

Before the:

**WORLD INTELLECTUAL PROPERTY ORGANIZATION
ARBITRATION AND MEDIATION CENTER**

THE CITY OF NEW YORK,
c/o Office of the Corporation Counsel
New York City Law Department
100 Church Street
New York, NY 10007

WIPO Case No. D2020-3111

and

NYC & COMPANY, INC.,
810 Seventh Avenue, 3rd Fl.
New York, NY 10019

(Complainants)

-v-

Disputed Domain Name(s):

**NEW YORK T.V. SHOW TICKETS,
INC., a/k/a NEW YORK SHOW
TICKETS,**
244 Fifth Avenue, Suite 2094
New York, NY 1001-7604

www.nycvb.com

(Respondent)

REQUEST FOR LEAVE TO FILE REPLY
(Rule, Paragraphs 10, 12)

Complainants seek leave to file a reply to address egregious factual and legal misstatements in Respondent's Response that they could not reasonably have anticipated. [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, \("WIPO Jurisprudential Overview 3.0"\)](#). The Response filed by Respondent misstates the applicable law and mischaracterizes the facts, and it muddies the record with false and unsubstantiated claims of wrongdoing by Complainants and unfounded personal attacks on Complainant NYC & Company's Chairman of the Board and Complainants' counsel. Most egregious, however, is

Respondent's patently and demonstrably false claim that it is using the www.nycvb.com website simply to provide tourist information for non-commercial purposes and without any intent to derive revenue. See Response, at 3, 5, 9.

Under the Policy, legitimate interests in a domain name may be demonstrated by showing that: (i) before any notice of this dispute, respondent used, or demonstrably prepared to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; (ii) respondent has been commonly known by the domain name, even if no trademark or service mark rights have been acquired; or (iii) respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark at issue. Policy 4(c).

In this case, the Respondent has denied use of the domain name in connection with a bona fide offering of goods or services. There is also no proof that Respondent is known by the domain name. Respondent instead contends that it registered and is using the domain name for bona-fide non-commercial purposes. As stated in *Seven Network (Operations) Limited v. Knock Knock WHOIS Not There, LLC*, WIPO Case No. [D2017-0498](#), "the requirements that must be satisfied for a respondent to be able to demonstrate rights or legitimate interests in a domain name under paragraph 4(c)(iii) of the Policy are: (i) the respondent's use of the domain name must be legitimate; (ii) that legitimate use must be either a noncommercial use or a fair use; and (iii) the effect of that use must not be commercial gain through either misleadingly diverting consumers or tarnishing the complainant's trademark."

Here, however, the "mission statement" posted on Respondent's website belies its claim of non-commercial use and refutes its claim of a "legitimate interest" in its use of the identical mark as a domain name. According to the mission statement on Respondent's website, "the NYCVB has been providing tourism services for over 20 years" and provides "a full suite of services for conventions and visitors to NYC . . . [f]rom planning a small event to a massive 10,000+ person conference." <https://www.nycvb.com/about/>. The website contains a link to contact Respondent and inquire about the services it provides. <https://www.nycvb.com/contact-us/>. The mission statement is clear evidence of commercial use.

Respondent's argument to the contrary is analogous to those advanced by fan websites that claim to be informational but are in fact intended to be used for commercial purposes. As noted in [Paragraph 2.5](#) of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions](#), pertaining to fan sites, there are many UDRP cases in which the respondent claims to have an active noncommercial fan site but the panel finds that it is primarily a pretext for commercial advantage. Paragraph 2.5 states:

A respondent does not have rights or legitimate interests in expressing its view, even if positive, on an individual or entity by using an identical or confusingly similar domain name, if the respondent is intentionally misrepresenting itself as being (or as in some way associated with) that individual or entity, or seeks to derive commercial advantage from its registration and use. Also, where the domain name is identical to the trademark, panels have noted that such respondent action prevents the trademark holder from exercising its rights to the trademark and managing its presence on the Internet.

In this case, Complainants have shown that Respondent is using the identical name by which NYC & Company is widely known and intentionally misrepresenting itself as being the NYCVB for the City of New York through its use of the website, with the intention of deriving a commercial advantage.

Respondent also relies heavily on an "abandonment" argument, which utterly lacks merit and could not reasonably have been anticipated, given the undisputed facts. Respondent contends that Complainant NYC & Company abandoned all rights in the NYCVB name and mark because it changed its corporate name and allowed a federal service mark registration for a stylized NYCVB logo to expire. However, the Complaint shows that NYC & Company has continuously used the NYCVB acronym in one form or another to identify itself from its inception in 1935.

As shown in the Complaint, since 2009, Complainant NYC & Company has owned and maintained eight (8) domain registrations with the NYCVB name and mark, which redirect to its primary website at www.nycgo.com. The use of those eight domain registrations in that manner shows that Complainants have continuing rights in the NYCVB name and mark that have not been abandoned. *See WebTrends Inc. v. Search Engine SEO Software Reviews, Mark Chu*, WIPO Case No. [D2008-1520](#) (noting that abandonment requires "clear and convincing proof" and rejecting an

abandonment claim based on the similar use of another domain registration to redirect traffic to the complainant's primary website).

The relevant focus under the Policy and Rules is on the use of the disputed domain name at the time of the filing of the complaint. *Document Technologies, Inc. v. International Electronic Communications, Inc.*, WIPO Case No. [D2000-0270](#) (“The issue under this first factor is whether the Complainant has rights *as of the time of the Complaint.*”) (emphasis in original). Here, the facts show that Complainants have legitimate interests in the use of the nycvb name and mark, by which NYC & Company has been known for decades; and that Respondent adopted the identical name to trade on the established goodwill and secondary meaning associated with the name and the Complainants.

As Respondent noted in its response, there was relative calm between the parties for many years after Respondent registered the disputed domain name, but that is because the website was not being used by Respondent to impersonate NYC & Company. The facts alleged and proven by Complainant show a creeping and increasing misuse of the website by Respondent, which is now causing injury to Complainants. Laches is not a defense. *See, e.g., Sport 2000 Brand AG v. MegaWeb.com Inc d/b/a sport2000*, WIPO Case No. [D2013-1890](#); *Welcomemat Services, Inc. v. Michael Plummer Jr., MLP Enterprises Inc.*, WIPO Case No. [D2017-0481](#); and *Uline, Inc. v. Bhavna Babaria*, WIPO Case No. [D2015-0462](#).

The Complainants certify that the information contained in this Request for Leave to File a Reply is to the best of the Complainants' knowledge complete and accurate, that the Reply is not being presented for any improper purpose, such as to harass, and that the assertions in this Reply are warranted under the Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully submitted,

/s/ Gerald E. Singleton
Gerald E. Singleton