

Ringling Bros. - Barnum & Bailey Combined Shows Inc. v. Lima, 74 USPQ2d 1887 (Arb 2005)

74 USPQ2D 1887
Ringling Bros. - Barnum & Bailey Combined Shows Inc. v.
Lima

Arbitration

No. 49-413-000002-05
Decided May 13, 2005

Headnotes

REMEDIES

[1] Monetary — Attorneys' fees; costs — Trademarks and unfair trade practices — In general (§510.0907.01)

Administrative panel hearing dispute over Internet domain name lacks authority to order respondent to reimburse complainant for latter's filing fees, since, pursuant to usTLD Dispute Resolution Policy,

remedies that administrative panel can order are expressly limited to either cancelling or transferring domain name.

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TRADEMARKS AND UNFAIR TRADE PRACTICES

[2] Infringement; conflicts between marks — Likelihood of confusion —Particular marks — Confusion likely (§335.0304.03)

Respondent's use of Internet domain name "ringling.us" is likely to result in confusion, even though respondent avers that domain name is intended for Web site relating to city of Ringling, Okla., since complainant's "Ringling" marks have achieved fame, renown, reputation, and worldwide recognition since their first use in 1919, particularly in field of circus entertainment, since Internet user entering "ringling.us" into browser would most likely intend to access Web site connected with complainant, since "ringling.us" domain name was reserved for city of Ringling for two years, but city chose not to register, thereby indicating city's recognition that Internet users would not seek to access Web site providing information about city through disputed domain name, since respondent has not developed such Web site, and since Internet users accessing Web site through disputed domain name would be likely to wrongly assume that respondent, or third-party transferee, was somehow affiliated with complainant.

[3] Infringement; conflicts between marks — Likelihood of confusion —Particular marks — Confusion likely (§335.0304.03)

Infringement; conflicts between marks — Willful (§335.11)

REMEDIES

Non-monetary and injunctive — Equitable relief — Seizure; forfeiture (§505.0703)

Complainant is entitled to order, pursuant to usTLD Dispute Resolution Policy, requiring respondent to transfer Internet domain name “ringling.us” to complainant, even though respondent avers that domain name is intended for Web site relating to city of Ringling, Okla., since disputed domain name contains term “Ringling,” under which complainant provides products and services and by which complainant is known, since complainant has no relationship with respondent and has never authorized respondent to use “Ringling” marks, since respondent has not developed operational Web site using disputed domain name, and complainant was not required to wait for respondent to establish rights or legitimate interests in domain name before enforcing its trademark rights, since record suggests that respondent, in asserting that he intended to assist city with its financial troubles, is merely attempting to retroactively manufacture evidence to counter bad-faith registration of domain name, and since respondent's knowledge of complainant's activities under “Ringling” marks indicates his intent to intentionally cause and then exploit inevitable confusion by securing compensation from complainant in exchange for eliminating that confusion.

Case History and Disposition

Complaint filed by Ringling Bros.-Barnum & Bailey Combined Shows Inc., pursuant to usTLD Dispute Resolution Policy, against respondent Kenneth Lima. Complainant requests that Internet domain name “ringling.us” be transferred from respondent to complainant, and that respondent be ordered to reimburse complainant for filing fees. Transfer granted; request for order of reimbursement denied.

Attorneys:

Julie A. Strauss, Ringling Bros. - Barnum & Bailey Combined Shows Inc., Vienna, Va.; Laura E. Goldbard, of Stroock, Stroock and Lavan, New York, N.Y., for complainant.

Kenneth Lima, Altamonte Springs, Fla., pro se.

Opinion Text

Opinion By:

Michaelson, panelist.

1. The Parties

The Complainant is Ringling Bros.-Barnum & Bailey Combined Shows, Inc. of Vienna, Virginia US 22182 represented by Julie A. Strauss, Vice President and Corporate Counsel of Complainant and by Laura E. Goldbard of Stroock, Stroock and Lavan 180 Maiden Lane, New York, New York 10038-4982.

The Respondent is Kenneth Lima of Altamonte Springs, Florida US, represented pro se.

2. The Domain Name and Registrar

The disputed domain name <ringling.us> is registered with Blue Razor Domains, Inc.

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3. Procedural History

The Complaint was brought pursuant to the usTLD Dispute Resolution Policy (the “Policy”), available at <www.neustar.us/policies/docs/usdrp.pdf>, which was approved by the U.S. Department of Commerce (DOC) on February 21, 2002, and in accordance with the Rules for usTLD Dispute Resolution Policy (the “Rules”), and by the American Arbitration Association (AAA) Supplemental Rules for Domain Name Disputes (the “Supplemental Rules”).

The Complaint was filed on-line with the AAA on February 28, 2005, and subsequently in

hard-copy form on March 18, 2005, along with Exhibits A1-E2.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the AAA as the DOC approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single member panel.

After receiving the Complaint, the AAA, in accordance with Paragraph 4 of the Supplemental Rules, determined whether that Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, the AAA verified registration details, including contact and registrant information, of the disputed domain name from the WhoIS database maintained by the Registrar.

On March 21, 2005, the AAA notified the Respondent, by e-mail, of the filing of the Complaint and set a deadline of April 11, 2005 by which the Respondent could file a Response to the Complaint. By virtue of the March 21, 2005 notification, under the paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

The Respondent was then provided with a 20-calendar day period, expiring on April 11, 2005, to file its Response with the AAA and serve a copy of the Response on the Complainant.

Subsequently, on April 9, 2005, the Respondent timely filed its Response with the AAA and the Complainant by e-mail as well as in hard-copy form, the latter containing three exhibits (those exhibits were specifically numbered).

Shortly thereafter, both the Complainant and Respondent filed various additional submissions electronically via the AAA's on-line case management system. The principal additional submissions are:

- a) the Respondent's "Response Amendment" filed on April 20, 2005;
- b) the Complainant's Response to Response Amendment filed on April 25, 2005; and
- c) the Respondent's Response to the Complainant's Response to the Response Amendment, also filed on April 25, 2005. Pursuant to the Rules and Supplemental Rules, on April 20, 2005, the AAA contacted the undersigned, Mr. Peter L. Michaelson, and invited him to serve as a Sole Panelist for this dispute. This request was confirmed in a letter, of the same date, from the AAA. On April 21,

2005, Mr. Michaelson accepted the invitation and returned a completed and signed Notice of Appointment to the AAA, along with a disclosure by the panelist. The AAA informed the parties of his appointment and the disclosure through an e-mail letter dated April 22, 2005 and subsequently, in the absence of any objection by either party to the disclosure, confirmed that appointment to the parties through an e-mail letter dated April 26, 2005.

Based on the deadline set forth in Paragraph 15 of the Rules, a decision was to be issued by the Panel to the AAA on or before May 10, 2005.

Owing to an unexpected circumstance, specifically an unforeseen time conflict experienced by the Panel, the Panel extended the due date for its decision from May 10, 2005 to May 17, 2005.

This dispute concerns one domain name, specifically <ringling.us>.

The language of this proceeding is English.

4. Factual Background

The Respondent registered the disputed domain name on January 6, 2005.

A. Complainant's RINGLING Marks

The Complainant owns various United States registrations for marks that include the term “RINGLING”, specifically “RINGLING BROS AND BARNUM AND BAILEY”, “RINGLING BROS BARNUM & BAILEY SHOW”, and “RINGLING BROS.”. The Complainant also owns registrations for the mark “RINGLING BROS. AND BARNUM & BAILEY” in over 40 countries, including Argentina, Australia, Austria,

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Canada, France, Germany, Greece, Hong Kong, Mexico, Norway, Poland, Portugal, South Africa, Spain, Taiwan, Thailand, United Kingdom and Venezuela. The dispute is based on these marks (collectively the “RINGLING Marks”). For each of its US registrations, the Complainant has provided,

in Exhibits A1-A4 and B to the Complaint, either a copy of the corresponding registration certificate or a summary thereof. The pertinent details of these US registrations are as follows:

(a) RINGLING BROS AND BARNUM & BAILEY (block letters)

US registration 870,254; registered May 27, 1969

renewed May 27, 1989 This mark was registered for use in connection with “Entertainment services in the form of a circus” in international class 41. This mark claims a date of first use and first use in inter-state commerce of March 29, 1919.

(b) RINGLING BROS. AND BARNUM & BAILEY (block letters)

US registration 2,188,593; registered September 8, 1998 This mark was registered for use in connection with “Providing an interactive on-line data base in the fields of entertainment, education, historical and biographical information regarding a specific circus, performers, animals and other circus-related information”, in international class 41. This mark claims a date of first use and first use in inter-state commerce of March 10, 1998.

(c) RINGLING BROS. AND BARNUM & BAILEY (block letters)

US registration 2,316,875; registered February 8, 2000 This mark was registered for use in connection with “Electronic on-line retailing in the field of merchandise related to a specific circus”, in international class 35. This mark claims a date of first use and first use in inter-state commerce of July 5, 1999.

(d) RINGLING BROS. AND BARNUM & BAILEY SHOW (stylized with logo)

US registration 2,511,740; registered November 27, 2001 This mark was registered for use in connection with “Pre-recorded videos and educational CD ROMS featuring a particular circus”, in international class 9; “Paper goods and printed matter, namely programs, posters and paper containers” in international class 16; “Clothing, namely hats, shirts and jackets” in international class 25; “Toys, namely plush, dolls and hand-held toys for creating illumination” in international class 28; and “Educational and entertainment services in the form of a particular circus and on-line data base services in the fields of entertainment, education, historical and bibliographical information regarding a specific circus, performers, animals and other circus-related information” in international class 41. This mark claims the following dates for its first use and first use in inter-state commerce: December 31, 1988; December 31, 1978; December 31, 1988; December 31, 1980 and January 31, 1978 for classes, 9, 16, 25, 28 and 41, respectively.

(e) RINGLING BROS. (block letters)

US registration 2,320,542; registered February 22, 2000 This mark was registered for use in connection with “Educational entertainment services in the form of a particular circus”, in international class 41. This mark claims a date of first use and first use in inter-state commerce of April 30, 1985.

In addition, the Complainant owns at least 80 domain names, as listed in Exhibit E1 to the Complaint, in which each name contains the term “RINGLING” either by itself or in conjunction with other term(s). A hard-copy printout of the WhoIS records for these names appears in Exhibit E2 to the Complaint.

B. The Complainant and its Activities

The Complainant and its predecessors in interest have used its mark “RINGLING BROS. AND BARNUM & BAILEY” continuously since 1919 to identify the circus productions of the Complainant's parent company. This mark has appeared in countless advertisements, in television and movie productions, on-line through the Complainant's web-site accessible through <ringling.com> (a hard-copy print-out of the home page of this site appears in Exhibit C to the Complaint), and in connection with various products sold by or under the authority of the Complainant's related and affiliated entities, as well as to identify the Complainant's circus productions.

The Complainant's website at <ringling.com> provides the Complainant's history and, among many other things, extensive information about the educational programs, performers and animals of RINGLING

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BROS. This site also hosts an on-line store, enables patrons to purchase circus tickets and hosts an e-zine. More than 1.56 million people visited this site last year, including individuals from more than 160 countries including Australia, Canada, China, Germany, Mexico and the United Kingdom. Additionally, the Complainant distributes its “RINGLING.COM” E-Zine Newsletter, a hard-copy of which appears in Exhibit D to the Complaint, weekly to over 50,000 subscribers. Furthermore, the Complainant generates more than \$6 million dollars in ticket sales for RINGLING BROS. AND BARNUM &

BAILEY from its RINGLING.COM website.

The Complainant's affiliated company also sells merchandise bearing the RINGLING Marks. Further, the Complainant has licensed its mark RINGLING BROS. AND BARNUM & BAILEY to third parties for use in connection with a variety of goods, as well as entering into sponsorships and other affiliations with promotional partners in the United States and elsewhere who seek the benefit of the "RINGLING BROS." moniker.

The Complainant and its affiliates protect the RINGLING Marks through obtaining appropriate US and foreign trademark registrations, undertaking maintenance and enforcement activities and maintaining the Complainant's many domain names.

C. The Respondent's Activities

Over the past four years, the Respondent has acquired geographic domain names with an intent to develop city/community websites relating to specific geographical areas, among them the disputed domain name, <ringling.us>, for the city of Ringling, Oklahoma. The Respondent provided, as an Exhibit to the Response, a list of his registered "city" domain names.

The Respondent provided as another Exhibit to his Response, a hard-copy printout of an article, dated December 8, 2004, from "KTEN.com Online News" that addresses the city of Ringling, Oklahoma and particularly the financial trouble which the city library was then apparently facing. As indicated by the date printed in the lower right margin of this Exhibit, the Respondent accessed and printed this article on April 9, 2005. With respect to this article, the Respondent states in its Response:

"Based on this information, the respondent seeks to help this community by establishing a city website at Ringling.us with the intentions of raising public awareness of the current status of this community, to assist in the promoting of literacy and to give its residents a place they can go online to represent their city." The Respondent has yet to establish an operational website to which <ringling.us> resolves.

D. Interactions between the Parties

As noted above, the Complainant filed its Complaint on-line on February 28, 2005, and

subsequently in hard-copy form on March 18, 2005 and forwarded a copy of the Complaint to the Respondent. Subsequently, by letter dated March 21, 2005 from Ms. Strauss to the Respondent, the Complainant demanded that the Respondent transfer the disputed domain name to the Complainant.

E. The Registry's Action

Apparently, in recognition that the disputed domain name contained the term “RINGLING” which is the name of a city, here being Ringling, Oklahoma, the Registry had placed the name on its “.US Reserved List” (accessible at <http://www.neustar.us/cgi-bin/reserved.pl?state=OK>) on November 1, 2002. This date preceded the launch date of .us registry for any registration of second-level domain names (e.g., xx.us). This list specified thousands of cities and municipalities across the US, including Ringling, Oklahoma, each of which could register its name, e.g., Ringling, as a second level domain name within the .us top level domain (e.g., as <ringling.us>). However, neither trademark owners nor individuals could register any name, including the disputed domain name, that was on the list. On November 4, 2004, the Registry removed the disputed domain name from the list and placed it into a general registration pool for first-come, first-serve registration. The current sponsoring registrar, Blue Razor Domains, Inc., acquired the disputed domain name for its customer on January 6, 2005. Obviously, from the record before this Panel, the Panel views the customer as clearly being the Respondent.

The Registry provided this information in response to an e-mail inquiry dated April 25, 2005 from the Respondent; the Respondent

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has provided a copy of this inquiry and the Registry's response as one of its Additional Submissions.

5. Relief Sought

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

The Complainant also requests that the Panel order the Respondent to reimburse the Complainant for its filing fees. Though the Complainant specifically requested reimbursement of US \$ 1000, the total filing fee for the Complaint is US \$ 2000. Hence, the Panel considers the request as being for the latter amount.

6. Parties' Contentions

A. The Complaint

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's RINGLING Marks.

Ostensibly, the similarity arises due to the inclusion of the term “RINGLING” in the disputed domain name which also exists within each of the RINGLING Marks. As such, the Complainant opines that Internet users are likely to be confused, mistaken or deceived into erroneously believing that the Respondent's website, resolvable through <ringling.us>, is authorized, licensed, sponsored or endorsed by or otherwise associated with Complainant, when in fact it is not.

Hence, the Complainant implicitly concludes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant states that the Respondent, other than registering the disputed domain name, has never used that name in connection with offering any goods or services. Consequently, the Complainant believes the Respondent has no rights or legitimate interests in the name.

Accordingly, the Complainant implicitly concludes that the Respondent is unable to show that it has any rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

(iii) Registered and Used in Bad Faith

The Complainant contends that, since the Respondent has merely registered the disputed domain name and has never used it thereafter, the Respondent apparently registered that name to prevent the Complainant from obtaining the name.

Therefore, the Complainant concludes that the Respondent's conduct constitutes bad faith registration under paragraph 4(a)(iii) of the Policy.

B. The Response

(i) Identical or Confusingly Similar

The Respondent contends that the disputed domain name is not confusingly similar to the Complainant's RINGLING Marks.

Specifically, the Respondent points to a list of domain names, which as noted above appears as an Exhibit to the Response, that he has registered over the prior four years where each name contains a name of a city. Further and as previously discussed, the Respondent intends to develop a city/community website relating to a specific geographical area corresponding to and resolvable through each of those names, among those being <ringling.us>.

With this in mind, the Respondent opines that since his website for the disputed domain name will contain information specifically related to the city of Ringling, Oklahoma, Internet users will not be “mistaken or deceived into erroneously believing that Ringling.us’ is ‘associated with the Complainant’”, and nowhere in the record is there any evidence to the contrary.

(ii) Rights or Legitimate Interests

The Respondent contends that, but for the Complainant's action in quickly filing the Complaint when it did — here being within two months after the Respondent registered the disputed domain name, insufficient time existed during which: (a) the Respondent could have established his website, and/or (b) the Complainant could have inquired directly with the Respondent as to his purpose in registering the

name. Had either event happened, then the Respondent could have established his legitimate rights in the name.

But since the Complainant's alacrity precluded either event from occurring, the Respondent

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seems to be contending that the Complainant essentially frustrated the Respondent's ability to establish any legitimate rights in the name and, as such, the Respondent should be excused from making any showing that it has rights and legitimate interests in the name pursuant to paragraph 4(c) of the Policy.

(iii) Registered and Used in Bad Faith

The Respondent contends that it did not register or use the disputed domain name in bad faith.

The Respondent states that it has no interest in “selling, renting, or otherwise transferring the domain name registration to the Complainant or to a competitor of the Complainant for valuable consideration”.

Moreover, the Respondent points to what it believes to be the Complainant's bad faith in filing this Complaint without a sufficient evidentiary basis and hence based on conjecture. Specifically, the Respondent states in the Response:

“The .us tld, established based on the geography of the United States, became second level in 2002. The Complainant had almost three years to establish their rights to this, and any other domain, that the Complainant felt best suited the protection of its trademark rights. Respondent's registration of Ringling.us on January 5, 2005 was not to prevent the Complainant from obtaining the domain name but rather to establish a geographic online presence for the city of Ringling, Oklahoma.” Thus, the Respondent believes that it had neither registered nor used the name <ringling.us> in bad faith.

C. Additional Submissions

The record before the Panel consists of various additional submissions, including the Response Amendment, Complainant's Response to the Response Amendment, and the Respondent's response to

the latter. The Panel has considered each of these submissions.

In the final paragraph of its Response Amendment, the Respondent alleges that the Complainant has attempted reverse domain name hijacking. Though the Respondent has not made a specific request for the Panel to make such a finding, the Panel nevertheless treats the Respondent's allegation as an implicit request for such a finding.

Furthermore, other than the information provided from the Registry, none of the other additional submissions provides any further factual information of consequence beyond that already provided in the Complaint and the Response. Accordingly, in the interest of brevity, the Panel will not address any of these other additional submissions any further.

7. Discussion and Findings

A. Preliminary issues

1. Request for reimbursement of filing fee

[1] The remedies which an administrative panel can order under the Policy are expressly limited to either canceling or transferring a disputed domain name. In that regard, Paragraph 4(i) of the Policy states: “The remedies available to a Complainant pursuant to any proceeding before an Administrative Panel *shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the Complainant*” [emphasis added].

Hence, the Panel is without power to grant any form of monetary or other relief other than cancellation or transfer of the domain name registration at issue.

Accordingly, the Complainant's request for reimbursement of its filing fee must be and is denied.

2. Request to strike Response Amendment/Request to Respondent to produce documents referenced in Response Amendment

The Complainant has requested, in its Response to the Respondent's Response Amendment, either that: (a) the Panel strike the Response Amendment, or (b) the Respondent provide copies of all documents referenced in the Response Amendment so that the Complainant, in its view, can prepare and file a full response to the Response Amendment.

Inasmuch as the Panel has considered all the Additional Submissions — as noted above, the request to strike is denied as moot.

As to the other request, the Panel has noted that all the additional filings filed after the Response, including the Response Amendment,

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provide factual information that, at best, adds nothing of consequence to that which is already recited in the Complaint and Response. Accordingly, the Panel requires no further filings from either party, including any further response which the Complainant might otherwise wish to file to the Response Amendment.

B. Policy Elements

Paragraph 15(a) of 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:

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

1. Identical or Confusingly Similar

[2] The Panel finds that confusion is likely to arise as a result of the Respondent's use of the disputed domain name.

The Complainant started use of its RINGLING Marks in March 1919, over 86 years ago. This Panel is certainly persuaded that that, over those 86+ years, the ever-increasing reputation and worldwide recognition of those Marks strengthened to the point where the Complainant has established an extremely widespread, world-wide notoriety in its RINGLING Marks, particularly in the fields of circus entertainment and the like. Thus, there is absolutely no doubt in this Panel's mind that these Marks have achieved fame, certainly in conjunction with the Complainant's past and present activities. This view is clearly reinforced by the numerous domestic and foreign trademark registrations for the RINGLING Marks which the Complainant has collectively procured and is currently using. Given the fame these Marks have attained, the Complainant's Marks are entitled to broad protection from injury to and misappropriation of its reputation that would otherwise result from cybersquatting. See, e.g., *Lockheed Martin Corporation v. Deborah Teramani* WIPO Case No. D2004-0836 (December 1, 2004).

The Panel views the term "RINGLING", which appears in each of the Complainant's Marks, as a predominant portion of those Marks. Given the fame and notoriety of those marks, it strains the Panel's credence to consider that anyone who enters the name <ringling.us> into his (her) browser will probably intend to access any site other than a website connected with the Complainant.

This view is confirmed by the fact that the city of Ringling, Oklahoma was effectively granted a 2-year pre-emptive window by the Registrar, from November 1, 2002 through November 4, 2004, during which it alone could register the disputed domain name free from interference from any trademark owner or individual. It chose not to do so. To this Panel, this inaction manifests a recognition by the city that an insufficient number of Internet users would seek to access a website, through the disputed domain name, which would provide information about the city and its surrounding environment. While the Respondent apparently intends to develop such a website, this has yet to happen. No such website exists.

Therefore, it stands to reason that the vast majority of those Internet users who would enter a domain name into their browser that included the term “RINGLING” as its second level domain, regardless of whether the gTLD (generic top level domain) were to be “.com”, “.org” or here “.us”, would likely be seeking to access a website connected with the Complainant and nothing else.

Therefore, what this Panel is simply faced with is the Respondent having registered the name <ringling.us>, without more, being challenged by the Complainant based on its RINGLING Marks which it has been using and very widely so for over 86 years.

Given this, confusion will inevitably arise through the use of the disputed domain name by either the Respondent or any third-party entity to which the Respondent were to transfer that name and which is unaffiliated with the Complainant.

In that regard, Internet users, intent on accessing the Complainant's website or a site associated therewith, would reach a website

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through the disputed domain name <ringling.us> and thus, in all likelihood, think that an affiliation of some sort exists between the Complainant and the Respondent or its third-party transferee, when, in fact, no such relationship would exist at all. See, also, *e.g.*, *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 28, 2004); *Lockheed v. Teramani*, cited *supra*; *Register.com, Inc. v. Wolfgang Reile a/k/a RWG Internet et al*, FA208576 (National Arbitration Forum, January 27, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, FA 173362 (National Arbitration Forum, September 16, 2003); *American Family Life Assurance Company of Columbus v. defaultdata.com aka Brian Wick*, FA 123896 (National Arbitration Forum, October 14, 2002); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002); *L.F.P., Inc. v. B and J Properties*, FA 109697 (National Arbitration Forum, May 30, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *Spence-Chapin Services to Families and Children v. Stanley Wynman*,

FA 100492 (National Arbitration Forum, December 10, 2001); *Meijer, Inc. v. Porksandwich Web Services*, FA 97186 (National Arbitration Forum, July 6, 2001); *MPL Communications, Limited et al v. IWebAddress.com*, FA 97092 (National Arbitration Forum, June 4, 2001); *American Home Products Corporation v. Ben Malgioglio*, WIPO Case No. D2000-1602 (February 19, 2001); *Surface Protection Industries, Inc. v. The Webposters a/k/a Mark's Paint Store, Inc.*, WIPO Case No. D2000-1613 (February 5, 2001); *Dollar Financial Group, Inc. v. VQM NET*, FA 96101 (National Arbitration Forum, January 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.*, WIPO Case No. D2000-1463 (January 10, 2001); *Treeforms, Inc. v. Cayne Industrial Sales Corp.*, FA 95856 (National Arbitration Forum, December 18, 2000); see also *Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.* AF-0145 (eResolution, May 3, 2000).

Therefore, the Panel finds that the disputed domain name sufficiently resembles the Complainant's RINGLING Marks as to cause confusion; hence, the Complainant has shown sufficient similarity between its marks and all the disputed domain name under paragraph 4(a)(i) of the Policy.

2. Rights or Legitimate Interests

[3] The Panel believes that the Respondent has yet to provide any basis that would legitimize any claim he has to the disputed domain name.

The simple reason is that the disputed domain name contains the term "RINGLING" under which Complainant provides various products and services. Furthermore, the Panel justifiably infers that the Complainant has never authorized the Respondent to utilize any of its "RINGLING" Marks, or a mark confusingly similar thereto, in conjunction with the specific goods and services which the Complainant provides under those marks, nor does the Complainant apparently have any relationship or association whatsoever with the Respondent.

Moreover, while the Complainant is commonly known by the term "RINGLING"; the Respondent is not.

In addition, any use to which the Respondent were to put any of the "RINGLING" Marks or a mark

confusingly similar thereto, in connection with providing goods or services identical or similar to those currently provided by the Complainant would directly violate the exclusive trademark rights now residing in the Complainant. See, e.g., *Lockheed v. Teramani, Register.com, Leiner Health Servs. Corp., AT&T Corp., MPL Communications FA 97092 and Treeforms, Inc., all cited supra*; and *MPL Communications, Limited and MPL Communications, Inc. v. LOVEARTH.net FA 97806* (National Arbitration Forum June 4, 2001) and *Am. Online, Inc. v. Fu*, WIPO Case No. D2000-1374 (December 11, 2000).

The Panel categorically rejects the Respondent's argument that, from his perspective, he was not afforded ample time, prior to the Complaint having been filed, to develop an operational website resolvable through the disputed domain name which would have permitted him to establish rights and legitimate interests in the name, and hence that alleged failing by the Complainant justifiably excused the Respondent's inability to show that he had such rights or legitimate interests at the time the Complaint was filed.

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Nothing in the Policy itself requires any complainant to wait for any respondent, which it perceives to be a possible cybersquatter, to take any preliminary action or to wait for any period of time to elapse before enforcing its trademark rights by filing a complaint against that respondent. Moreover, apart from the Policy, the parties had no agreement or understanding between themselves regarding any such action or its forbearance.

It is to the complainant's advantage to act with all due speed, as the Complainant did here, for the simple reason that expeditious policing minimizes the period during which user confusion would otherwise occur thereby very likely significantly reducing any injury which that complainant would otherwise suffer due to its delay. The longer a complainant waits before taking appropriate legal action, the longer the time interval is during which confusion will occur and hence the more injury which the complainant would likely sustain, as a result of that confusion, to the goodwill inherent in its marks and

its overall reputation in the marketplace. Moreover, requiring a complainant to wait, until its respondent developed rights and legitimate interests, as a threshold condition to filing its complaint would clearly be self-defeating and effectively render the Policy a nullity: an outcome which this Panel will simply not countenance.

Lastly, the Respondent, in stating that he had not established rights or legitimate interests when the Complaint was filed, effectively admitted, by negative inference, that whatever rights and interests he then had in the disputed domain name were obviously illegitimate when he registered the name and simply continued as such thereafter.

Thus, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) of the Policy.

3. Registered or Used in Bad Faith

The Panel believes that the Respondent's actions constitute bad faith registration of the disputed domain name.

The Respondent erroneously argues, in the Response, that the Complainant had nearly three years to register the disputed domain name, but choose not to do so. As the Respondent learned from the Registry and so informed this Panel, any individual or trademark owner (which includes the Complainant) was simply precluded from registering the disputed domain name for a 2-year period stretching from November 2002 to November 2004 while that name was listed on the .US Reserved List. It was only on or after November 4, 2004, when Registry removed the name from this list, that the name first became available for general registration. It was shortly thereafter that the Respondent, not the Complainant, became the first party to register the name.

As discussed above, the Respondent obviously knew at the time he registered the name that he had no rights or legitimate interests in the name. This view is further confirmed by the hard-copy print-out of the "KTEN.com Online News", to which the Respondent pointed to as describing Ringling, Oklahoma which the Respondent intended to assist, that was accessed by the Respondent on April 9, 2005 — some four months after the Respondent registered <ringling.us> and a month and a half after the

Complaint was filed. Unquestionably, this evidence bearing an access date several months after the registration date of the disputed domain name is just not credible to prove the Respondent's intent at the time of registration. The late date of this evidence leads the Panel to believe that the Respondent is simply attempting to retroactively manufacture evidence to counter its bad faith registration of the name.

In the absence of any persuasive evidence to the contrary tending to exculpate the Respondent as of the time he registered the disputed domain name in early January 2005, the Panel believes that the Respondent knew of the Complainant's long-running activities under its RINGLING Marks and registered the name to intentionally cause and then opportunistically exploit the confusion that would inevitably arise amongst Internet users by obtaining excessive financial compensation, of some form and certainly in excess of the costs of registration, from the Complainant in order to eliminate the confusion and preclude further injury to the Complainant. Otherwise, realistically, why would the Respondent, in spite of knowing that he could not claim any interests or legitimate rights in the name when he registered it, still proceed to have registered the name? The Panel can think of no credible reason.

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Hence, the Panel views these actions as constituting bad faith registration in violation of paragraph 4(a)(iii) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations to establish a case under Paragraph 4(a) of the Policy upon which the relief it now seeks, as to the domain name itself, can be granted.

C. Reverse Domain Name Hijacking

Though the Respondent has implicitly requested the Panel, in its Response Amendment, to find that the Complainant has engaged in reverse domain name hijacking, the Panel's findings above effectively moot this request.

8. Decision

Under Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel now orders that the disputed domain name, <ringling.us>, be *TRANSFERRED* to the Complainant.

However, the Complainant's request to the Panel for an order for reimbursement of its filing fees from the Respondent is *DENIED*.

**- End of Case -
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