



NATIONAL ARBITRATION FORUM

DECISION

Groovr, Inc. v. Active Interactive, Inc.
Claim Number: FA0710001103425

PARTIES

Complainant is **Groovr, Inc.** (“Complainant”), represented by **Brian R. Coleman**, of **Perkins Coie LLP**, 101 Jefferson, Menlo Park, CA 94025. Respondent is **Active Interactive, Inc.** (“Respondent”), represented by **John Alunit**, of **Patel & Alunit, PC**, 16830 Ventura Blvd., Suite 360, Encino, CA 91436.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**gruvr.com**>, registered with **Godaddy.com, 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 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 October 25, 2007; the National Arbitration Forum received a hard copy of the Complaint on October 26, 2007.

On October 26, 2007, Godaddy.com, Inc. confirmed by e-mail to the National Arbitration Forum that the <**gruvr.com**> domain name is registered with Godaddy.com, Inc. and that the Respondent is the current registrant of the name. Godaddy.com, Inc. has verified that Respondent is bound by the Godaddy.com, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the Policy.

On November 2, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of November 23, 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@gruvr.com by e-mail.

A timely Response was received and determined to be complete on November 23, 2007.

Complainant's timely additional submission was received and determined to be complete on November 28, 2007.

Respondent's additional submission was received on December 4, 2007 and determined to be deficient by virtue of its being untimely filed.

On December 5, 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.

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 its GROOVR Marks inasmuch as the name is sufficiently phonetically and visually similar to Complainant's mark GROOVR as to be likely to cause confusion among Internet users.

Complainant contends that the name and its mark GROOVR are both derived from the term "groovy" which, according to the *2006 Random House Unabridged Dictionary*, is defined as a slang term meaning "highly stimulating or attractive; excellent: groovy music; a groovy car."

Further, Complaint also contends that the name merely substitutes the letter "u" for the letters "oo" in the mark, which is insufficient both phonetically and visually to dispel user confusion, particularly since both Complainant and Respondent operate in the same industry, namely social networking.

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

2. Rights and legitimate interests

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

First, Complainant contends that Respondent's activities at its web site <**gruvr.com**> has not established prior user rights, and hence common law trademark rights, inasmuch as Respondent registered the disputed domain name after Complainant registered its domain name <groovr.com> and after Complainant established its website at the latter domain name.

Second, Complainant states that Registrant is not now and never has been licensed or authorized to use the GROOVR Marks in any manner.

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.

Specifically, Complainant, in viewing its mark GROOVR as being suggestive, pointedly questions whether Respondent simply devised the disputed domain name <**gruvr.com**> on its own.

Further, Complainant alleges that, owing to the similarity of the name to the Complainant's GROOVR mark, Respondent is likely using the name to divert Internet traffic destined to Complainant's web site to Respondent's site instead, thus interfering with Complainant's business. The resulting confusion will likely tarnish and dilute that mark.

Additionally, the launch of Respondent's web site at <**gruvr.com**>, viewed in light of the success Complainant's web site attained, indicates that Respondent traded off the Complainant's goodwill in its marks, thus reflecting bad faith use.

B. Respondent

1. Confusing similarity/identity

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

Specifically, Respondent points to differences under the well-known factors enumerated by the US Court of Customs and Patent Appeals (CCPA) in the seminal case of *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) that negate a likelihood of confusion.

In particular, Respondent contends that: (a) the name and mark are phonetically different, owing to the inclusion of an unlauded U in Respondent's mark GRÜVR; and

(b) Respondent's mark has a different connotation from Complainant's mark GROOVR inasmuch as Respondent's mark (and hence the disputed domain name) was derived from the German term "FUKENGRÜVEN," which was, and remains, a popular parody of the advertising slogan, FAHRVERGNÜGEN, used by Volkswagen in a 1989 U.S. advertising campaign that included a stick figure apparently enjoying a drive. Thus, the disputed domain name and Complainant's mark GROOVR yield different commercial impressions to their intended audiences.

Moreover, Respondent alleges that the services provided by its web site at <gruvr.com> and Complainant's site significantly differ. Specifically, Respondent's site displays concert listings on a map and provides information on local concerts, but has no mobile phone requirement or component, nor any social networking or blogging capability. In contrast, Complainant's web site at <groovr.com> is a mobile phone based social networking and blogging website.

Further, Respondent states that Complainant has not provided any evidence of actual confusion arising from concurrent use of Respondent's mark (and its domain name) and those of Complainant. As evidence of this, Respondent provides a graph, in Exhibit 11 to the Response, from <alexa.com> that compares the Internet traffic of both Respondent's and Complainant's web sites during 2007. The graph explicitly shows the Complainant's web site had a spike in traffic in January of 2007 followed by a gradual decrease in traffic, while Respondent's site had gradually increasing traffic until a large spike in September. Respondent contends that "[i]f there was any confusion whatsoever among consumers the graphs would be similar in shape illustrating that consumers were going from one website to the other after realizing they had mistakenly visited the wrong website. Such a correlation is absent from the graph."

2. Rights and legitimate interests

Respondent, contrary to Complainant's allegations, states that, for any of several reasons, it has rights and legitimate interests in the disputed domain name.

First, Respondent used the name in connection with a *bona fide* offering of services for nearly 10 months, commencing December 5, 2006, prior to receiving any notice from Complainant of the present dispute. In that regard, Respondent states that the first notice it received of this dispute was a September 24, 2007 letter from Complainant's counsel. This alone evidences rights and legitimate interests under paragraph 4(c)(i) of the Policy.

Second, Respondent contends that, as its business, it has been commonly known by the disputed domain name and, as such, has acquired common law trademark rights in that name starting as early as December 5, 2006 when it launched its web site. Inasmuch as this date is prior to the December 6, 2006 date on which Complainant launched its web site, Respondent's common law rights predate those of Complainant.

Third, Respondent contends that the April 11, 2006 date on which Complainant registered its domain name is irrelevant to establish trademark rights, as those rights are

based on use of a mark in commerce and registration of a domain name does not constitute use in commerce. Even though Complainant claims its web site went live on December 6, 2006, it claims first use of its marks, in its trademark registrations, on a later date of January 3, 2007 but regardless of which is correct, either date falls after the date December 5, 2006 on which Respondent first used the disputed domain name and its own mark GRUVR in conjunction with its own web site.

3. Bad faith use and registration

Contrary to Complainant's allegations, Respondent contends that, for any of several reasons, it did not register or use the disputed domain name in bad faith.

First, since the date (December 5, 2006) on which Respondent first used its mark GRUVR predates either date (December 6, 2006 or January 3, 2007) which Complainant appears to claim as its first use date for its mark GROOVR, then any suggestion by Complainant that its mark was suggestive, and thus formed an obstacle to Respondent, is baseless as any trademark rights which accrued to Complainant did not arise until after Respondent started use of its own mark.

Respondent denies that its use of the disputed domain name acts to divert Internet traffic from Complainant's web site to Respondent's site, given that: (a) Respondent had not learned of Complainant's mark GROOVR until some 10 months after Respondent commenced use of the name, and (b) no evidence of any actual confusion exists. Specifically, Respondent points to consumer traffic patterns from <alexa.com> which it believes show no correlation between such patterns for <gruvr.com> and <groovr.com>. Furthermore, Google Adwords provides a "Keyword Tool" that automatically reads a website and composes a report on the keywords used by the website. According to Google's automated analysis, there is no overlap at all between the keywords used by the <groovr.com> and <gruvr.com> sites. Respondent has provided, in Exhibit 12 to the Respondent, hard copy printouts of keyword searches for both of those web sites. Hence, Respondent concludes that any diversion is highly improbable.

Lastly, Respondent disputes Complainant's allegation that Respondent attempted to deliberately trade off of the good will of Complainant. Although both Respondent's and Complainant's web sites were both launched in December 2006, Respondent's launch date preceded Complainant's date by one day and both sites offered different services. Moreover, in view of the <alexa.com> report indicating that Complainant's web site at <groovr.com> achieved commercial success, if any, in January of 2007, Respondent's launch of its web site approximately one month earlier has no relation at all to the commercial activity of Complainant's site. Hence, Respondent views Complainant's allegation as meritless.

C. Additional Submissions

Even though the Complainant's additional submission was timely filed but the Respondent's was not, the Panel considered both submissions.

The Panel finds that both submissions basically reiterated and amplified allegations previously made in the primary filings, and raised other issues that were irrelevant (including, e.g., how the public perceives and defines an umlaut). Hence, for the sake of brevity, the Panel sees no reason and will thus refrain from either summarizing or discussing either of these additional submissions any further.

FINDINGS

A copy of the WHOIS registration record for the disputed domain name appears in Exhibit 4 to the Complaint. As indicated, the domain name was registered on December 3, 2006.

A. Complainant's GROOVR Marks

Complainant owns two United States trademark registrations for the term "GROOVR," in block letters either by itself or with other words, and on which this dispute is based. Complainant has provided, in Exhibit 7 to the Complaint, copies of the records from the publicly-accessible on-line TARR (Trademark Applications and Registrations Retrieval) database provided by the US Patent and Trademark Office. Pertinent details of these registrations are as follows:

- 1) GROOVR (block letters)
United States registration 3,293,317; registered: September 18, 2007
filed: January 8, 2007

This mark is currently registered for use in connection with "Internet and mobile telephone based social networking, dating and introduction services; providing an on-line computer database storing data about individuals consisting of the relationships between the individuals, their contact information, their present location, previous locations, photographs from different locations, personal characteristics, namely, skills, hobbies, interests, educational information, career information, health information, dating information, results of self assessment tests, and other personal information" in international class 45. The Complainant claims first use and first use in commerce of the mark for these services commenced on January 3, 2007.

- 2) GET YOUR GROOVR ON! (block letters)
United States registration 3,293,318; registered: September 18, 2007
filed: January 8, 2007

This mark is currently registered for use in connection with "Internet and mobile telephone based social networking, dating and introduction services; providing an on-line computer database storing data about individuals consisting of the relationships between the individuals, their contact information, their present location, previous locations, photographs from different locations, personal characteristics, namely, skills, hobbies, interests, educational information, career information, health information, dating information, results of self assessment tests, and other personal information" in

international class 45. The Complainant claims first use and first use in commerce of the mark for these services also commenced on January 3, 2007.

B. Complainant and its activities

Complainant provides various services including social networking, blogging, and tracking locations of concerts and other events. Complainant operates a web site at <groovr.com> and registered that domain name on April 11, 2006.

As stated in its trademark registrations, Complainant has continuously provided its services under its marks since January 3, 2007, though Complainant also points to a single instance of its prior use of the mark GROOVR apparently dated December 6, 2006 and appearing on an archived web page provided through <archive.org>.

By letter dated September 24, 2007 to Respondent, Complainant's counsel demanded that Respondent immediately discontinue use of its mark GRUVR and transfer the disputed domain name to Complainant.

C. Respondent and its activities

In the fall of 2006, Respondent conceived and established its GRUVR website, which was initially hosted on <delvr.com>. Subsequently, Respondent moved its website to <**gruvr.com**> on December 5, 2006 and as of that date, Respondent's site resolvable through the disputed domain name was operational.

Respondent's web site at <**gruvr.com**> displays local concert listings on a map, specifically including for each such event: the date of that event, the name of the band performing, the venue for that event and the address of that venue. This web site allows users to set up email alerts and reminders about concerts they may be interested in attending, and also offers "widgets" for their use in presenting such listings on other websites. In Exhibit 3 to the Response, Respondent provided a screenshot of its home page showing these features.

Respondent's web site has no blogging ability and, unlike Complainant's web site, strictly prohibits any type of social networking. Internet users cannot create individual profiles on that site, nor contact other users on or through that site. Moreover, Respondent's site is not mobile telephone based and does not require the use of mobile phones for its use.

As indicated in a print-out of an archived page, obtained through archive.org, from Respondent's web site dated January 26, 2007 -- approximately three weeks after the January 3, 2007 which Complainant claimed as the first date on which it used its GROOVR Marks in interstate commerce, Respondent's web site had already created local map listings for 8,719 events based on data Respondent obtained from other sources.

DISCUSSION

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

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

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

Identical and/or Confusingly Similar

As a threshold matter, to qualify under paragraph 4(a)(i) of the Policy, a complainant must possess legally recognized rights of exclusivity in a mark, to which a disputed domain name is alleged to be either identical or confusingly similar, at the time that name was registered, i.e., those rights must predate the registration.

Those rights may arise through a trademark registration or at common law, the latter in countries such as the US which recognize valid rights in unregistered marks which arise just through use and in instances where, through such use, the mark has become sufficiently distinctive of the goods and/or services with which that mark has then been used. However, if the rights came into existence subsequent to the date on which the name was registered, then complainant has no legitimate basis to challenge respondent for the name -- as complainant had no rights of exclusivity over the name at the time. *See, e.g., Intermark Media, Inc. v. Wang Logic Corp.*, FA 139660 (Nat. Arb. Forum Feb. 19, 2003); *see also Bus. Architecture Group, Inc. v. Reflex Publ’g*, FA 97051 (Nat. Arb. Forum June 5, 2001).

Here, the pertinent facts are simple, undisputed and controlling. Respondent registered the disputed domain name on December 5, 2006. Complainant alleges two separate dates on which it claims to have first used its mark GROOVR in order to establish its rights in that mark: December 6, 2006 and January 3, 2007 -- the latter date being the same first use date which Complainant claimed on both of its federal trademark applications that ultimately issued as its trademark registrations. Though Complainant provides no explanation, let alone credible, as to the cause of this discrepancy, nevertheless, it is irrefutable that each of these dates is subsequent to the December 5, 2006 date on which Respondent registered the disputed domain name. Consequently, as Complainant had no cognizable trademark rights and hence no exclusivity over the term GROOVR or one confusingly similar thereto as of the date on which Respondent registered the disputed domain name, then Complainant has simply failed to meet its burden under paragraph 4(a)(i) of the Policy.

Lastly, no trademark rights arise simply by virtue of registering a domain name. Rather, if that domain name, or more aptly its gTLD (generic top level domain), is used as a mark, then common law trademark rights start accruing in that mark as of and based on its actual use in commerce and in connection with a good or service, and the distinctiveness which the mark achieves thereby. Complainant appears to argue that, merely due to having registered its domain name <groovr.com> on April 11, 2006 which predates the date when Respondent registered the disputed domain name, Complainant then has priority over Respondent for purposes of paragraph 4(a)(i). This view is misguided. Complainant, by its own admission, simply has no trademark rights in its mark GROOVR (which forms the gTLD of its own domain name) prior to December 5, 2006.

Rights or Legitimate Interests / Registration and Use in Bad Faith

In light of the Panel's findings immediately above regarding paragraph 4(a)(i), the Panel can simply dispense with addressing any issue as to whether: (a) the Respondent has rights or legitimate interests in the disputed domain name, and (b) whether Respondent both registered and used that name in bad faith. Thus, the Panel declines Complainant's invitation to do so and hence will not opine on either of these issues. *See, e.g., CPFilms, Inc. v. Solar Lunar Performance Film*, FA 861127 (Nat. Arb. Forum Feb. 6, 2007); *Hugo Daniel Barbaca Bejinha v. Whois Guard Protected*, FA 836538 (Nat. Arb. Forum Dec. 28, 2006); and *Pom Wonderful LLC v. Redavid*, FA 846577 (Nat. Arb. Forum Jan. 8, 2006).

Inasmuch as Complainant has failed to meet its burden under paragraph 4(a)(i) of the Policy, 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: December 18, 2007