



NATIONAL ARBITRATION FORUM

DECISION

Tetris Holding, LLC v. Smashing Conceptions
Claim Number: FA0707001030720

PARTIES

Complainant is **Tetris Holding, LLC** ("Complainant"), a Delaware corporation, represented by **Jeanne Hamburg**, of **Norris, McLaughlin & Marcus, P.A.**, 875 Third Avenue, 18th Floor, New York, NY 10022. Respondent is **Smashing Conceptions** ("Respondent"), represented by **Alx Klive**, of **Smashing Conceptions** UK31 Birch House, 5 Droop Street, London W10 4EQ.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is/are **<freetetris.org>**, registered with **Go Daddy Software, Inc.** (the "Registrar").

PANEL

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

Mr. Peter L. Michaelson, Esq. as Panelist.

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy"), available at icann.org/services/udrp/udrppolicy24oct99.htm, which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy ("Rules") as approved on October 24, 1999, as supplemented by the National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect ("Supplemental Rules").

Complainant submitted a Complaint to the National Arbitration Forum electronically on July 10, 2007; the National Arbitration Forum received a hard copy of the Complaint, together with a declaration of Henk B. Rogers, the latter containing Exhibits 1-12, on July 11, 2007.

On July 11, 2007, the Registrar confirmed by e-mail to the National Arbitration Forum that the **<freetetris.org>** domain name is registered with Go Daddy Software, Inc. and that Respondent is the current registrant of the name. The Registrar also verified that Respondent is bound by the Go Daddy Software, Inc. registration agreement and has

thereby agreed to resolve domain-name disputes brought by third parties in accordance with the Policy.

On July 17, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of August 6, 2007 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@freetetris.org by e-mail.

A timely Response, together with Exhibits 1-11, was received and determined to be complete on August 6, 2007.

On August 14, 2007 and in compliance with Supplemental Rule 7, Complainant timely submitted an additional submission together with Exhibits 13-21.

On August 15, 2007, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Mr. Peter L. Michaelson, Esq. as Panelist and set a due date of August 29, 2007 to receive the decision from the Panel.

On August 21, 2007 and in compliance with Supplemental Rule 7, Respondent timely submitted an additional submission together with Exhibits 12-16.

Owing to unexpected time conflicts experienced by the Panel all of which constituted unforeseen circumstances, the Panel, by its order dated August 29, 2007, extended this due date to September 12, 2007.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

1. Confusing similarity/identity

Complainant contends that the disputed domain name is confusingly similar to the TETRIS Marks inasmuch as the name incorporates Complainant's mark TETRIS along with a prepended generic term "FREE", the latter term being unable to sufficiently distinguish the resulting name from the mark so as to dispel confusion of Internet users.

Hence, Complainant concludes that it has met the requirements of paragraph 4(a)(1) of the Policy.

2. Rights and legitimate interests

Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy.

Specifically, Complainant alleges that Respondent was well aware of the fame of the mark TETRIS prior to its adoption of the disputed domain name and that Complainant never authorized Respondent to use the TETRIS Marks in any domain name. Inasmuch as here Respondent's use of the mark TETRIS to provide Internet users with browser-based access to a video game which is substantially similar to Complainant's TETRIS game, does not amount to fair use, then such use constitutes an infringement of Complainant's exclusive rights in the mark. Moreover, Complainant states that the mark TETRIS is inherently distinctive and one for which it has spent considerable amounts of time, money and labor to acquire its rights and then to police and enforce those rights. Hence, Respondent, given its prior notice of the mark, could thus never have acquired any rights and legitimate interests in the name; hence, its use of the disputed domain name must be illegitimate.

3. Bad faith use and registration

Complainant contends that Respondent has registered and is using the disputed domain name in bad faith, hence in violation of paragraph 4(a)(iii) of the Policy.

Complainant alleges that inasmuch as Respondent was well aware of Complainant's mark TETRIS or, given the fame of that mark, should have been so aware when Respondent adopted and started using the disputed domain name, then its registration and use of that name must be in bad faith.

B. Respondent

1. Confusing similarity/identity

Respondent argues that the name is not confusingly similar to Complainant's mark.

First, Respondent contends that the term TETRIS has become generic of a genre of falling block games, of which Respondent's browser-based version is one game. Hence, Respondent contends that Complainant no longer has any trademark rights in the term TETRIS when it is used in conjunction with such games.

In that regard, Respondent argues that since Complainant's original TETRIS game appeared in the industry in 1989, Complainant has been "unable to prevent an avalanche of similar falling block puzzle games becoming available, dozens of which are freely available on the Internet today as on-line games, and dozens of which, like ours, are actually called

'tetris' or a variant thereof" (see hard-copy printouts, provided in Exhibit 5 to the Response, of home pages of 25 web sites where each provides a TETRIS game that does not originate from Complainant). As such, the falling block genre of games is no longer uniquely associated with Complainant. In its place, an entire class of falling block puzzle games has come to be known as TETRIS, both on-line and among the wider general public.

Second, Respondent asserts that, if Complainant still has exclusive rights in the mark TETRIS, then the addition of the term "FREE" in the domain name is sufficient to negate any confusion among Internet users. In particular, Respondent asserts that Complainant does not provide on-line games and hence is not well known by the general public for doing so (see a hard-copy printout in Exhibit 10, to the Response, of Complainant's home page at <tetris.com>, through which Complainant does not offer any browser-based game). In contrast, Respondent's activities are solely confined to providing on-line, browser-based versions of old video games. The game of TETRIS which Respondent provides on its web site (and which others provide on their web sites -- as shown, e.g., in Exhibit 5 to the Response) was not created by Complainant.

Third, Respondent points to the fact that by including the term "FREE" in the name and using a gTLD (generic top level domain) of ".org" rather than ".com", any possible confusion is further ameliorated as no Internet user would expect a web site having the term "FREEEx.org" (where x is a mark) to be associated with the web site of the mark owner, typically being a name in the form of "x.com." Further, Respondent points to a disclaimer, regarding the specific service it provides and which expressly disassociates itself from the original game creator, and appears on its web site, that further reduces any likelihood of user confusion from arising (see a hard-copy printout, which appears in Exhibit 1 to the Response, of the home page of Respondent's web site).

Hence, Respondent contends that Complainant accepts that other non-original TETRIS games and various non-official TETRIS web sites exist.

2. Rights and legitimate interests

Contrary to Complainant's view, Respondent contends that, for any of several reasons, it has rights and legitimate interests in the disputed domain name under paragraph 4(c) of the Policy.

First, Respondent's web site is a non-profit, non-commercial website established December 2005. The site highlights the work of programmers, who recreate, as part of their education, online versions of old classic video games which have long since been presumed to have passed into the public domain. Respondent, in turn, hosts those games on its web sites, without receiving any commercial remuneration, so that those games can be shared with a relatively wide audience. Respondent states that more than a half-million users currently visit its <freetetris.org> website each month, with 75% being registered, and since its inception more than 2.4 million unique users have visited that site. Further,

Respondent contends that, through its own efforts commencing from the time it registered the name, it has established and marketed an increasingly popular web site under that name. As a result, that site is now commonly known as "Free Tetris" by hundreds of thousands of Internet users who now visit it monthly. Consequently, Respondent alleges that it has developed legitimate rights in both its game and the disputed domain name.

Second, since Respondent does not use any coding, graphics or sounds which emanate from Complainant's TETRIS game and copyright protection does not extend to protecting a genre, then Respondent's game does not infringe on any intellectual property rights which Complainant may have in its game. Hence, Respondent's offering of its game through its web site is bona fide. Further, since that offering predated the date on which Respondent was placed on notice of this dispute, Respondent has legitimate rights in the disputed domain name under paragraph 4(c)(1) of the Policy. Alternatively, if any such infringement does exist, then Respondent contends that its actions in providing the game on a non-profit basis constitute "fair use" of that game, again legitimizing its rights to the disputed domain name.

3. Bad faith use and registration

Respondent contends, contrary to Complainant's view and for any of various reasons, that it did not register and use the disputed domain name in bad faith.

First, Respondent states that it never offered the disputed domain name for sale to anyone, including Complainant; Complainant never alleged that Respondent ever did so.

Second, Respondent never engaged in a pattern of registering "tetris"-based domain names, let alone to prevent Complainant or any one else from registering such a name -- nor does Complainant allege that Respondent ever did. In that regard, Complainant owns the names <tetris.com> and <tetris.net>.

Third, Respondent states that it never acted in any way to intentionally or otherwise disrupt Complainant's business. Here too, Complainant never alleged that Respondent ever did so.

Lastly, Respondent contends that it registered the disputed name in good faith with an intent to establish a non-commercial, *bona fide* gaming web site, which in fact it did. Respondent states that inasmuch as its site is non-commercial, Respondent could never attract Internet users for commercial gain. Further, Respondent never set out to mislead or confuse Internet users as to the origins of its site -- and, in light of the disclaimer on its site, manifested just the opposite.

C. Additional Submissions

The Panel has fully considered both submissions as both were timely made and complied with the requirements of Supplemental Rule 7. Nevertheless, the Panel finds that, for the most part, both submissions, reiterate and amplify various allegations set forth in the Complaint. Hence, for the sake of brevity, the Panel will very briefly summarize just a few particularly salient arguments, including certain ones not previously made by the parties.

1. Complainant

Complainant strongly argues, contrary to Respondent's view, that its TETRIS Mark is not generic. Complainant states that the mark TETRIS is a coined word which is inherently distinctive, famous and uniquely associated with the TETRIS video game emanating from Complainant. Complainant contends that Respondent has offered no proof to support its claim that the mark has become generic.

Complainant further argues that Respondent's lack of legitimate interests is illustrated by:

- (a) the latter's registration of the disputed domain name through a proxy service (Domains by Proxy) which, in turn, shielded Respondent's true identity from appearing in the WHOIS registration entry for the name;
- (b) the lack of any disclaimer, contrary to Respondent's claim, on the <freetetris.org> web site. Rather, a small, non-prominent disclaimer appears on the <freevideogamesonline.org> site (see a hard-copy printout, in Exhibit 1 to the Response, of the home page to this site) to which a link appears on the former site; this disclaimer being insufficient to dispel confusion of Internet users; and
- (c) by virtue of Respondent's web site ranking higher, in terms of user traffic, on the Google search engine, than Complainant's site, that ranking in itself is commercially valuable to Respondent, hence negating the non-profit nature of Respondent's web site.

Moreover, Respondent's higher ranking on the Google search engine, simply results from its having traded off Complainant's goodwill, which, in turn, reflects bad faith.

2. Respondent

Respondent states that Complainant misconstrues the former's assertion that the mark TETRIS is generic. Respondent is not arguing that the mark is generic for any use, but rather when used in conjunction with falling block puzzle games. In that regard and contrary to Complainant's view, Respondent has provided sufficient evidence showing that the mark TETRIS has so become generic. Specifically, Respondent points to 25 examples of third-party web sites that offer games named TETRIS but which are not associated with Complainant and to a web-based article (see a copy of the latter in Exhibit 16 of the Response) that reports the existence of "millions of Tetris clones".

In spite of what Complainant may believe as to any commercial value resulting from Respondent's higher traffic level on the Google search engine, this view simply masks the overriding fact that Respondent's web site is indeed non-commercial with its nature fully described on Respondent's site portal at Respondent's "Free Video Games Project" web site. Respondent does not charge for access to its Free Tetris video game, nor does it commercially exploit that game in any way.

Further, Respondent states that prior versions of its home page at <freetetris.org> did in fact display disclaimers since the inception of that site and certainly prior to the date on which the Complaint was filed.

Lastly, Respondent used the identity shield (proxy) service offered by the Registrar simply to protect it from spam, fraud and other malevolent third-party action that occurs on the Internet.

FINDINGS

A copy of the WHOIS registration record for the disputed domain name appears in Exhibit 1 of the Rogers Declaration. As indicated, the domain name was registered on December 30, 2005.

A. Complainant's TETRIS Marks

Complainant owns various United States and counterpart foreign trademark registrations for the term "TETRIS," in block letters by itself, stylized and/or with a separate design element, and on which this dispute is based. Complainant has provided, in Exhibits 2 and 3 to the Rogers Declaration, copies of its US trademark registrations and a list of its foreign trademark registrations, respectively (the list also includes a small number of foreign trademark applications as well, though the vast majority of the entries in the list are foreign registrations). Being that Complainant is a US (specifically Delaware) corporation, the Panel will view this dispute with respect to its US registrations, the pertinent details of which are as follows:

- a) TETRIS (stylized with a design element)
United States registration 2,362,250; registered: June 27, 2000
filed: August 20, 1999

This mark is currently registered for use in connection with "video game cartridges and software for playing video games" in international class 9; "clothing, namely shirts, hats and t-shirts" in international class 25; and "hand-held video games" in international class 28. The registration certificate states that: first use and first use in commerce of the mark for the goods in class 9 commenced as of June 30, 1997 and October 31, 1998, respectively; and both first use and first use in commerce of the mark for the goods in class 25 and also the services in class 28 commenced as of November 30, 1998.

- b) TETRIS
United States registration 2,362,238; registered: June 27, 2000
filed: August 20, 1999

This mark is currently registered for use in connection with "video game cartridges and software for playing video games" in international class 9; and "clothing, namely shirts, hats and t-shirts" in international class 25. The registration certificate states that both first use and first use in commerce of the mark for these goods in classes 9 and 25 commenced as of June 2, 1989 and August 31, 1991, respectively.

- c) TETRIS
United States registration 1,657,499; registered: September 17, 1991
last renewed: June 27, 2000
filed: March 8, 1990

This mark is currently registered for use in connection with "games and playthings; namely action figures, bagatelle games; video games and video game cartridges; electronic game equipment for playing video games; electronic game programs; electronic toys with a clock or timepiece feature; hand-held electronic toys; nonelectronic hand-held games; player-operated electronic controllers for electronic video game machines; toy figures mountable on pencils and pens" all in international class 28. The registration certificate states that first use and first use in commerce of the mark for these goods commenced as of June 2, 1989.

B. Complainant and its activities

Complainant licenses the TETRIS Marks worldwide for use with the TETRIS video game in multiple media, e.g., from wireless communications devices (such as mobile telephones) to handheld video games to television console games. Complainant's licensees include Nintendo (for video games); Electronic Arts, Inc. d/b/a EA Mobile (for mobile phones, Apple iPods, PDAs); THQ, Inc. (for certain videogame consoles); and Radica Ltd. (for electronic handheld games). See paragraph 8 of the Rogers Declaration.

Currently, Complainant has registered trademarks in the term TETRIS in the US and in approximately 50 foreign countries. Complainant's predecessors-in-interest first use of the mark TETRIS dates back to 1989. See paragraphs 6, 7 and 9 of the Rogers Declaration. As a result of Complainant's licensing activities to date since 1989, Complainant has earned revenues amounting to millions of dollars.

Complainant and its licensees have advertised TETRIS-based products around the world. See in the Rogers Declaration: paragraph 8 and Exhibits 4-7 (the latter providing copies of various advertisements); Exhibit 8 (product packaging for

Nintendo TETRIS game); paragraph 9 and Exhibits 9 and 10 (advertisements in Asia and Germany by Complainant and one of its sub-licensees, respectively).

On or about April 25, 2007, Complainant, through its Counsel, became aware of the fact that the disputed domain name resolved to a web site that provided a link for any Internet user to engage in a free (no fee) game of TETRIS. Complainant had never authorized the owner of this site, i.e., Respondent, to provide such a game, whether on its web site or elsewhere. To date, the disputed domain name remains so active.

Complainant conducted a WHOIS search as recently as June 20, 2007 which revealed that the registrant of the domain name is Domains By Proxy, Inc. (a copy of those search results appears in Exhibit 1 to the Rogers Declaration). Upon filing the Complaint, Complainant was able to obtain the identity, from the Registrar, of Respondent as being the true registrant of the disputed domain name.

C. Respondent and its activities

Respondent's web site is a community website that exists as part of Respondent's wider community web site called "The Free Video Games Project", the latter located at <freevideogamesonline.org> (a copy of the home page of the latter site appears in Exhibit 1 to the Response). Currently, the <**freetetris.org**> web site has over half-a-million users per month with over 210,000 registered regular users (see web site statistics in Exhibit 2 as provided by Google Analytics). More than 2.4 million unique users have visited Respondent's <**freetetris.org**> web site since its inception in December 2005. Further, since that date, Respondent has continuously maintained that site as strictly non-commercial.

Respondent's <freevideogamesonline.org> web site highlights the work of talented programmers who recreate online versions of old classic video games as part of their education. Respondent provides various services, such as hosting of the games through its web site, all without receiving any commercial reward whatsoever so that those versions can be readily shared with a wide audience. The programmers are not compensated for their efforts other than gaining artist credit for their creations. It is very common for individual game designers to re-create old video games which are not protected by copyright and which are long since presumed to be in the public domain (see a copy of a college advertisement, provided in Exhibit 11, which purports to provide such an activity for its students). The falling block puzzle game that appears on Respondent's <**freetetris.org**> web site was a complete, independent re-creation by its own programmers without reliance on any specific coding, graphics or sounds whatsoever that form Complainant's TETRIS game.

Respondent's <**freetetris.org**> web site is more popular than Complainant's own web site, such as, by virtue of Respondent's web site appearing immediately above Complainant's web site on a Google search results page for "tetris" (see a printout of that

results page appearing in Exhibit 9 to the Response), and also as evidenced by comparative web site usage statistics provided by Alexa (a popular web site comparison utility), compete.com and Google (all of which is also provided in Exhibit 9 to the Response).

Respondent's experience with the game TETRIS is confined to playing online versions of that game which were not created by Complainant. An entire community of websites exists that offer on-line versions of TETRIS games not associated with Complainant (see hard-copy printouts of home pages from 25 such sites as provided in Exhibit 5 to the Response).

Respondent had no knowledge of Complainant prior to its receiving a copy of the Complaint, which as noted above was filed with the Forum on July 10, 2007, and never received any prior communication from Complainant concerning Complainant's assertion of rights in its TETRIS Marks and game.

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 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.

Trademark Validity issues

Issues concerning trademark validity, which Respondent here raises in the context of a lack of registerability owing to genericness of the mark, are clearly not within the purview of any UDRP proceeding and are best left for administrative and/or judicial adjudication. Not only is doing so outside the very limited and focused jurisdiction afforded to ICANN panels under the Policy but moreover the summary and rather abbreviated nature of UDRP proceedings totally precludes the establishment of a fully developed factual record that underlies such a question.

UDRP panels cannot and hence do not assess the validity of any federally registered trademark. Instead, such panels must, of necessity, accord significant deference to decisions of that government body, namely the USPTO, which, in the first instance not only possesses the requisite expertise to assess such issues but also the federal statutory

mandate to do so. It is simply not within the purview of any UDRP panel to evaluate and review the judgment of the USPTO on such questions. Moreover, even apart from those jurisdictional concerns but clearly in view of the rather summary and abbreviated nature of UDRP proceedings, UDRP panels are here too grossly ill-equipped to deal with an extensive factual inquiry that typically underlies an invalidity determination. See, e.g., *Gerber Childrenswear Inc. v. David Webb*, D2007-0317 (WIPO April 24, 2007); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle* D2004-0824 (WIPO Jan. 18, 2005); *Register.com, Inc. v. Wolfgang Reile a/k/a RWG Internet and Marketing Rightway Gate Inc., et al*, FA 208576 (Nat. Arb. Forum Jan. 27, 2004); *United States Office of Personnel Mgmt. v. MS Tech. Inc.*, FA 198898 (Nat. Arb. Forum Dec. 9, 2003), and *Lake at Las Vegas Joint Venture v. Principal Equiti, Inc.*, D2002-0758 (WIPO Oct. 4, 2002).

Hence, once the USPTO has made a determination that a mark is registerable, as it has here by issuing a registration to Complainant for its mark TETRIS, a UDRP panel is not empowered to nor should it disturb that determination.

To the extent Respondent wishes to challenge the USPTO's determination that any of Complainant's TETRIS Marks has acquired sufficient distinctiveness upon which its federal trademark registration can be based, and continues to be so distinctive of Complainant's goods and services, Respondent may well have appropriate administrative and/or judicial avenues available to it to do so, such as by filing an action in the USPTO to cancel any of Complainant's federal registrations or alternatively instituting federal litigation. Absent Respondent having done so and attained a final ruling that any of Complainant's federally registered TETRIS Marks is indeed generic, with respect to the goods or services with which that mark is then used, and thus not susceptible of continued federal registration, this Panel will simply defer, as it must, to the USPTO's determination implicit in its having granted various registrations, i.e., that each of Complainant's TETRIS Marks has acquired sufficient distinctiveness and hence is not generic, and thus qualifies for continued federal trademark protection and enjoys all the rights afforded thereby.

Therefore, given the inability of this Panel to address the invalidity issue raised by Respondent, then, as far as this proceeding is concerned, the Panel is not precluded from finding that the disputed domain name is either identical or confusingly similar to Complainant's TETRIS Marks.

Identical and/or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to Complainant's TETRIS Marks.

From a simple comparison of the name and the mark TETRIS, no doubt exists that the disputed domain name is, for all practical purposes, confusingly similar to that mark.

The only difference between the name and that mark is the addition of the term "free," as a prefix and the appending of a gTLD (generic top level domain) “.org” to the mark -- with the last being totally irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that minor variations, such as adding short letter or number groups or even generic words to a mark, are each insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Prepending the term "free" such that the term “TETRIS” becomes in the domain name “freetetris” is clearly such a minor variation. See, e.g., *Associated Bank Corp. v. Texas International Property Associates*, D2007-0334 (WIPO June 28, 2007); *Gerber Childrenswear Inc. v. David Webb*, D2007-0317 (WIPO April 24, 2007); *SPX Corp. v. Hevun Diversified Corp.*, FA791657 (Nat. Arb. Forum Nov. 13, 2006); *Google Inc. v. Burns*, FA 726096 (Nat. Arb. Forum Aug. 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, D2005-0766 (WIPO Sept. 12, 2005); *Napster, Inc. v. Vinscani*, D2005-0531 (WIPO July 19, 2005); *Caesars Entertainment Inc. v. Nova Internet Inc*, D2005-0411 (WIPO June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, D2004-0824 (WIPO Jan. 18, 2005); *Lockheed Martin Corp. v. Deborah Teramani*, D2004-0836 (WIPO Dec. 1, 2004); and *National Collegiate Athletic Assoc. v. Dusty Brown*, D2004-0491 (WIPO Aug. 30, 2004); and *Lane-Labs USA, Inc. v. Powell Productions*, FA 155896 (Nat. Arb. Forum July 1, 2003). While a sufficient number of variations or even one such significant variation itself made to a mark may suffice, under a specific factual situation, to impart requisite distinctiveness to a resulting domain name and there through dispel user confusion (see, e.g., *Citgo Petroleum Corporation v. Richard Antinore*, D2006-1576 (WIPO March 14, 2007); and *CP Films, Inc. v. Solar Lunar Performance Film*, FA861127 (Nat. Arb. Forum Feb.6, 2007)), such is clearly not the case here when both the name at issue and the mark are viewed, as they must, in their entirety with respect to each other.

Therefore, the Panel finds that the disputed domain name <freetetris.org> is confusingly similar to Complainant’s TETRIS Marks as to cause confusion; hence, Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

Rights or Legitimate Interests

The Panel, after very careful consideration of the specific facts at hand, finds that Respondent has rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy states, in pertinent part:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name ...

(1) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services."

First, it is undisputed that Respondent registered and began use of the name on December 30, 2005 and did not learn of this dispute until approximately a year and a half later when Respondent was notified of the instant Complaint on July 17, 2007.

Given this, Respondent has satisfied the temporal threshold portion of paragraph 4(c)(1) that its use or demonstrable preparations for use of the name (or a name corresponding thereto) start prior to Respondent's having received notice of this dispute.

With that, the focus shifts to whether Respondent's use of the name, which incorporated Complainant's registered mark TETRIS, under the specific facts at issue, i.e., in connection with offering free access to a video game that from a thematic perspective (i.e., being a similar falling block puzzle) resembled Complainant's game, is bona fide.

While the resolution of that issue is not clear cut -- with valid arguments having been presented on both sides, the Panel is highly mindful of and ultimately guided by the underlying narrowly-defined scope and tenet of the Policy.

Specifically, Respondent's use of the name in connection with its web site has been non-commercial since the inception of that site back in late December 2005 and so continues unabated to the present date. The record reflects, and Complainant does not contest, that Respondent did not receive any pecuniary remuneration at any time from its site. The only direct benefit which Respondent received was for its student programmers who receive artist credit for their efforts in creating programs that replicated classic old video games. Though Complainant argues that somehow Respondent received commercial benefit from its higher site ranking, in terms of web visitors and placement on a Google "tetris" search page, the Panel does not see -- nor has Complainant shown -- how Respondent received any such benefit whatsoever from its site. At all times Respondent neither sought nor actually received any financial return, whether directly or through a suitable and proximate nexus to its higher site ranking.

Perhaps, if Respondent: (a) had or actually manifested an intent to selling its web site to a third party, or (b) even just allowed that party to commercially use the site, either of which in a manner that would have been likely to cause financial injury to Complainant, through exploitation of Internet user confusion, such as by diverting sales and licensing revenue away from Complainant to that third-party or otherwise interfering with Complainant's business to its ultimate injury, then having a higher search ranking might have induced the third-party to remit a higher price for the disputed domain name and Respondent's associated web site, or at least for rights to post content to or commercially exploit that site than would otherwise have possibly arisen. However, Respondent, from the inception of its site in December 2005, never had nor manifested any such intent nor did it allow any third party to use its site, let alone in a manner reasonably likely to ultimately inflict any financial harm on Complainant -- a finding which Complainant does not dispute.

Furthermore, although Respondent's web site draws more visitors than does Complainant's web site, no evidence exists of record as to how Respondent is actually financially or otherwise commercially benefited by each incremental Internet user which its site draws and what commercial damage, if any, Complainant suffers as a result.

Hence, Complainant's argument, that Respondent, in spite of the completely non-commercial nature of its site, nevertheless gains commercial benefit, by virtue of its higher web site ranking and visitor numbers, is simply too speculative, ill-defined and the possible commercial benefits flowing there from are too remote, as to be persuasive to this Panel. The Panel concludes that, under the specific facts here, Respondent's has used and continues to use the disputed domain name in connection with a bona fide offering of services.

While it is certainly true that Respondent is using the trademarked term TETRIS in the disputed domain name <**freetetris.org**> and is providing access to a video game that arguably, at least in terms of its genre, is probably similar to Complainant's video game, more than just that use is needed to obtain relief under the Policy. Questions of whether just use of a domain name and an accompanying service infringes a trademark are simply insufficient to invoke the Policy and, as with questions of trademark validity, are outside the purview of the very limited jurisdiction of an UDRP proceeding. Such questions are best left to and properly resolved through an appropriate judicial forum. More egregious conduct that collectively demonstrates, under the Policy, a lack of a respondent's having sufficient rights or legitimate interests in the name at issue as well as bad faith in terms of both use and registration, is required -- conduct that, in this Panel's view, is simply missing under the specific facts here. See, e.g., *Rudy Rojas v. Gary Davis*, D2004-1081 (WIPO Dec. 18, 2005); and *Citigroup, Inc. v. Joseph Parvin*, D2002-0969 (WIPO May 12, 2003).

Thus, the Panel concludes that Respondent has rights or legitimate interests in the disputed domain name under paragraph 4(c)(1) of the Policy.

Registration and Use in Bad Faith

In light of the Panel's findings that Respondent possesses rights or legitimate interests in the disputed domain name under paragraph 4(c)(1) of the Policy, then all issues relating to whether Respondent registered and used that name in bad faith are moot. Hence, the Panel declines Complainant's invitation to address those issues and thus renders no opinion on any of those issues.

Inasmuch as Complainant has failed to meet its burden under paragraph 4(a)(2) of the Policy, therefore it has failed to establish a *prima facie* case for relief under paragraph 4(a).

DECISION

Consequently and in accordance with the elements of the Policy, the relief sought by Complainant is hereby **DENIED**.

Peter L. Michaelson, Esq., Panelist
Dated: September 11, 2007