



## NATIONAL ARBITRATION FORUM

### DECISION

Happy's Pizza Company v. Navigation Catalyst Systems Inc.  
Claim Number: FA0705000975493

#### PARTIES

Complainant is **Happy's Pizza Company** ("Complainant"), represented by **Mark D. Schneider**, of **Gifford, Krass, Sprinkle, Anderson & Citkowski P.C.**, P.O. Box 7021, Troy, MI 48007-7021. Respondent is **Navigation Catalyst Systems, Inc.** ("Respondent"), represented by **Brett E. Lewis**, of **Lewis & Hand, LLP**, 45 Main Street, Suite 818, Brooklyn, NY 11201.

#### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**happypizza.com**>, registered with **Go Daddy Software, Inc.**

#### PANEL

The undersigned certifies that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

Diane Cabell, Houston Putnam Lowry, and Joel M. Grossman, Chair, as Panelists.

#### PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on May 1, 2007; the National Arbitration Forum received a hard copy of the Complaint on May 2, 2007.

On May 2, 2007, Go Daddy Software, Inc. confirmed by e-mail to the National Arbitration Forum that the <**happypizza.com**> domain name is registered with Go Daddy Software, Inc. and that Respondent is the current registrant of the name. Go Daddy Software, Inc. has verified that Respondent is bound by the Go Daddy Software, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On May 4, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of May 24, 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@happypizza.com by e-mail.

A timely Response was received and determined to be complete on May 24, 2007.

A timely Additional Submission was submitted by Complainant and determined to be complete on May 29, 2007.

A timely Additional Submission was submitted by Respondent on June 1, 2007. Both of these Additional Submissions were considered by the Panel.

On June 5, 2007, pursuant to Respondent's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed Diane Cabell, Houston Putnam Lowry, Chartered Arbitrator, and Joel M. Grossman, Chair, as Panelists.

### **RELIEF SOUGHT**

Complainant requests that the domain name be transferred from Respondent to Complainant.

### **PARTIES' CONTENTIONS**

#### **A. Complainant**

Complainant contends that it has common law trademark rights in the term "Happy's Pizza," and that Respondent's domain name, <**happypizza.com**>, is identical to or confusingly similar to the mark. Complainant notes that it has filed a trademark application with the U.S. Patent and Trademark Office for the mark, and that the application is now pending. Complainant submitted a Declaration as part of its trademark application stating that the mark has been used in commerce since December 1993, and Respondent's registration of the domain name was July 8, 2004. Complainant further asserts that Respondent has no legitimate rights or interests in the name. Specifically, Complainant states that Respondent is not commonly known by the domain name, and does not offer *bona fide* goods or services to the public as a pizza parlor or other type of restaurant. Complainant asserts that Respondent is not making a legitimate noncommercial use of the domain name, since it is using the name to advertise restaurant services or products. Finally, Complainant contends that Respondent registered and continues to use the name in bad faith. Respondent asserts that Complainant has "a long history as a cybersquatter" and cites other cases in which courts or other ICANN panels have so held. Complainant further asserts that Respondent is using the domain name to disrupt Complainant's business and to confuse the public as to the source of Respondent's domain name.

#### **B. Respondent**

Respondent challenges Complainant's assertion that it has a common law trademark in the "Happy's Pizza" name. Respondent points out that Complainant has not submitted any evidence which would demonstrate that the public associates the term with Complainant, or that there is a secondary meaning in the term. In fact, Respondent asserts that the only evidence in the record to support the existence of a common law trademark is Respondent's self-serving statement as part of its trademark application that it has used the mark "Happy's Pizza" in commerce since 1993. Absent additional evidence, Complainant cannot assert a common law trademark in the "Happy's Pizza" name. In the absence of such evidence, Complainant has no basis to challenge the

validity of Respondent's domain name. Second, Respondent asserts that the mark is a compilation of two common terms, happy and pizza, and Complainant cannot monopolize these common terms. Respondent asserts that it has legitimate rights and interests in the domain name, as it is permitted to register common words or a combination of common words for the purpose of Internet advertising. Finally, Respondent contends that it registered the domain name and continues to use the domain name in good faith. It had no notice of Complainant's use of the mark when it registered the domain name, it has never offered to sell the domain name to Complainant, and it has been using the name in a legitimate Internet business. The fact that Respondent may have been deemed a cybersquatter in other cases is immaterial to the present case, which must be judged on its merits.

### C. Additional Submissions

In its Additional Submission Complainant challenges Respondent's assertion that the domain name is merely a combination of two common words, happy and pizza. Complainant asserts that the possessive apostrophe in the term "Happy's Pizza" takes the term out of the universe of common words or terms, because it refers to a particular person's pizza. Additionally, Complainant contends that it is irrelevant that Respondent did not know of the mark when it registered the domain name, as the mark was used and commonly known in commerce.

In its Additional Submission Respondent asserts that Complainant's use in commerce is quite limited, to the Detroit metropolitan area, and is not known nationally. Respondent also contends that there is no real difference between the terms "Happy's Pizza" and "HappyPizza," and that the addition of the apostrophe does not change the fact that the mark is simply a conglomeration of common words.

## **FINDINGS**

The Panel determines that Complainant has not introduced sufficient evidence to prove that it has common law rights in the "Happy's Pizza" mark. Therefore, Complainant has not satisfied Policy ¶ 4(a)(i). Because it cannot meet its initial burden under the Policy, the Panel finds that the relief sought by Complainant must be denied. In light of its finding on this threshold issue, the Panel declines to discuss the issues of Respondent's rights or legitimate interests in the domain name, or of Respondent's bad faith.

## **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:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights;

- (2) 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**

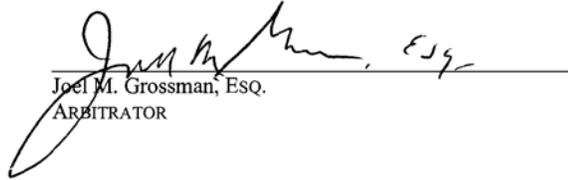
The threshold issue in this case is whether “Happy’s Pizza” can be deemed a “trademark or service mark in which Complainant has rights.” The Policy does not require a complainant to own a federally registered trademark; Complainant may establish common law trademark rights through evidence that it has done business with the name in question “in a sufficient manner to cause a secondary meaning identifiable to complainant’s goods or services.” *Molecular Nutrition, Inc. v. Network News & Pub’ns*, FA 156715 (Nat. Arb. Forum June 24, 2003). As the panel in *Molecular Nutrition* stated: “...the Policy puts the burden squarely on Complainant to establish the fundamental trademark or service mark rights that serve as the foundation for these proceedings.”

In the instant case, Complainant has submitted no evidence to establish its common law rights in the mark. The statement in its trademark application that the mark has been used in commerce since at least December 31, 1993 is insufficient to meet this burden. *See Weatherford Int’l Inc. v. Wells*, FA 153626 (Nat. Arb. Forum May 19, 2003) (“Although Complainant asserts common law rights in the WELLSERV mark, it failed to submit any evidence indicating extensive use or that its claimed mark has achieved secondary source identity. [A claim that the mark is well-known] must be supported by evidence and not self-serving assertions.”). This is especially true when the assertion is being directly challenged by a respondent in its answer.

In the instant case, as in *Weatherford*, Complainant has failed to submit evidence beyond the self-serving Declaration in its trademark application. That Declaration says nothing about extensive use of the mark. All it does is aver that earlier statements in the trademark application are true. The only earlier statement in the application concerning use of the mark in commerce is this: “the mark was first used at least as early as 12/31/1993, and first used in commerce at least as early as 12/31/1993, and is now in use in such commerce.” There is nothing in this statement which indicates the extensiveness of the use in commerce, or supports an assertion that the term has taken on a secondary meaning relating to Complainant. Even after this deficiency was pointed out in the Response, Complainant added nothing on this point in its Additional Submission other than a Declaration from its Chief Operating Officer saying “on information and belief, since 1993 Complainant has been offering restaurant services to the public under the Happy’s Pizza service mark.” As in the original complaint, there is no discussion of the extent of the use of the service mark, or any evidence concerning secondary meaning. Indeed, even the fact of use of the mark since 1993 is offered only “on information and belief.” The Panel thus concludes that Complainant has failed to meet its threshold burden of showing rights in a trademark or service mark, even in a common law trademark.

**DECISION**

Having failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.



Joel M. Grossman, Esq.  
ARBITRATOR

Diane Cabell, Houston Putnam Lowry, Chartered Arbitrator, Joel M. Grossman, Chair, Panelists  
Dated: June 15, 2007

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