



## DECISION

Tickets.com, Inc. v. H.A. Woofer Smith  
Claim Number: FA0309000196048

### PARTIES

Complainant is **Tickets.com, Inc.**, Costa Mesa, CA (“Complainant”) represented by **Philip I. Frankel, Esquire of Bond, Schoeneck & King, PLLC**, One Lincoln Center, Syracuse, NY 13202-1355. Respondent is **H.A. Woofer Smith**, Houston, TX, (“Respondent”) represented by **Patrick W. Fletcher, Esquire of Fletcher Law Offices**, 427 E. 17<sup>th</sup> Street, Suite 325, Costa Mesa, CA 92627.

### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<wwwtickets.com>**, registered with **Network Solutions, Inc.**

### PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

**M. KELLY TILLERY, ESQUIRE** as Panelist

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on September 15, 2003; the Forum received a hard copy of the Complaint on September 18, 2003.

On September 22, 2003, Network Solutions, Inc. confirmed by e-mail to the Forum that the domain name **<wwwtickets.com>** is registered with Network Solutions, Inc. and that the Respondent is the current registrant of the name. Network Solutions, Inc. has verified that Respondent is bound by the Network Solutions, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On September 24, 2003, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of October 14, 2003 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@wwwtickets.com by e-mail.

A timely Response was received and determined to be complete on October 14, 2003.

An Additional Submission was timely received from Complainant and was determined to be complete on October 16, 2003.

On October 23, 2003, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Forum appointed **M. KELLY TILLERY, ESQUIRE** as Panelist.

### **RELIEF SOUGHT**

Complainant requests that the domain name be transferred from Respondent to Complainant.

### **PARTIES' CONTENTIONS**

#### **A. COMPLAINANT**

Complainant contends that:

1. it is the owner of the TICKETS.COM mark and a logo incorporating the words TICKETS.COM in both the U.S. and abroad;
2. it has been using the word mark and logo as early as August 1997;
3. the logo consists of two elliptical designs with the words TICKETS.COM going through it;
4. its mark and logo were registered with the United States Patent and Trademark Office ("USPTO") on June 25, 2002 under Registration No. 2,584,197 in Classes 39, 41 and 42 and on November 12, 2002 under Registration No. 2,649,091 in Class 41;
5. it provides numerous services through its website <tickets.com>, selling tickets to sports and entertainment events, providing information about pending concerts, plays and sporting events and allowing viewers to buy tickets online;
6. it has two pending applications for the word mark TICKETS.COM with the USPTO;
7. it has also registered and has applications pending throughout the world in several countries for both the word mark and the logo as reflected in an attached chart;
8. a competitor, Ticket Vault, Inc., provides similar services through its website <ticketvault.com>, a domain name registered by Woofer Smith, a principal in Ticket Vault, Inc.;
9. the domain name <wwwtickets.com> was created on May 4, 2002, years after Complainant was online and approximately three years after the Ticket Vault, Inc. website was active;
10. when one types in the disputed domain name, it links the browser directly to the <ticketvault.com> website;
11. the registration of <wwwtickets.com> is "typosquatting" and an attempt to direct the public away from Complainant's website if they mistype Complainant's mark;
12. it became aware of the domain name and sent a cease and desist letter to Respondent on or about August 22, 2003; to date, there has been no response and the domain name continues to exist;

13. the domain name is confusingly similar to TICKETS.COM because it incorporates Complainant's mark in its entirety and includes the strategic addition of the "www" prefix;
14. Respondent is not using the domain name in connection with a bona fide offering of goods and services, but rather to steal business away from a direct competitor based solely on a customer's unknowing typographical error;
15. Respondent is not commonly known by the domain name;
16. Respondent has not used the domain name in connection with a legitimate, non-commercial use.

## B. RESPONDENT

Respondent contends that:

1. registration of Complainant's logo is valid and protects Complainant's mark with regard to the distinctive design of the logo;
2. Complainant does not possess a federal registration of the word mark TICKETS.COM alone;
3. the word mark TICKETS.COM cannot serve as a valid common law trademark because it is generic as applied to a company that sells tickets;
4. both USPTO registrations of Complainant specifically state that "NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE 'TICKETS.COM', APART FROM THE MARK AS SHOWN";
5. Complainant has offered only a self-made spreadsheet to substantiate its claim of foreign registrations;
6. even if such registrations do in fact exist, as both the Complainant and the Respondent are residents of and have their principal places of business in the United States, the trademark laws of the United States should be applied;
7. before any notice of this dispute, Respondent used the domain name in connection with a bona fide offering of goods or services;
8. Respondent admits registering the domain name to attract people seeking tickets on the Internet;

## C. **ADDITIONAL SUBMISSIONS**

### A. COMPLAINANT

Complainant further contends that:

1. Respondent's failure to provide evidence of genericness or descriptiveness is fatal to Respondent's case;

2. copies of the actual international registrations are attached as an Exhibit;
3. the fact that the TICKETS.COM mark, a word mark without the design, has been registered in foreign countries is alone enough;
4. the TICKETS.COM mark is at the very least, suggestive of the services recited in several of its registrations;
5. Complainant can have (and indeed has) legitimate rights by virtue of its use of the mark across a broad spectrum of different goods and services.

### **FINDINGS**

1. Complainant has not met its burden to prove by a preponderance of the credible, relevant, admissible evidence that Respondent's domain name is confusingly similar to a mark in which Complainant has rights. Policy ¶ 4(a)(i).
2. Complainant has not met its burden to prove by a preponderance of the credible, relevant, admissible evidence that Respondent has no rights or legitimate interest in respect to the domain name. Policy ¶ 4(a)(ii).
3. Complainant has not met its burden to prove by a preponderance of the credible, relevant, admissible evidence that Respondent's domain name has been registered and is being used in bad faith. Policy ¶ 4(a)(iii).

### **DISCUSSION**

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

### **Identical and/or Confusingly Similar**

The United States Patent and Trademark Office ("USPTO") Trademark Electronic Search System (TESS) reveals a bit more information about Complainant's trademark registrations and applications than Complainant has seen fit to disclose to the Panel. As a United States Government Public Record, the Panel takes judicial notice of same.

Complainant actually owns four (4) service marks registered with the USPTO.

<b><u>MARK</u></b>	<b><u>USPTO REGISTRATION NUMBER</u></b>	<b><u>REGISTRATION DATE</u></b>	<b><u>CLASS(ES)</u></b>	<b><u>DISCLAIMER(S)</u></b>
TICKETS.COM	2649091	11/12/01	41	<u>No claim</u> to exclusive

(Design plus letters) right to use “tickets.com” apart from as shown.

TICKETS.COM (Design plus letters)	2584197	6/25/02	42	<u>No claim</u> to exclusive
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“tickets.com” apart  
from as shown.

TICKETS.COM 1-800-TICKETS (Design plus words and numbers)	2621143	9/17/02	41	<u>No claim</u> to exclusive right to use “tickets.com 1-800-tickets” apart from mark as shown.
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TICKETS.COM 1-800-TICKETS (Design plus words and numbers)	2613620	9/3/02	42; 41; 39	<u>No claim</u> to exclusive right to use “tickets.com 1-800- tickets” apart from mark as shown.
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Complainant attempted to register the TICKETS.COM mark as a word/service mark on August 7, 1998 with a disclaimer of exclusive rights to “.com” only apart from the mark as shown in Classes 39 and 42. The USPTO refused to register the mark and the Trademark Trial and Appeal Board dismissed Complainant/Applicant’s Application on September 2, 2002.

Complainant tried again to register the word mark TICKETS.COM as a word/service mark but this time on the USPTO Supplemental Register in Classes 35, 41 and 42. On September 16, 2002, the USPTO Examining Attorney mailed a “Non-Final Action” letter “requesting additional information and/or making an initial refusal.” No final determination as to registerability has been made.

Thus, as things stand at present, Complainant has no U.S. registered mark for TICKETS.COM as a word mark and four (4) registered Design/Word marks having “TICKETS.COM” as part thereof. However, each of those four (4) registrations specifically and clearly disclaims any exclusive right to use the words TICKETS.COM as a mark apart from the stylized, design marks which incorporate same.

Under these circumstances, none of Complainant’s U.S. registrations establish rights in a mark as required by Policy ¶ 4(a)(i).

This, however, does not end this inquiry. Registration with the USPTO is not prerequisite to a Complainant establishing that it has rights in a mark under Policy ¶ 4(a)(i). A Complainant may establish “rights in a mark” by proving that it has common law rights in the United States to the mark and/or even registrations and/or common law rights in the mark in another country or countries.

Complainant claims use of TICKETS.COM as a “word mark and logo” as early as August 1997. Although Complainant’s only “evidence” of same is a copy of two (2) of the four (4) aforementioned Registrations for Design/Word Marks, Respondent does not dispute this claim. Complainant has also alleged widespread use of the mark since then throughout the U.S. (and the world) and Respondent also does not dispute same. Thus, Complainant just might have “rights in the mark” under U.S. common law, if not the “common law” of other nations.

However, Complainant further contends that it has registrations for “TICKETS.COM” in Argentina, Denmark, France, Germany, Indonesia and Tunisia and for “TICKETS.COM & DESIGN” in Argentina, Australia, Benelux,

Canada, European Community, Denmark, France, Germany, Indonesia, Japan, South Korea, New Zealand, Spain, Switzerland, Taiwan and United Kingdom. As Respondent points out, Complainant first submitted only a chart/list of these alleged registrations, with dates, numbers and nations. No official documents were submitted and Respondent disputes same.

Under these circumstances and especially in light of Complainant's lack of candor with this forum regarding its USPTO Registrations, the Panel is unable to lend any credence to Complainant's claims regarding these foreign registrations. Unfortunately, for reasons of limited access, cost, language differences and unfamiliarity with the trademark law of the seventeen (17) foreign jurisdictions involved, this Panel cannot take judicial notice of any public record readily available.

Complainant has, however, now, filed an Additional Submission replying to Respondent's arguments, including this one and attaching purported copies of foreign registrations as aforementioned.

For purposes of this discussion, the Panel will assume that the supplemental documentation provided by Complainant does establish that it owns valid registrations for TICKETS.COM as a word mark only, without any disclaimers, in several other countries. Without the tools referenced above, the Panel is unable to determine the strength of this evidence<sup>[1]</sup>, but need not do so for reasons set forth below.

Under U.S. trademark law and some UDRP precedent, registration of a mark creates a rebuttable presumption of acquired secondary meaning and inherent distinctiveness. *See Men's Wearhouse, Inc. v. Wick*, FA117861 (Nat. Arb. Forum Sept. 16, 2002); *see also Janes Int'l. Holding Co. v. Rademacher*, D2002-0201 (WIPO Mar. 5, 2002). Complainant has no U.S. registration for TICKETS.COM as a word mark alone and/or without a disclaimer, but the Panel will grant Complainant said presumption based upon the unrebutted evidence of foreign registrations.

Complainant sells tickets. Its claimed mark is TICKETS.COM.<sup>[2]</sup> The primary significance of the word TICKETS is of a type of license or commodity; it cannot possibly be as an indicator of Complainant as the source of "tickets." Complainant and Respondent and thousands of others sell TICKETS. Under these circumstances, its "mark" is generic. No one has or can have exclusive rights in and to same. *See Historical Research Ctr. Int'l Inc. v. artrampage.com*, FA 110772 (Nat. Arb. Forum June 20, 2002); *Energy Source, Inc. v. Your Energy Source*, FA 96364 (Nat. Arb. Forum Feb. 19, 2001); *ABC Inc. v. Genius, Inc.*, FA 104582 (Nat. Arb. Forum Apr. 12, 2002); *Efutures.com LLC v. Canon Trading Co.*, FA 103056 (Nat. Arb. Forum Feb. 27, 2002); *See generally* R. Badgley, *Domain Name Disputes* Section 2.04 [A] (Aspen Law & Business 2002); Gilson, *Trademark Law & Practice*, Section 2.02 (Matthew Bender 2000). Even if this "mark" could be considered merely descriptive or suggestive, Complainant has failed to demonstrate that the term has acquired secondary meaning. *See ABC Inc. v. Genius, Inc.*, FA 104582 (Nat. Arb. Forum Apr. 12, 2002); *see also Cyber Imprints.com, Inc. v. Alberga*, FA 100608 (Nat. Arb. Forum Dec. 11, 2001). Complainant cannot have rights in the mark as required by Policy ¶ 4(a)(i).

Under these circumstances, Complainant has thus not met its burden of proof under Policy ¶ 4(a)(i).

### **Rights or Legitimate Interests**

Since a complainant must prove all three (3) points under Policy ¶ 4(a) and Complainant herein has not proven the first, it is unnecessary to reach the second. However, it is not disputed that (1) Respondent sells tickets online, (2) that the domain name in question leads one to Respondent's site (though indirectly) at which it sells tickets and has done so since at least May of 2002, (3) that the domain name in question was created/registered on May 4, 2002 and (4) that the earliest possible notice of this dispute to Respondent was in August of 2003.

Under these circumstances, Policy ¶ (4)(c)(i) supports Respondent's contention that it has rights and/or legitimate

interests in respect of the domain name in accord with Policy ¶ 4(a) (ii). Complainant has thus failed to meet its burden of proof on this second necessary element as well.

### **Registration and Use in Bad Faith**

Since a complainant must prove all three (3) points under Policy ¶ 4(a) and Complainant herein has not proven the first two, it is unnecessary to reach the third element. However, this Panel also finds no evidence of registration or use in bad faith, primarily for the same reasons set forth hereinabove.

### **DECISION**

Complainant having failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

Accordingly, it is Ordered that Complainant's Complaint be and hereby is dismissed.

**M. KELLY TILLERY, ESQUIRE, Panelist**

Philadelphia, Pennsylvania

Dated: November 14, 2003

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[1] Complainant did not provide certified copies of the registrations, translations and/or citation to any foreign law to support its claim.

[2] The suffix is irrelevant to this analysis.

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