

1. Ownership of the SHARETV Service Mark

Plaintiff is the owner of U.S. Registration No. 3,947,657 for the SHARETV service mark. (Compl. ¶ 23.) Plaintiff's ownership of said service mark constitutes evidence of valid and exclusive ownership of the SHARETV service mark in connection with an online television community for fans of network television. 15 U.S.C. §§ 1057(b) and 1115(a); *see Harrods Ltd. v. Sixty Internet Domain Names*, 302 F. 3d 214, 229 (4th Cir. 2002) (stating that although it is use of the mark not registration that confers trademark protection, registration does confer certain benefits on the owner and registration serves as *prima facie* evidence of the mark's validity). Further, after Plaintiff proves that Plaintiff is the owner of the federally registered SHARETV service mark, it is Defendant's burden to dispute the presumption of Plaintiff's exclusive rights in the SHARETV service mark. *H. Jay Spiegel & Associates, P.C. v. Spiegel*, 652 F. Supp. 2d. 639, 645 (E.D. Va. 2009) (explaining that service mark registration shifts the burden of proof to the defendant who must rebut plaintiff's right to the mark's exclusive use). Because Defendant has failed to respond to Plaintiff's allegations in the instant case, and because upon default Defendant concedes Plaintiff's allegations, Plaintiff has established its exclusive rights to the SHARETV service mark.

2. Registrant uses the SHARETV Service Mark in Commerce

Plaintiff also has sufficiently alleged that Registrant's use of the Domain Name is preventing and hindering internet users from accessing Plaintiff's website and its subsequent services. 15 U.S.C. §§ 1141(1), 1125(a); *see PETA*, 263 F.3d at 365 (holding that the defendant's use of PETA's mark in connection with goods and services does not mean that the defendant needed to sell or advertise services on PETA's website; instead, the defendant only needed to prevent users from obtaining or using PETA's good or services). Specifically, the use of an infringing mark in the

domain name of a website is likely to prevent internet users from reaching Plaintiff's website because "[t]he prospective users of [plaintiff's] services who mistakenly access Defendant's web site may fail to continue to search for [plaintiff's] own home page, due to anger, frustration, or the belief that [plaintiff's] home page does not exist." *PETA*, 263 F.3d at 366 (citing *PETA v. Doughney*, 113 F. Supp. 2d 915, 919 (E.D. Va. 2000)). Further, inclusion of a mark in a domain name, where the domain name reroutes users to a website listing websites related to a plaintiff's services or directing visitors to unrelated commercial sites, constitutes use "in commerce." See *Avalere Health LLC v. Avalere.org*, No. 1:12-cv-00997, 2013 WL 1790137, at *5 (E.D. Va. Apr. 10, 2013).

Registrant modified the Domain Name website <sharetv.com> to prominently display Plaintiff's SHARETV service name in Korean and to describe an online television service that would be shortly in service. (Compl. ¶ 38.) Consequently, prospective users of Plaintiff's online television community who mistakenly access the Defendant Domain Name are likely to stop searching for Plaintiff's true homepage due to annoyance or under the belief that Plaintiff's website does not exist or is not yet online. Further, prior to Registrant's change of the Domain Name website to its current form, Registrant previously used the Domain Name in connection with several "parked" pages and revenue-generating sponsored links to websites in competition with Plaintiff. (Compl. ¶ 31; see Pl. Ex. H.) Thus, Registrant's use of the Domain Name establishes the "use in commerce" conduct under §§ 32(1) and 43(a) of the Lanham Act, 15 U.S.C. §§ 1141(1) and 1125(a).

3. Likelihood of Confusion

A likelihood of confusion exists "if the defendant's actual practice is likely to produce confusion in the minds of consumers about the origin of goods or services in question." *George & Co.*, 575 F. 3d at 393. In assessing the confusion, the standard is "how the two parties actually use

their marks in the marketplace to determine whether the defendant's use is likely to cause confusion." *George & Co.*, 575 F.3d at 393. The Fourth Circuit set out nine factors to assess whether a likelihood of confusion exists including: (1) the strength or distinctiveness of the plaintiff's mark as actually used in the marketplace; (2) the similarity of the two marks to consumers; (3) the similarity of the goods or services that the marks identify; (4) the similarity of the facilities used by the two parties; (5) the similarity of advertising used by the two parties; (6) the defendant's intent; (7) actual confusion; (8) the quality of the defendant's product; and (9) the sophistication of the consuming public. *See George & Co.*, 575 F.3d at 393; *see also Louis Vutton*, 507 F.3d at 259. Not all of these factors are of equal importance, nor are they always relevant in any given case. *See Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.2d 316, 320 (4th Cir. 1992). Further, evidence of actual confusion, is weighed most heavily in the likelihood-of-confusion analysis. *See Lyons P'ship, L.P. v. Morris Costumes, Inc.*, 243 F.3d 789, 804 (4th Cir. 2001); *see also Lone Star Steakhouse*, 43 F.3d at 937.

In assessing the likelihood of confusion, this Court examines eight of the nine relevant factors within the nine factor test.¹¹

a. Strength of Distinctiveness of Plaintiff's Mark

Since 2007, Plaintiff has grown significantly and incurred numerous followers and users. (*See Compl.* ¶ 16.) Thus, due to Plaintiff's expansive online television business, including fifty million total users and two million monthly users, it follows that Plaintiff's SHARETV service mark

¹¹ Factor eight is not relevant and will not be discussed because it pertains to the quality of the defendant's product, and is applicable in situations where defendant is allegedly engaged in the production of cheap copies or knockoffs of a competitor's trademark-protected goods. *See Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 467 (4th Cir. 1996).

is recognizable. (*Id.* ¶ 15.) Plaintiff has also heavily invested in advertising and promoting its online television website and services in connection with the SHARETV mark. (*Id.* ¶ 18.)

Consequently, the commercial value of the SHARETV service mark is strong enough to enhance the confusion of actual and potential consumers. *See George & Co.*, 575 F.3d at 393 (“Generally, the stronger the mark, the greater the likelihood that consumers will be confused by competing uses of the mark.”). Because Plaintiff federally registered its SHARETV service mark, the mark is presumed inherently distinctive and its registration constitutes *prima facie* evidence that the mark is not generic or merely descriptive. *See U.S. Search, LLC v. U.S. Search.com Inc.*, 300 F.3d 517, 524 (4th Cir. 2002). In total, this Court finds that the foregoing illustrates that Plaintiff’s SHARETV mark is both distinctive and strong.

b. Similarity of the Marks

Because the Domain Name is virtually identical to the SHARETV service mark, save the additional <“.com”>, and also because this additional part is not a part of the actual service mark, the marks appear identical.

The Fourth Circuit has held that a likelihood of confusion exists when a domain name is identical to the mark in question, regardless of whether confusion about a website’s source or sponsorship could be resolved by visiting the plaintiff’s true website. *See Newport News Holdings Corp. v. Virtual City Vision, Inc.*, 650 F.3d 423, 437 (4th Cir. 2011); *see also Investtools, Inc. v. Investtools.com*, et al., No. 1:06-cv-00210, 2006 WL 2037577, at *3 (E.D. Va. July 17, 2006) (“[t]he addition of a “.com” to the plaintiff’s mark is of minimal importance in distinguishing the mark and diminishing the likelihood of confusion, as many internet users are likely to associate the [d]efendant domain names with the [plaintiff’s] mark.”).

Registrant's addition of ".com" to the Plaintiff's SHARETV service mark to create the Defendant Domain Name may actually enhance the likelihood of confusion between the SHARETV service mark and the Domain Name because many Internet users may mistakenly associate the Domain Name with the SHARETV service mark and business. *See id.* The fact that the Domain Name is nearly identical to the SHARETV service mark in terms of appearance, sound, and meaning weighs heavily in favor of a likelihood of confusion. *See George & Co.*, 575 F.3d at 396. Thus, due to the similarity of the Plaintiff's SHARETV mark and the mark Registrant's uses in the Domain Name, this Court finds that the marks are nearly identical.

c. Similarity of the Goods/Services

The Defendant's Domain Name website purports to be the home page of Plaintiff's SHARETV and displays the messages: "The TV that we share with neighbors" and "Coming Soon." (Compl. ¶ 38.) Although the Domain Name website does not currently offer any identifiable goods or services, if Registrant acts on his published statements that TV services will be "Coming Soon," it is likely that Registrant will utilize the Domain Name to offer competing services to those offered by Plaintiff. *See George & Co.*, 575 F.3d at 397. Thus, because Registrant purports to offer the same services as Plaintiff in the future, this Court finds that the goods and services to be rendered are similar.

d. Similarity of Facilities Used in Business

Defendant's Domain Name website and Plaintiff's website both use the internet to connect with consumers. The use of substantially identical means by both the Plaintiff and Defendant to facilitate services to consumers weighs in favor of finding a likelihood of confusion. *See Eurotech, Inv. v. Cosmos European Travels Aktiengesellschaft*, 213 F. Supp.2d 612, 622-23 (E.D. Va. 2002)

(explaining that the fourth factor weighs in favor of finding a likelihood of confusion where both parties used the internet to facilitate services to consumers). Thus, upon comparison of the facilities used by both Plaintiff and Registrant, this Court finds that the facilities are identical.

e. Similarity of Advertising

Since Plaintiff's business began in 2007, Plaintiff has conducted business and collected revenue in connection with the SHARETV service mark and trade name. (Compl. ¶18.) In addition, Plaintiff has invested heavily in online advertising and promotion for its television community and services offered under the SHARETV service mark. (*Id.*) Registrant does not have the same longevity, advertising, and promotion services as Plaintiff. In fact, Registrant's only advertising contains the phrase "Coming Soon" alongside the phrase "The TV that we share with neighbors." (*See id.* ¶ 39). However, the advertising does use the same facility, being the internet, and targets the same consumer audience. *See Sara Lee*, 81 F.3d at 465. Further, Registrant's lack of advertising suggests that Registrant sought to obtain a free ride off the SHARETV service mark reputation and the advertising efforts of Plaintiff. *See Eurotech*, 213 F. Supp. 2d at 623 (finding that a lack of advertising by a domain holder suggests that the domain holder "sought to obtain a free ride off the goodwill of the [trademark owner's] registered trademarks."). Thus, although the advertising quality and quantity between the two parties is not similar, because they share the same medium and audience, this Court finds that as a whole, these factors minimally weigh in favor of the likelihood of confusion by consumers.

f. Registrant's Intent

Registrant's intent can be inferred by a series of events including: a pattern of registering and using over 1,500 domain names; the lack of the Defendant Domain Name's use in connection with

any *bona fide* goods or services; Plaintiff's cease-and-desist letter to Registrant putting Registrant on notice of his infringing use; and Registrant's modification of the Defendant Domain Name shortly after discussions with Plaintiff. (Compl. ¶¶ 25-28, 32, 35-36.) Although intent to deceive is not required for a finding of confusion, if there is intent to confuse the public, this intent constitutes strong evidence of establishing a likelihood of confusion. *See Pizzeria Uno*, 747 F.2d at 1535. Thus, as evidenced by the aforementioned events on the part of Registrant, the undersigned concludes that Registrant's actions were done with the deliberate intent to deceive potential and actual users/consumers of Plaintiff's website.

g. Actual Confusion

A defendant's conduct which results in actual confusion among consumers is one of the most heavily weighed factors in ascertaining the existence of a likelihood of confusion. *See Sara Lee*, 81 F.3d at 467. To date, multiple users of Plaintiff's website have reported their confusion between Registrant's Domain Name and Plaintiff's website. (Compl. ¶¶ 39, 42.) Additionally, a writer for the *New York Post's* on-line newspaper confused Defendant Domain Name with Plaintiff's domain name, which confirms that a variety of consumers are actually confused by Registrant's use of the Domain Name. (*Id.* ¶ 39; Pl. Ex. K.) Therefore, the undersigned finds that Plaintiff pleads clear evidence that actual confusion between the Domain Name and Plaintiff's website has occurred.

h. Sophistication of the consuming public

Along with the consuming public, a writer for the *New York Post's* online newspaper, a recognizable publication, confused Plaintiff's website with Defendant Domain Name. (Compl. ¶ 39; Pl. Ex. K.) Such confusion constitutes adequate evidence of confusion by both the general public as well as sophisticated users. *See Sara Lee*, 81 F.3d at 647 (stating that if the typical

consumer in the relevant market is sophisticated in the use of, or possesses an expertise regarding a particular product, such sophistication or expertise may be pertinent in determining the likelihood of confusion).

Accordingly, upon review of the record and after giving weight to the aforementioned factors, the undersigned finds that Plaintiff has sufficiently plead that Registrant's actions in connection with Defendant Domain Name result in a clear finding that such actions are likely to cause confusion to consumers. Thus, this Court finds that Registrant's use of Plaintiff's SHARETV mark in the Domain Names constitutes trademark infringement under 15 U.S.C. §§ 1114 and 1125(a) as well as Va. Code § 59.1-92.12 and Virginia's common law requirements for unfair competition.

B. Count Three: Virginia Consumer Protection Act

Pursuant to Va. Code § 59.1-200(A)(2), (3) and (14), the Virginia Consumer Protection Act, it is unlawful to "misrepresent the source, sponsorship, approval, or certification of goods or services . . . misrepresent[] the affiliation, connection, or association of the supplier, or of the goods or services, with another . . . [or] use any other deception, fraud, false pretense, false promise, or misrepresentation in connection with a consumer transaction." Defendant Domain Name purports to be the home page of Plaintiff, and displays the messages: "The TV that we share with neighbors" and "Coming Soon." (Compl. ¶ 38.) Further, Defendant Domain Name's failure to use the website in connection with any *bona fide* goods or services, Plaintiff's cease-and-desist letter to Registrant making Registrant aware of his infringing use, and Registrant's modification of the Domain Name shortly after discussions with Plaintiff show an attempt by the Registrant to misrepresent affiliation, connection, or association of SHARETV with Plaintiff in violation of the Virginia Consumer Protection Act, Va. Code § 59.1-200.

In sum, this Court finds that Registrant's use of Plaintiff's SHARETV mark in connection with Defendant Domain Name constitutes trademark infringement under 15 U.S.C. §§ 1114 and 1125(a) as well as Virginia's common law requirements for unfair competition, Va. Code § 59.1-92.12, and the Virginia Consumer Protection Act, Va. Code § 59.1-200.

IV. REQUESTED RELIEF

Although Plaintiff's Complaint seeks several remedies (*see* Compl. at 20-22), Plaintiff's Motion for Default Judgment asks only for the transfer of the Domain Name to Plaintiff.¹² Under § 43(d)(2) of the Lanham Act, the relief for an *in rem* proceeding is forfeiture or cancellation of the domain name or transfer of the domain name to the owner of the trademark. Since the registry for Defendant Domain Name, Verisign Inc., is located within this judicial district and subject to the Court's jurisdiction, this Court may properly order Verisign Inc. to transfer the Defendant Domain Name to Plaintiff's chosen registrar, eNom, Inc.¹³ so that eNom, Inc. may register the Domain Name in Plaintiff's name.

V. RECOMMENDATION

For the reasons set forth above, the undersigned Magistrate Judge recommends the entry of default judgment in favor of Plaintiff against Defendant Domain Name <sharetv.com> for violations of 15 U.S.C. §§ 1114 and 1125(a) as well as Virginia law for unfair competition and the Virginia Consumer Protection Act. The undersigned Magistrate Judge recommends that an Order be entered directing registrar VeriSign, Inc. to immediately and permanently transfer to Plaintiff all proprietary and ownership rights to the name <sharetv.com> and to transfer the Defendant Domain Name to

¹² Thus, this Report and Recommendation will only make a recommendation as to the transfer of Defendant Domain Name. (*See* Pl. Motion. Supp. Def. J. at 25-26).

¹³ *See* Pl.'s Mem. Supp. Def. J. at 26 (listing Plaintiff's preferred Registrar).

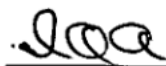
eNom, Inc, the registrar of Plaintiff's choosing pursuant to 15 U.S.C. § 1125(d)(1)(C).

VI. NOTICE

By mailing copies of this Report and Recommendation, the parties are notified as follows. Objections to this Report and Recommendation, pursuant to 28 U.S.C. § 636 and Rule 72(b) of the Federal Rules of Civil Procedure, must be filed within fourteen (14) days of service on you of this Report and Recommendation. A failure to file timely objections to this Report and Recommendation waives appellate review of the substance of the Report and Recommendation and waives appellate review of a judgment based on this Report and Recommendation.

The Clerk is directed to send a copy of this Report and Recommendation to all counsel of record and the Registrant at the following mailing and email addresses:

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 /s/

Ivan D. Davis
United States Magistrate Judge

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Alexandria, Virginia