



**NATIONAL
ARBITRATION
FORUM**

NATIONAL ARBITRATION FORUM

DECISION

National Sports Services Inc. v. Global Media Resources S.A.
Claim Number: FA0409000335580

PARTIES

Complainant is **National Sports Services Inc.** (“Complainant”), represented by **Richard B. Newman**, of **Berkley Gordon & Goldstein, LLP**, 8330 W. Sahara Ave. Suite 290, Las Vegas, NV 89117. Respondent is **Global Media Resources S.A.** (“Respondent”), represented by **Jenna L. Wilson**, of **Dimock Stratton LLP**, 20 Queen Street West, Suite 3202, Box 102, Toronto, Ontario Canada M5H 3R3.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**sportstracker.com**>, registered with **Moniker Online Services, Inc.**

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”).

Complainants submitted a Complaint to the National Arbitration Forum (the "Forum") electronically on September 28, 2004; the Forum received a hard copy of the Complaint, together with Exhibits 15, on October 4, 2004. Shortly thereafter, at the Forum's request of October 6, 2004 and within the time limit allotted, Complainant submitted a slightly amended Complaint to the Forum.

On September 30, 2004, the Registrar, Moniker Online Services, Inc. ("Moniker"), confirmed by email to the Forum that the domain name <**sportstracker.com**> is registered with Moniker and that Respondent is the current registrant of that name. Moniker has verified that Respondent is bound by the Moniker registration agreement through which Respondent has agreed to resolve domain name disputes brought by third parties in accordance with the Policy.

On October 8, 2004, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of October 28, 2004 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@sportstracker.com by e-mail.

A timely Response, together with Annexes A and B (with Annex A containing Exhibits 1-6, and Annex B containing Exhibits 1-6) was received by the Forum and determined to be complete, both on October 28, 2004.

Subsequently and pursuant to Supplemental Rule 7, Complainant timely filed an additional submission, together with a sole Annex, on November 2, 2004.

Thereafter and also pursuant to Supplemental Rule 7, Respondent timely an additional submission, together with Annex A containing Exhibits 1-3, on November 8, 2004.

On November 8, 2004, pursuant to Complainant's request to have the dispute decided by a single-member panel, the Forum appointed Mr. Peter L. Michaelson, Esq. as the Panelist and set a due date of November 22, 2004 to receive the decision from the Panel.

RELIEF SOUGHT

Complainant requests that the disputed 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 Complainant's registered <**sportstracker.net**> domain name. In that regard, and citing to *Shields v. Zuccarini* 254 F.3d 476 (2001), Complainant takes the position that the term "confusingly similar" has been "found to mean the intentional registration of domain names that are misspellings of the domain names of another company, causing an Internet user who makes a slight spelling or typing error to reach an unintended site."

Furthermore, Complainant alleges that it has copyrighted its <**sportstracker.net**> domain name in 1998 and that the disputed domain name infringes that copyright.

Consequently, Complainant believes that it has satisfied the requirements of paragraph 4(a)(i) of the Policy with respect to the disputed domain name.

2. Rights and legitimate interests

Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name.

Specifically, Complainant alleges that Respondent is using the disputed domain name for commercial gain and particularly to misleadingly divert Complainant's customers. In that regard, Complainant states that: (a) shortly after it registered the disputed domain name in 1998, Respondent registered the disputed domain name; and (b) Respondent is using the disputed domain name to point to a pornographic web site, and by virtue of the high degree of similarity [basically only a difference in the generic top level domains] between that name and Complainant's registered name and hence the consumer confusion likely engendered thereby, Respondent's use of the former name acts to divert customers from Complainant's web site to Respondent's pornographic web site and, by so doing, disrupt Complainant's business.

Further, Complainant points to what it believes to be various acts of Respondent that violate the registration agreement between Moniker and Respondent.

3. Bad faith use and registration

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

Specifically, Complainant takes the position that US law prohibits "a person or company to register, with bad faith intent to profit from, an Internet domain name that is identical or confusingly similar to the Internet domain name of another person or company", and that that is exactly what Respondent has done.

In that regard, Complainant alleges that Respondent's actions clearly evidence bad faith in as much as Respondent registered the disputed domain name some six months after

Complainant registered its domain name and did so to "prey on consumer confusion by misusing the domain name to divert customers" from Complainant's site to the "Respondent's pornography site, which presumably derives revenue based upon the number of visits or 'hits' the site receives". Complainant opines that the "deliberate maintenance of such a domain name to divert customers from NSS' [Complainant's] web site, thereby disrupting its business, constitutes the necessary showing of bad faith".

B. Respondent

1. Confusing similarity/identity

In essence and to the extent pertinent, Respondent alleges that Complainant does not have any rights in the disputed domain under the Policy because:

- (a) Complainant does not have registered or common law trademark rights in the term "SPORTSTRACKER";
- (b) The term "SPORTSTRACKER" is descriptive and generic;
- (c) The term "SPORTSTRACKER" is currently being used by parties other than Complainant; and
- (d) Complainant has not proven that the term "SPORTSTRACKER" has acquired any distinctiveness or secondary meaning.

Specifically, Respondent contends that Complainant does not have a registered mark in any jurisdiction of which Respondent is aware for the term "SPORTSTRACKER". Given that Complainant is based in the US, Respondent states that its search of the on-line trademarks database of the United States Patent and Trademark Office (located at <uspto.gov>) yielded no pending trademark application or registration for that term. Further, Respondent, being based in Canada, states that its search of the on-line Canadian trademarks database (accessible at <www.cipo.gc.ca>) indicated that Complainant has no Canadian trademark registrations or pending trademark applications for the same term.

Moreover, Respondent states that Complainant has failed to provide any evidence, whether by, e.g., goodwill or reputation, that Complainant has acquired any common law trademark rights, through distinctiveness or secondary meaning, in the term "SPORTSTRACKER". In the absence of such evidence, Respondent concludes that Complainant cannot prove that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights.

2. Rights and legitimate interests

Respondent states that, contrary to Complainant's view, Respondent has rights and legitimate interests in the disputed domain name.

Specifically, Respondent points to the fact that it registered the disputed domain name five years ago and since then has offered goods and services using that name. Respondent contends that inasmuch as it and Complainant have co-existed, without any evident consumer confusion arising through concurrent use of their respective domain names for several years, this signifies that Complainant has no rights in the disputed name. Further, Respondent states that, since an Internet search (which ostensibly it undertook) for the terms "SPORTSTRACKER" and "SPORTS TRACKER" led users to Complainant's web site as well as to other sites advertising or describing other software or products sold under either of those terms, it believes that confusion between Complainant's and Respondent's businesses and services appears to be unlikely.

Lastly, Respondent states that Complainant has provided no evidence to suggest that Respondent has attempted to disrupt Complainant's business.

3. Bad faith use and registration

As to bad faith use and registration, Respondent states that Complainant has offered no evidence that the registration and use of the disputed domain name has been in bad faith.

Specifically, Respondent states that, by Complainant's own admission, Complainant was content to allow Respondent, over a period of five years, to use and develop its web site resolvable through the disputed domain name. Complainant has not explained why Respondent was allowed to so develop its business over this period, and why Complainant did not object prior to 2004. This failure, as Respondent opines, to explain delay militates against a finding of bad faith.

Further, Respondent contends that Complainant has not demonstrated that Respondent registered the disputed domain name primarily for the purpose of disrupting the business of a competitor and, to that end, has not provided any evidence of any resulting disruption. Respondent also states that, by Complainant's own admission, the parties are not competitors.

Respondent states, that since it and Complainant have co-existed for five years, there is no merit to Complainant's claim of disruption to or confusion with Complainant's business.

C. Additional Submissions

Inasmuch as both Complainant and Respondent timely filed their respective additional submission, the Panel has fully considered both of these submissions.

Since these submissions appear to just repeat and amplify the salient contentions made in the initial pleadings, then, for the sake of brevity, the Panel will simply omit any specific discussion of these submissions.

FINDINGS

Respondent registered the <**sportstracker.com**> domain name on March 9, 1999. This date is approximately six months after the September 18, 1998 date on which Complainant registered its <**sportstracker.net**> domain name. Complainant uses its domain name to address its web site which, in conjunction with Complainant's proprietary software, provides Complainant's subscribers with access to an extensive database of synthesized sports handicapping information.

Starting sometime during the year 2000, Respondent began using the disputed domain name in conjunction with a pornographic web site (a hard-copy printout of the home page of that site appears as the sole exhibit to Complainant's Additional Submission). Whenever a user enters the disputed domain name into his(her) browser, that user is redirected to a web site at <realbj.com>.

Furthermore, various third parties currently use the term "SPORTSTRACKER" or "SPORTS TRACKER" in conjunction with corresponding software applications for tracking sports and athletic activities. One such party was refused registration, by the US Patent and Trademark Office and on the grounds of descriptiveness, of the term "SPORTS TRACKER" for use with "delivery of sports data via software to wireless devices".

Complainant does not appear to use the term "SPORTSTRACKER" or "SPORTS TRACKER" as its trademark or service mark in connection with its sports handicapping service or, for that matter, any produce or service; nor does Complainant appear to have any trademark registration, issued by any governmental entity, for either of these terms.

Complainant, through its counsel, sent Respondent a letter dated June 18, 2004 demanding that: (a) Respondent cease and desist from all further use of the disputed domain name, and (b) transfer that name to Complainant. Complainant also sent a corresponding cease and desist letter, dated June 28, 2004, to the Registrar. Copies of both of these letters appear in Exhibits 4 and 5 to the Complaint. Complainant received no response from Respondent to the June 18th letter. The Registrar responded to the June 28th letter essentially refusing to transfer the disputed domain name to Complainant in the absence of a court order or a ruling from an administrative panel acting under the Policy.

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:

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

Identical and/or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires that a disputed domain name be "identical or confusingly similar to a *trademark or service mark in which Complainant has rights*" (emphasis added). This devolves into two requirements that must both be met by every complainant under the Policy, namely that: (a) Complainant has rights in a trademark or service mark, and (b) the disputed domain name is identical or confusingly similar to that trademark or service mark.

Based on this Panel's review, both the Complaint and Complainant's Additional Submission collectively appear utterly devoid of any proof whatsoever that Complainant has any trademark or service mark rights in the term "SPORTSTRACKER" or "SPORTS TRACKER" -- let alone as of March 9, 1999 which is the date the disputed domain name was registered -- whether those rights result from a federal or state registration, or at common law through mere use of either of these terms as a trademark or service mark. Absent such proof, let alone sufficient, Complainant has simply failed to satisfy the requirements of paragraph 4(a)(i) of the Policy. See, e.g., *Continental Design and Management Group v. Technet, Inc.* Case No. FA096564 (Nat. Arb. Forum March 21, 2001).

Furthermore, though Complainant asserts that it has rights under copyright in the disputed domain name, any such rights are totally irrelevant for purposes of a dispute occurring under the Policy as the Policy requires complainants, as a threshold matter, to hold trademark or service mark rights, not rights under copyright.

Rights or Legitimate Interests; Registration and Use in Bad Faith

In view of the Panel's finding above that Complainant has failed to satisfy paragraph 4(a)(i) of the Policy, then all issues as to whether: (a) under paragraph 4(a)(ii) of the Policy, Respondent has any rights or legitimate interests in the disputed domain name; and (b) under paragraph 4(a)(iii) of the Policy, Respondent registered and used the

disputed domain name in bad faith are now moot. Consequently, the Panel has no need to consider any of these issues and thus declines to do so.

Hence, Complainant has simply failed to meet its burden under paragraph 4(a) of the Policy.

DECISION

Consequently and in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the relief sought by Complainant is hereby **DENIED**.

Peter L. Michaelson, Esq., Panelist
Dated: November 18, 2004