



NATIONAL ARBITRATION FORUM

DECISION

Pilgrim Films and Television Inc v. Brandon Bator
Claim Number: FA0702000909831

PARTIES

Complainant is **Pilgrim Films and Television Inc.** ("Complainant"), represented by **Stephen J. Strauss**, of **Fulwider Patton LLP**, 6060 Center Drive, Tenth Floor, Los Angeles, CA 90045. Respondent is **Brandon Bator** ("Respondent"), 37 Bostwick Lane, Chicopee, MA 01020.

REGISTRAR AND DISPUTED DOMAIN NAME

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

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on February 2, 2007; the National Arbitration Forum received a hard copy of the Complaint on February 6, 2007.

On February 2, 2007, Go Daddy Software, Inc. confirmed by e-mail to the National Arbitration Forum that the <**pilgrimfilmsandtelevision.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 February 7, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of February 27, 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@pilgrimfilmsandtelevision.com by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On March 5, 2007, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

This Complaint is based on the following factual and legal grounds: ICANN Rule 3(b)(ix).

- a. The Domain Name is Identical to a Trademark and Service Mark in Which the Complainant Has Rights – ICANN Rules 3(b)(viii), (b)(ix)(1).
 - i. Complainant is in the business of creating and producing "reality-based" television shows, including the hit television series The Ultimate Fighter, American Chopper, American Casino, Dirty Jobs and Ghost Hunters.
 - ii. Complainant commenced using PILGRIM FILMS & TELEVISION as a service mark in connection with its motion picture and television production services at least as early as 1997. Complainant incorporated PILGRIM FILMS AND TELEVISION, INC. as a California corporation on January 27, 1997.
 - iii. Complainant filed on January 16, 2007 federal trademark and service mark applications with the United States Patent and Trademark Office covering the PILGRIM FILMS & TELEVISION and Design mark for " pre-recorded videotapes and video discs featuring television series episodes, sports events, documentaries, and reality-based television shows and series episodes" in International Class 9; and "motion picture, television, videodisc, videotape and multi-media production services;

entertainment services, namely, providing a website featuring news and information in the field of reality-based television shows, documentaries and sports" in International Class 41.

- iv. Complainant operates a website (under the domain <pilgrim-films.com>) providing summaries of the various television shows produced by Pilgrim Films and Television, as well as a history of the company.
 - v. Complainant's PILGRIM FILMS & TELEVISION mark and logo appear at the end of each televised show it produces, on a title card after the end credits. Additionally, Complainant's PILGRIM FILMS & TELEVISION mark and logo appears on DVD compilations of the various shows it produces. These DVD compilations are sold to the public.
 - vi. On November 21, 2005, the Respondent registered the domain name <pilgrimfilmsandtelevision.com>. This domain name incorporates, in its entirety, Complainant's PILGRIM FILMS & TELEVISION mark.
 - vii. To the best of Complainant's knowledge, Respondent has never used or developed the <pilgrimfilmsandtelevision.com> domain name in connection with the bona fide offering of any goods or services. The domain resolves into an inactive website depicting a "404 Error" message.
- b. The Respondent Has No Rights or Legitimate Interests In Respect of the Domain Name -- Policy, Para 4(a)(ii), Rules, Para 3(b)(ix)(2)
- i. Complainant has established with extrinsic proof that it has rights in the PILGRIM FILMS & TELEVISION mark through application with the United States Patent and Trademark Office and by continuous common law use of its mark in commerce. See, Enlightened, Inc. v. Nil, FA 549191 (Nat. Arb. Forum Oct. 18 2005) (ordering transfer of domain name where complainant had only common law rights); SeekAmerica Networks Inc. v. Tariq Masood and Solo Signs, D2000-0131 (WIPO April 13, 2000) (finding that the ICANN Rules do not require trademark registration with a government authority for rights to exist; rights in the mark can be established by pending trademark applications).
 - ii. The contested domain name incorporates, in its entirety, Complainant's PILGRIM FILMS & TELEVISION mark. As such, the Respondent's registration and use of the <pilgrimfilmsandtelevision.com> domain name creates a likelihood of confusion with Complainant's PILGRIM FILMS & TELEVISION mark. Respondent's addition of the generic top-level domain ".com" in the contested domain name to Complainant's PILGRIM FILMS & TELEVISION mark does not negate the confusingly similar aspects of Respondent's domain name, pursuant to Policy ¶4(a)(i).

- iii. Complainant has no relationship with the Respondent, nor has Complainant given permission or authorized the Respondent to register and use the contested domain name.
 - iv. To the best of the Complainant's knowledge, the Respondent has not been commonly known by the contested domain name.
 - v. Complainant submits that the Respondent had actual and constructive knowledge of Complainant's rights in the PILGRIM FILMS & TELEVISION mark and names when he registered the <pilgrimfilmsandtelevision.com> domain name.
 - vi. Respondent has made no demonstrable preparations to use the contested domain which resolves into an inactive website depicting a "404 Error" message. Such a use is neither a bona fide offering of goods or services pursuant to Policy ¶4(c)(i) nor a legitimate noncommercial or fair use pursuant to Policy ¶4(c)(iii). See, Jaclyn Smith and Jaclyn Smith International, Inc. v. Unasi, Inc., FA0507000522853 (Nat. Arb. Forum September 7, 2005).
- c. The Domain Name Was Registered and is Being, Used in Bad Faith -- Policy paras 4(a)(iii), 4(b); Rules, para 3(b)(ix)(3).
- i. Respondent's passive holding of the contested domain constitutes evidence of bad faith. See, Radio & Records, Inc. v. Jucco Holdings c/o Admin, FA0603000665108 (Nat. Arb. Forum May 9, 2006) ("Respondent's <radioandrecord.com> domain name, which is confusingly similar to Complainant's well-known RADIO & RECORDS mark, directs Internet users to an inactive website. The panel interprets Respondent's passive holding of the disputed domain name as evidence that Respondent registered and used the domain name in bad faith pursuant to Policy ¶4(a)(iii)").
 - ii. Alternatively, Respondent's registration of the contested domain, despite knowledge of Complainant's common law rights in the PILGRIM FILMS & TELEVISION mark, is evidence, in and of itself, of bad faith registration and use. See, The Atlantic Paranormal Society and Pilgrim Films and Television, Inc. v. Xerium Technologies, FA0510000575661 (Nat. Arb. Forum November 23, 2005) ("Respondent's registration of a domain name containing Complainant's mark with actual knowledge of Complainant's rights in the mark is evidence of bad faith registration and use pursuant to Policy ¶4(a)(iii)).

B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant, Pilgrim Films and Television Inc., is in the business of creating and producing reality-based television shows, including the television series "The Ultimate Fighter," "American Chopper," "American Casino," "Dirty Jobs" and "Ghost Hunters."

Complainant has used the PILGRIM FILMS & TELEVISION mark in connection with its motion picture and television production services as early as 1997. Complainant has provided evidence of its incorporation with the California Secretary of State on January 27, 1997. Additionally, Complainant has filed an application with the United States Patent and Trademark Office (“USPTO”) for the PILGRIM FILMS & TELEVISION mark (Ser. No. 77/084197 filed January 16, 2007).

Respondent registered the <pilgrimfilmsandtelevision.com> domain name on November 21, 2005. Respondent has not made any use of the disputed domain name since registering it almost one and a half years ago.

DISCUSSION

Paragraph 15(a) of 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."

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) (“In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.”).

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; and
- (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

Complainant is not required to own a trademark registration to establish rights in the PILGRIM FILMS & TELEVISION mark under Policy ¶4(a)(i). *See SeekAmerica Networks Inc. v. Masood*, D2000-0131 (WIPO Apr. 13, 2000) (finding that the Rules do not require that the complainant's trademark or service mark be registered by a government authority or agency for such rights to exist); *see also Great Plains Metromall, LLC v. Creach*, FA 97044 (Nat. Arb. Forum May 18, 2001) (“The Policy

does not require that a trademark be registered by a governmental authority for such rights to exist.”).

Complainant has established common law rights in the PILGRIM FILMS & TELEVISION mark through continuous and extensive use of the mark in connection with its business since at least 1997. Complainant has provided evidence of its incorporation with the California Secretary of State on January 27, 1997, and Complainant has filed an application with the United States Patent and Trademark Office (“USPTO”) for the PILGRIM FILMS & TELEVISION mark showing a first use in September 2001. Accordingly, the Panel finds Complainant’s PILGRIM FILMS & TELEVISION mark has acquired secondary meaning sufficient to establish common law rights in the mark. *See S.A. Bendheim Co., Inc. v. Hollander Glass*, FA 142318 (Nat. Arb. Forum Mar. 13, 2003) (holding that the complainant established rights in the descriptive RESTORATION GLASS mark through proof of secondary meaning associated with the mark); *see also Keppel TatLee Bank v. Taylor*, D2001-0168 (WIPO Mar. 28, 2001) (“[O]n account of long and substantial use of [KEPPEL BANK] in connection with its banking business, it has acquired rights under the common law.”).

The Panel finds Respondent’s <**pilgrimfilmsandtelevision.com**> domain name is confusingly similar to Complainant’s PILGRIM FILMS & TELEVISION mark because it replaces the ampersand with the term “and” and adds the top-level domain “.com,” which does not significantly distinguish the domain name from the mark pursuant to Policy ¶4(a)(i). *See Wright & Lato, Inc. v. Epstein*, D2000-0621 (WIPO Sept. 2, 2000) (finding that the <wrightandlato.com> domain name is identical to the complainant’s WRIGHT & LATO mark, because the ampersand symbol (&) is not reproducible in a URL); *see also PG&E Corp. v. Anderson*, D2000-1264 (WIPO Nov. 22, 2000) (noting that PG&E’s home web page is found at <pge.com> because the ampersand symbol is not reproducible in a domain name); *see also Busy Body, Inc. v. Fitness Outlet Inc.*, D2000-0127 (WIPO Apr. 22, 2000) (“[T]he addition of the generic top-level domain (gTLD) name ‘.com’ is . . . without legal significance since use of a gTLD is required of domain name registrants . . .”).

The Panel finds Policy ¶4(a)(i) satisfied.

Rights or Legitimate Interests

Under Policy ¶4(a)(ii), the burden is on Complainant to prove Respondent does not have rights and legitimate interests in the disputed domain name. Once Complainant has made a *prima facie* case, the burden then shifts to Respondent to show that it has rights or legitimate interests pursuant to Policy ¶4(c). *See Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (once the complainant asserts that the respondent has no rights or legitimate interests with respect to the domain, the burden shifts to the respondent to provide “concrete evidence that it has rights to or legitimate interests in the domain name at issue”); *see also Compagnie Generale des Matieres Nucleaires v. Greenpeace Int’l*, D2001-0376 (WIPO May 14, 2001) (“Proving that the Respondent has

no rights or legitimate interests in respect of the Domain Name requires the Complainant to prove a negative. For the purposes of this sub paragraph, however, it is sufficient for the Complainant to show a prima facie case and the burden of proof is then shifts on to the shoulders of Respondent. In those circumstances, the common approach is for respondents to seek to bring themselves within one of the examples of paragraph 4(c) or put forward some other reason why they can fairly be said to have a relevant right or legitimate interests in respect of the domain name in question.”).

Respondent has not made any use of the <**pilgrimfilmsandtelevision.com**> domain name since registering it November 21, 2005. Internet users who seek out the website are directed to a website that does not display any information, indicating that the domain name is not associated with any active website. The Panel finds Respondent registered a domain name incorporating the dominant features of Complainant’s mark but has not posted any content at the resultant website for almost a year and a half. Such nonuse does not constitute a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy ¶4(c)(iii). *See AT&T Corp. v. Domains by Brian Evans*, D2000-0790 (WIPO Sept. 27, 2000) (finding no rights or legitimate interests where the respondent did not provide any documentation on the existence of its alleged company that might show what the company’s business was, or how the company’s years of existence, if it ever existed, might mesh with the complainant’s trademark claims); *see also LFP, Inc. v. B & J Props.*, FA 109697 (Nat. Arb. Forum May 30, 2002) (holding a respondent cannot simply do nothing and effectively “sit on his rights” for an extended period of time when that the respondent might be capable of doing otherwise).

Respondent registered the domain name under the name “Brandon Bator” and there is no evidence in the record suggesting Respondent is commonly known by the <**pilgrimfilmsandtelevision.com**> domain name. Respondent has not established rights or legitimate interests in the <**pilgrimfilmsandtelevision.com**> domain name pursuant to Policy ¶4(c)(ii). *See RMO, Inc. v. Burbridge*, FA 96949 (Nat. Arb. Forum May 16, 2001) (interpreting Policy ¶4(c)(ii) "to require a showing that one has been commonly known by the domain name prior to registration of the domain name to prevail"); *see also Great S. Wood Preserving, Inc. v. TFA Assocs.*, FA 95169 (Nat. Arb. Forum Aug. 5, 2000) (finding that the respondent was not commonly known by the domain name <greatsouthernwood.com> where the respondent linked the domain name to <bestoftheweb.com>).

The Panel finds Policy ¶4(a)(ii) satisfied.

Registration and Use in Bad Faith

Complainant also alleged Respondent acted in bad faith. Respondent has not posted any content at the website (or page) associated with the <**pilgrimfilmsandtelevision.com**> domain name. Respondent has held the respective registration for almost a year and a half. With no content associated at the website and no evidence of Respondent’s

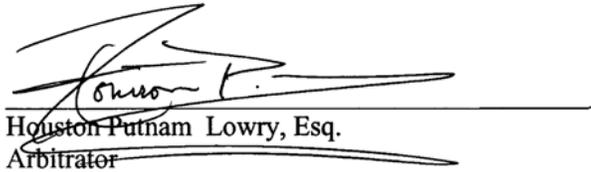
preparations to use the disputed domain name, the Panel concludes Respondent registered and used the <**pilgrimfilmsandtelevision.com**> domain name in bad faith, pursuant to Policy ¶4(a)(iii). See *Pharmacia & Upjohn AB v. Romero*, D2000-1273 (WIPO Nov. 13, 2000) (finding no rights or legitimate interests where the respondent failed to submit a response to the complaint and had made no use of the domain name in question); see also *Am. Online, Inc. v. Kloszewski*, FA 204148 (Nat. Arb. Forum Dec. 4, 2003) (“Respondent's passive holding of the <aolfact.com> domain name for over six months is evidence that Respondent lacks rights and legitimate interests in the domain name.”).

The Panel finds Policy ¶4(a)(iii) satisfied.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**pilgrimfilmsandtelevision.com**> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: March 15, 2007

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