

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

Case No: D2020-3111

and

NYC & COMPANY, INC.,
810 Seventh Avenue, 3rd Floor
New York, NY 10019
(Complainant)

Disputed Domain Name[s]:

-v-

nycvb.com

NEW YORK SHOW TICKETS INC.
770 River Road #84
Edgewater, NJ 07020
(Respondent)

RESPONDENTS RESPONSE TO ADMINISTRATIVE PANEL ORDER NO.1

Unlike the complainant, I will respond directly to the questions asked in the Panel Order No 1 and will not attempt to introduce new evidence or testimony that does not specifically pertain to the questions asked in the panel order. The complainant's response to Panel Order No 1 appears to be an attempt to retry their case by introducing new evidence and theories that do not respond directly to the questions asked of them. With a voluminous response and 42 new pieces of evidence and multiple theories, most of which do not pertain to the questions asked in the Panel Order 1, the complainant is clearly attempting to retry the case and drown the respondent in litigation in the very limited time left in this case schedule and to manipulate the court and its decision. It is requested that the court ignore all new evidence and testimony that does not specifically answer the questions asked of them in the Panel Order No 1.

NEW JERSEY NOTARY ACKNOWLEDGEMENT (AFFIDAVIT)

State of New Jersey
County of Bergen,

I, Noel Turner, being duly sworn, make this my affidavit and state:

a. In a sworn affidavit, made under penalty of perjury (the “Affidavit”), state whether Mr. Turner was aware of Complainant’s use of NYCVB as a trademark at the time the disputed domain name was registered on April 2, 1999.

Response:

I was not aware of the Complainant’s use of NYCVB as a trademark at the time when I registered the disputed domain name on April 2, 1999.

b. In the Affidavit, state whether Respondent has derived revenue from its activities at its domain name <nytix.com>.

Response:

The nycvb.com domain has derived no revenue and is a non-profit, non-commercial resource for visitors to New York City. The nytix.com domain, is however, a profit making corporation, operating under New York Show Tickets Inc., is currently operating, and has been registered as an ‘S’ Corporation in New Jersey since 1997. The two websites are entirely separate other than being owned by the same person.

c. In the Affidavit, admit or deny the allegation that, from April 1999 until May 2014, the disputed domain name was redirected to <nytix.com>. If the allegation is denied, please explain why.

Response:

From April 1999 to 2003, the disputed domain name nycvb.com was not redirected anywhere, and the website was unused and did not have any content appearing. In 2003, the nycvb.com website was launched with its own content and articles and the site has been that way since that launch date to present day.

d. In the Affidavit, admit or deny the allegation that, from May 2014 until September 2017, the disputed domain name was redirected to Complainant’s main website. If this allegation is denied, please explain why. If this allegation is admitted, please explain why this redirection was done.

Response:

The nycvb.com domain name has never been redirected to the complainant’s main website at nycgo.com. There has, however, been deep links from the nycvb.com website to many kinds of NYC city services including mta.info, NYC.gov. The New York City Mayors Office and nycgo.com.

e. In the Affidavit, admit or deny the allegation that, beginning March 2018, the disputed domain name resolved to a website purporting to offer tourism services, on which website certain of Complainant’s copyrighted material appeared. To the extent this allegation is denied, please explain why.

Response:

In March 2018, the disputed domain name and website nycvb.com was up and running and contained a large amount of tourism information on a non-commercial basis. At that time the website did NOT contain any of the Complainant’s alleged copyrighted material. At that time the nycvb.com website contained hundreds of original stories and artwork and the complainant has not disputed this timeline. There was however a very brief period between 11/29/18 and 12/03/18 when the disputed domain and website did contain 8 images that were used with ‘assumed’ permission as the images were derived from the complainants own image repository at business.nycgo.com. That repository is used for NYC promotional materials for use by non-commercial media, of which the respondent’s own website satisfies those conditions and requirements. A total of eight images (out of over 50,000 images that currently exist on nycvb.com) were garnered from the complainants own image media store. The complainant encourages non-commercial media to use this image store which they openly offer for free to ‘non-commercial media use’. The respondent's website nycvb.com appears to meet these “non-commercial media” requirements and had assumed that we were approved to use the images See the complainants own website text where it states:

“Need visuals or video of New York City?”

NYC & Company maintains a library of high-quality digital images and B-roll for noncommercial, media use that depict all five boroughs, local neighborhoods, attractions, experiences and more. These assets are available to download for free from the link below following a brief registration. If you need additional assistance or wish to request an image not found in the library, please contact us. The images and B-roll are no cost and are royalty free”

The link to this complainant’s own image store is located at:

<https://business.nycgo.com/travel-trade/tools-and-resources/media-library/>

As the respondent at nycvb.com is a noncommercial website and is also a media outlet, we had access to the complainant’s image service. We assumed we could use the 8 images from their photo repository in some editorial stories that we crafted. As soon as the complainant identified their disapproval of our use, the images were removed from our website on the very same day that we were informed of their displeasure. All eight images were removed on 12/03/18 and the complainant confirmed such in an email correspondence between both parties.

The respondent’s website at nycvb.com has hundreds of original stories and articles on NYC and thousands of original images, and these eight images represent a tiny fraction of the total images we use. The images were used for a very short time, and removed as soon as we were notified of the complainant’s disapproval, although they still allow other non-commercial media to use these images, clearly not putting us on a level playing field with other competing organizations in the non-commercial media space.

The complainant clearly wishes to make some hay out of the situation in this case, even though the images were only used for a few days and were used in our own articles about NYC and we are a non-commercial media website and satisfy all their criteria for using these photos. Following the photo download, our online account to the shared photo repository at the complainant’s website was then closed. The complainant likes to paint the picture in a different, and altogether misleading, way, but we felt that the images were used in a correct manner, but removed them anyway.

f. In the Affidavit, admit or deny that Mr. Turner received the cease-and-desist letter from Complainant on or about December 3, 2018. If this allegation is admitted, please explain why the Respondent did not reply to it.

Response:

I can confirm that I received the infringement letter concerning the allegedly infringing images from Complainant on or about December 3, 2018. The letter was immediately responded to in both email and verbally over the telephone on December 3, 2018. As the details in section e above cover, the eight allegedly infringing images were removed on that day when we were informed of their displeasure. A follow up email from complainant Natalie Koepff on December 7, 2018 confirmed that the eight images had been removed to their satisfaction, but there still remained the complainant’s argument that the NYCVB moniker belongs to them and also the use of the term “New York Convention and Visitors Bureau” can only be used by them. The section of the complainants email from that date is detailed below”

There is, however, still copyrighted content on the website that belongs to NYC & Company. Furthermore, the website still uses the NYCVB acronym and name New York Convention & Visitor Bureau, which have long been associated in the minds of consumers with NYC & Company, to falsely suggest that the website originates with NYC & Company.

At this point it is unclear what copyrighted content Ms. Koepff is referring to, other than the contested NYCVB and ‘New York Convention and Visitors Bureau’ monikers themselves. Upon receiving that letter, I had a long telephone call with complainant Gerald Singleton on or about December the 8th, 2018. The call with Mr Singleton lasted about 90 minutes and in that call Mr. Singleton discussed his trademark and his claims of rights to the brand ‘NYCVB’, which I disagreed with. He indicated that there was no further copyrighted content appearing. In this call the complainant, Gerald Singleton, kept mentioning that his time is far more important than having to deal with this problem. Mr. Singleton spoke to me from his mobile phone number and his phone records will be able to attest that this call took place and how long it took. In the call, I countered that as the complainant gave up the brand name ‘nycvb’ many years prior, I believed our use of the brand was now perfectly appropriate and that their subsequent trademarks had been registered in bad faith and the large gap in between his bad faith trademark registration and its renewal gave our case more credibility. Another follow-up email from me to the complainants Natalie Koepff and Gerald Singleton dated December 17, 2018, went unanswered but read:

December 17, 2018

Hi Natalie,

As we have previously discussed, the eight images that you had issues with on our website nycvb.com were removed on December 3, 2018, but I still do not see a confirmation from you that your request about these images was completely satisfied.

I am disappointed that you have chosen to pursue a “personal” legal battle, rather than come to a reasonable resolution for the matter at hand, especially given the conversations I had with Bryan Grimaldi in October 2017.

Despite your protestations about your claims to the brand ‘NYCVB’, I respectfully disagree with your legal conclusions. A few important points are still outstanding. Can you provide any recent evidence to reinforce your statement that “NYCVB has long been associated in the minds of consumers with NYC & Company”. Can you also provide any evidence that the trademarked moniker “NYCVB” has been publically used by NYC & Company in the last twenty years, otherwise a trademark opposition can be filed, especially appropriate if Ms. Winningham intends to renew the expiring trademark later this year. I am not aware of a copyright on the term “NYCVB” that you refer to, so please advise about this. I also cannot find a single instance where the NYCVB.com website includes the words “NYC and Company” or any art indicating any direct relationship between the two entities. It has been a very long time since “NYC and Company” was known as the “NYCVB”, a fact that you are more than well aware of. If you intend to change the name of your organization back to NYCVB, then that is a different discussion we can have. When you abandoned the “NYCVB” name in 1998, you do not retain rights in perpetuity to the abandoned name and there can be a reasonable expectation of termination of your rights during its non-use. There is some case law that supports that conclusion and the Lanham Act also defines it, so I believe there is some merit to this case.

As always, I am happy to discuss the matter with you in person, or on a call.

Regards,

Noel Turner

No answer was received back from any of the complainants regarding this email. The email was resent on December 30th, 2018 and again no response was received.

Potentially Erroneous Statement in Panelist Question

By asking “**please explain why the Respondent did not reply to it.**” The panelist has indicated that he is under the misapprehension that no response was sent to the December 3rd, 2018 letter that was sent from complainants. The fact is that there was a flurry of many both written and verbal communications on December 3rd, 2018 in both directions. The complainants did not actually state in their testimony that they did not receive a response; they just inferred that they did not get the resolution that they wanted. See complainants wording “**But respondent refused to comply with said demand**”, which as usual, does not paint the full picture, which was that the eight images were removed post-haste, lots of email and phone

communication then occurred. The complainant never provided the follow-up evidence to back up their statement of rights to the NYCVB moniker other than a bad faith registration of the mark, a trademark expiration and some false platitudes of inferred rights from yesteryear.

g. Provide proof of the allegation (page 7 of the Response) that, beginning on January 10, 2003, Respondent began to use the disputed domain name as a “website for travel and tourism”.

Response:

On January 10 2003, we had the official launch for the NYCVB.com website and have included the press release In Annex 1. Since the website opening day, we have been adding a great deal of content and images over the years, which bring us to the present day with hundreds of articles and thousands of images on the website.

h. Provide proof of the allegation (page 9 of the Response) that, since 2003, Respondent has been “commonly known” as “NYCVB”.

Response:

Since 2003, the respondent's website nycvb.com has been commonly known as ‘NYCVB’ through its many online endeavors. The public website has posted hundreds of articles, thousands of photos, received thousands of emails and received web page visits from many hundreds of thousands of visitors. The term NYCVB features prominently in all stories, communication, art and links. All the major search engines recognize the respondents website nycvb.com as the first result for the search term “NYCVB” and these search engines include; Google.com, Bing.com, Yahoo.com, Ask.com, Baidu.com, Dogpile.com, DuckDuckGo.com, Ecosia.com, Exalead.com, Excite.com, Gigablast.com, Lycos.com, MetaCrawler.com, Mojeek.com, Qwant.com, Searx.com, Sogou, Startpage.com, Swisscows.com, WebCrawler.com, Yandex.com, Yippy.com, and Youdao.com.

Without reiterating all the points that were raised in previous testimony, it is abundantly clear that nycvb.com has been the de facto standard for the term “NYCVB” for many years.

Date: 01/30/2021

Affiant's Signature



Affiant's Name: Noel Turner

Subscribed and sworn to before me on January 30, 2021 by Noel Turner.

 1/30/2021

Notary Public Signature

My Commission Expires: 10/16/2025

