

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)

**COMPLAINANTS' REPLY TO RESPONDENT'S RESPONSE
PURSUANT TO ADMINISTRATIVE PANEL ORDER NO. 1**

Complainants NYC & Company, Inc. (“NYC & Company”) and the City of New York (the “City”) submit the following reply to Respondent’s Response pursuant to Administrative Panel Order No. 1.

The affidavit submitted by Respondent in its Response is filled with demonstrably false statements concerning Respondent’s use of the disputed domain since 1999 to the present and Respondent’s awareness of NYC & Company’s rights in the NYCVB name and mark. Starting with the first question, the Panel Order asked Respondent to “**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” and Mr. Turner stated: “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.”

From the uncontroverted surrounding facts, the Panel may draw the inference that Mr. Turner was aware of NYC & Company’s use of NYCVB as a trademark in April 1999. Mr. Turner has not denied that “New York Show Tickets was previously a member of NYC & Company from 1998 to 2000 and then again from about 2006 to 2011”, when he registered the disputed domain. See Complaint, at page 1. Negative inferences may properly be drawn from the lack of a response to material allegations in a complaint. “It is well-established the Panel may draw inferences about bad faith registration or use in the light of the circumstances such as a lack of response to the complaint and a lack of conceivable good faith.” See F. Hoffmann-La Roche AG v. Direct Privacy, WIPO Case No. D2012-1504; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.

Furthermore, in its Response to the Complaint, Respondent annexed as ANNEX 4 an article dated January 27, 1999 from Travel Weekly, entitled “New York CVB Expands Mission”, to support its claim that NYC & Company abandoned all rights in the NYCVB name and mark at the time he registered the disputed domain. ANNEX 4, however, says just the opposite: it says that NYC & Company was adopting a new name to promote its non-tourism business and that it would continue to use the NYCVB mark for its core tourism business, which in fact it did. The relevant language in ANNEX 4, highlighted for easy reference, shows that Respondent’s claim of a lack of awareness of Complainant’s use of NYCVB as a trademark 1999 is false.

NEW YORK -- **With tourism here booming, the New York Convention and Visitors Bureau will expand its portfolio** to market the Big Apple as a place to live and run a business, **said bureau president Fran Reiter.**

To carry out its new mission, the bureau adopted the new name, NYC & Company, and signed American Express, Time Warner, Con Edison, Federated Department Stores and other non tourism corporate sponsors, Reiter said.

NYC & Company named American Express vice chairman Jonathan Linen, Time Warner vice president Derek Johnson and New York restaurateur Danny Meyer (Union Square Cafe) to its board of directors.

The expanded agency will be headed jointly by Reiter and Tim Zagat, the publisher of the Zagat restaurant guides, who will serve as chairman. Reiter said the agency will retain the NYCVB label for its core tourism marketing efforts.

ANNEX 4 to Respondent's response. The full article appears at

<https://www.travelweekly.com/Destinations2001-2007/New-York-CVB-expands-mission>.

Notably, another article appeared on July 21, 1999 in Travel Weekly, entitled "NYCVB to Reiter – Pick CVB or Mayoral Bid," just months after Mr. Turner registered the disputed domain, which shows that Complainant was prominently using the NYCVB mark and name "Convention and Visitors Bureau." See <https://www.travelweekly.com/Destinations2001-2007/NYCVB-to-Reiter-Pick-CVB-or-mayoral-bid>.

It is common practice for companies to use different trademarks and service marks to promote different parts of their business and specific products and services. Companies may have house marks to identify a line of products rather than a single product. The fact that NYC & Company changed its corporate name in 1999 does not support Respondent's claim of an abandonment of rights to the NYCVB name and mark. NYC & Company obtained a federal registration for the service mark NYCVB in 1998 and has continued to use the NYCVB name mark in different iterations up to the present time. Thus, despite its claims to the contrary, the overwhelming evidence in the record shows that Respondent was aware of Complainant's prior use of the NYCVB name and mark when it registered the disputed domain, and that Respondent has no legitimate rights or interests in the disputed domain and is using it in bad faith.

Next, the Panel Order asked Respondent to state "**whether Respondent has derived revenue from its activities at its domain name <nytix.com>**". The response given by Respondent is short and materially false by omission, as follows:

"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.”**

(Emphasis added).

The foregoing response is materially false in that the www.nycvb.com website contains imbedded clickable links to Respondent’s commercial websites at www.NYtix.com (“New York Show Tickets” and “Discount Broadway Tickets”) and www.TVtaping.com (TV Show Tickets List” and “TV Show Ticket Guide for New York City”) as follows:

Discount Broadway Tickets:

Discount Broadway tickets can be purchased on the day of the show at the [TDF TKTS booth](#) in Times Square (or any one of the other 3 TKTS booths located around NYC). Discounted tickets can also be purchased in advance through the [New York Show Tickets](#) service. This company provides a discount code that can be used in person (no fee) or over the internet or phone (fee applies for phone or web) The discount code can be used for up to 8 ticket purchases per transaction. This service also supplies ticket lottery and standby ticket information and is a paid service.

Broadway Tickets Still Too Expensive?

If the Broadway Show that you want to see is too expensive, you should consider seeing another Broadway Show (or even an off-Broadway show) as there is always something good playing on the Great White Way. [Discount Broadway Tickets](#) does offer standby, Lottery Rush, Student and some other discounted ticket methods that will bring the Broadway show ticket price down, but venturing a little further into the rich cultural landscape of performance arts in New York City, may just pay off more than you ever imagined. If you are dead set on that must-have ticket, then you can exchange some of your time for a lower ticket price, but doing the ticket lottery, standing room only and other last-minute bargains.

(Source: <https://www.nycvb.com/broadway-shows/>).

See also <https://www.nycvb.com/?s=nytix> and <https://www.nycvb.com/broadway-shows/>:

Broadway Show Tickets in NYC

You can buy Broadway tickets from many different ticket outlets in NYC and the cost of the tickets can vary wildly. [Below is our guide to buying Broadway tickets in NYC.](#)

The Best Ways To Buy Broadway Show Tickets

Face Value Broadway Tickets:

Ticket buyers can purchase face value Broadway tickets directly from the box office at the Broadway theatre. Each theatre only sells tickets to their own show (IE you cannot buy Hamilton tickets at the Wicked theatre) The box office does not charge any additional fees for tickets purchased in person. Face value tickets can also be purchased over the phone (or on the internet) from the official ticket source like [Telecharge](#) or [Ticketmaster](#), but these organizations will charge a fee of \$10 for the convenience, making this method better for people from out of town. Your Broadway tickets can still be picked up at the box office or sent to a mailing address, but the \$10 fee/per ticket will still apply. The only way to avoid the fee is to buy the tickets in person at the box office.

\TDF TKTS ticket windows Times Square

Discount Broadway Tickets:

Discount Broadway tickets can be purchased on the day of the show at the [TDF TKTS booth](#) in Times Square (or any one of the other 3 TKTS booths located around NYC). [Discounted tickets can also be purchased in advance through the New York Show Tickets service.](#) This company provides a discount code that can be used in person (no fee) or over the internet or phone (fee applies for phone or web) The discount code can be used for up to 8 ticket purchases per transaction. This service also supplies ticket lottery and standby ticket information and is a paid service.

(photograph omitted)

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See also <https://www.nycvb.com/premium-online-guides-nyc/>:

Broadway Show Discount Guide

Our premium online guide to getting cheap Broadway tickets in New York City includes secret discount codes and other substantial discounts to the top Broadway Shows in New York. More information can be found on the Broadway discount ticket type breakdown. The guide also includes: discount Broadway codes, standing room only (SRO) tickets, anyone rush tickets, cancelled tickets, TDF TKTS Half price theatre ticket stand, partial view tickets, student rush, audience appreciation/rewards programs, group discounts, starving artist tickets, American Express, Visa and Mastercard special offers and discounts, second acting (Getting into the show for free), kids night on Broadway and the seasonal 2 for 1 special deals.

The Discount Broadway Ticket Guide is priced at just \$4.95 – which is a one time fee access for 30 days – subscription does not auto-renew.

Further information for ticket pricing can be found on the [Broadway Show Ticket Price List](#)

Free TV Show Tickets

Free TV show tickets In New York City for the top TV Shows including Stephan Colbert, Live with Kelly and Ryan, The Today show and Saturday Night Live amongst many others. Further information can be found on the [TV Show Ticket List](#). Tickets for TV shows in New York City are usually free, but getting the tickets often require a great deal of perseverance, as the TV shows do a poor job of announcing the availability of tickets and the exact instructions on how to come into possession of them. The TV production's poor communication about ticket availability, coupled with the fact that most TV shows don't actually even give out physical tickets anymore (just a reservation on a list – like a nightclub list) or an email list, leads to a smaller conversion rate IE.

The [TV Show Ticket Guide For New York City](#) is priced at just \$4.95 – which is a one time fee access for 60 days – subscription does not auto-renew.

The foregoing statements, which have appeared on the www.nycvb.com website in one form or another since it was launched with its own content in 2018 (as opposed to simply redirecting to the NYTix.com website or the NYC & Company website, as had been the case prior to 2018), show that Respondent is using the disputed domain to sell subscriptions to guides on his commercial websites. Thus, the sworn statement that Respondent derives no revenue from the nycvb.com website is false. The www.TVtaping.com website is also owned by Respondent. See <https://www.godaddy.com/whois/results.aspx?checkAvail=1&domain=TVtaping.com> (GoDaddy WHOIS domain registration). However, even if the links on the nycvb.com were only to websites owned by an unrelated third party, the inference could be drawn that Respondent is deriving revenue from those links. See *State of Wisconsin v. Pro-Life Domains, Inc.*, WIPO Case No. D2003-0432 (“Using a party’s name to redirect Internet users to an unrelated commercial site for profit is recognized under the Policy as evidence of bad faith registration and use. Policy, Paragraph 4(b)(iv).”).

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, including: “(iv) **by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other online location**, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.” (Emphasis added). The evidence here clearly shows that Respondent is using the nycvb.com website to drive traffic to the NYTix.com and

TVtaping.com websites to sell subscriptions for its “Discount Broadway Ticket Guide” and its “TV Show Ticket Guide for New York City” for commercial gain.

Next, the Panel Order asked Respondent to “**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.**” Respondent flatly denied that the disputed domain was directed to the nytix.com website, but it did not explain why, as the Panel requested. Respondent stated: “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.” The statements are demonstrably false.

The disputed domain was only launched by Respondent with its own content starting in 2018, not 2003, as Respondent has claimed, which can easily be confirmed by reference to the Wayback Machine at archive.org. Moreover, NYC & Company was still using the NYCVB moniker throughout 2003, as confirmed by unsolicited media coverage and articles appearing in trade publications such as Travel Weekly. Annexed as ANNEX 1 are copies of a several articles that appeared in Travel Weekly in 2002, 2003 and 2004, all of which refer to NYC & Company, as “the City’s convention and visitors bureau.” Thus, had Respondent engaged in any due diligence, either when the disputed domain was registered, or later when Respondent allegedly launched the site with its own content, it would have been that NYC & Company was still using the NYCVB name and mark.

Next, the Panel Order asked Respondent to “**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.**” Again, Respondent flatly denied any redirection to the NYC & Company website, and it provided no explanations as requested by the Panel. And again, the statement is demonstrably false.

Captured images archived on the Wayback Machine provide irrefutable evidence of the falsity of Respondent’s sworn statements in its Response to Administrative Panel Order #1. The Wayback Machine images conclusively establishes that Respondent used the disputed domain to redirect traffic to its commercial website, www.NYTitix.com, from 2000 to 2013 and then

redirected traffic to Complainant NYC & Company’s website from 2013 to 2017. As noted in Trinity Mirror Plc and MGN Ltd. v. Piranha Holdings, WIPO Case No. D2008-0004, “[u]se of the disputed domain name to redirect to Complainants’ site does not create any right or legitimate interest in the domain name on the part of Respondent, and instead is most likely part of a strategy to monetize the name through eventual sale or online advertising given the nature of the business pursued by Respondent with respect to other domain names.”

Since 2018, Respondent has used the disputed domain to impersonate a CVB by falsely claiming to be the CVB for the City and by falsely claiming to have relationships with the Mayor’s Office. Most egregious, however, is Respondent’s patently false statement that the disputed domain is used solely for informational non-commercial purposes; quite to the contrary, the disputed domain contains links to other commercial websites that Respondent owns, namely, www.NYtix.com and www.TVtaping.com.

As noted in The Franchise Group v. Jay Bean, WIPO Case No. D2007-1438: “Panels frequently reference the Wayback Machine in order to determine how a domain name has been used in the past. Karl’s Sales and Service Company, LLC v. LaPorte Holdings, Inc., WIPO Case No. D2004-0929; National Football League v. Thomas Trainer, WIPO Case No. D2006-1440; La Francaise des Jeux v. Domain Drop S.A., WIPO Case No. D2007-1157. More properly known as the Internet Archive, the Wayback Machine is a non-profit organization that constructs a library of web pages that have appeared on the Internet over time. It maintains these historical web pages in an archive which is accessible to the public. To research a particular domain name, one simply goes to “www.archive.org” and enters the domain name that one is researching in the Wayback Machine browser.” See also Mr. Green Ltd v. Kemal Marangoz, WIPO Case No. D2015-1833 (“In order to assess the chronology and to better understand some of the assertions made by the parties (where these were undocumented) in addition to visiting the website at the disputed domain name, the Panel also visited the Wayback Machine to inform itself of the Complainant’s use of the “www.garbo.com” website.”).

In their response to the Panel Order, Complainants submitted annexes with captured images from the Wayback Machine covering the period from 2000 to 2017. See Complainants’ ANNEXES 21 and 22. In sharp contrast, Respondent submitted no screenshots and virtually no other evidence to support its claims. Indeed, the only reference to the Wayback Machine by Respondent was in its initial Response, which contained a link to an archived image of the

nycvb.com website as it appeared on March 31, 2018. See Respondent’s Response at page 5 (“An example of what the respondent’s website nycvb.com looked like on March 31, 2018 is located at archive.org: <https://web.archive.org/web/20180331194925/http://www.nycvb.com/>”). This is consistent with the fact that Respondent did not post any content on the nycvb.com website, or use the NYCVB name and mark on the nycvb.com website, until early 2018.

Respondent has admitted that it received a cease and desist from NYC & Company in 2018 and had numerous communications during 2018 regarding Respondent’s unauthorized use of NYC & Company’s copyrighted material on the nycvb.com website. Although Respondent now claims that it only used images contained in an NYC & Company library that were available for free use, it did not offer that excuse in 2018 in response to the cease and desist letter, nor has it provided any proof that the copyrighted images it used came from that library. In fact, they did not come from that library, but rather were cut and pasted from NYC & Company’s website. Respondent’s infringing use of NYC & Company’s copyrighted material on the nycvb.com is just more evidence of a pattern of opportunistic, parasitic bad faith behavior on the part of Respondent, which can be considered by the Panel in reaching a decision.

Next, Respondent was asked to 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.”** Respondent did not provide such proof because there is no such proof, either in the Wayback Machine or anywhere else. Instead, Respondent refers to a self-serving press release it issued through presswire in 2003, which proves nothing about its actual use of the disputed domain in 2003.

Finally, Respondent was asked to provide **“proof of the allegation (page 9 of the Response) that, since 2003, Respondent has been “commonly known” as “NYCVB”.** Here again, Respondent provided no proof. Instead, it refers to the content of the nycvb.com as it exists today, which uses the terms “NYCVB” and “convention and visitor bureau” in many places, but there is no proof that Respondent New York T.V. Show Tickets, Inc. is known as a CVB, apart from internet search results that prove little. There is no evidence unsolicited of media recognition, or consumer feedback to support any claim of name recognition.

Respondent has not explained why the disputed domain still uses, after Respondent's receipt of an ICANN complaint and an earlier cease and desist letter from Complainants, an image of a non-existent building and a non-existent office address in New York City. See <https://www.nycvb.com/about/>. Nor has Respondent explained why it is not licensed or authorized to do business in New York state; and why it falsely claims that it has relationships with the Mayor's Office.

CONCLUSION

As shown above, Respondent was previously a member of NYC & Company from 1998 to 2000 and then again from about 2006 to 2011. Thus, Respondent was a member of NYC & Company at the time it registered the disputed domain and its claim that it was not aware of NYC & Company's prior use and continuing use of the NYCVB name and mark and its trademark rights has been shown to be blatantly false.

Based on the foregoing, Complainants request that the Panel order the transfer of the disputed domain to Complainant NYC & Company.

CERTIFICATION

The undersigned representatives of the Complainants certify that the information contained in this Reply to Respondent's Response to Administrative Order No.1 is to the best of the Complainants' knowledge complete and accurate, that this 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.

Natalie Koepff, in her capacity as Senior Vice President and General Counsel of NYC & Company, certifies that the information contained herein regarding NYC & Company is true, accurate and complete, based on her own personal knowledge and a review of books and records created, kept, and maintained in the ordinary course of business of NYC & Company.

Gerald E. Singleton, in his capacity as Senior Counsel-Intellectual Property for the Office of the Corporation Counsel of the City of New York, New York City Law Department, certifies that the information contained herein regarding the City is true, accurate and complete, based on

his own personal knowledge and a review of books and records created, kept, and maintained in the ordinary course of business of the City of New York.

Dated: New York, New York
February 6, 2021

Respectfully submitted,

/s/ Gerald E. Singleton
Gerald E. Singleton

/s/ Natalie Koepff
Natalie Koepff