related to the trademarks and business field of the Complainant and there is a statement that the disputed domain name may be for sale. The Panel is in the opinion that the object of registering the disputed domain name consisting of the Complainant's trademark was to mislead the Internet users and allowing the PPC links related to the field of the Complainant in the website to which the disputed domain name resolves for commercial gain. It has been established in numerous UDRP decisions that such conduct constitutes bad faith of the Respondent set out at paragraph 4(b)(iv) of the Policy.

The Complainant alleges that it had sent a cease-and-desist letter to the Respondent on June 13, 2024 before filing the Complaint, but the Respondent has not responded to that letter. Referring to the Panel's consideration in *Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. [D2002-0787](#), and considering the reasons above, the Panel is of the opinion that the failure to reply to the Complainant's letter and to the Complaint further supports in the circumstances of this case the Panel's finding of bad faith.

Having considered all the facts in this case, the Panel finds that the Complainant has sustained its burden of proof in showing that the disputed domain name was registered and being used in bad faith.

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 <spongebobsquarepants.com> be transferred to the Complainant.

/Ugur G. Yalçiner/

Ugur G. Yalçiner

Sole Panelist

Date: September 26, 2024