

ADMINISTRATIVE PANEL DECISION

National Collegiate Athletic Association v. John Donato, VAST Marketing Group

Case No. D2022-1221

1. The Parties

Complainant is National Collegiate Athletic Association, United States of America (“United States”), represented by Loeb & Loeb, LLP, United States.

Respondent is John Donato, VAST Marketing Group, United States.

2. The Domain Names and Registrar

The disputed domain names <2023finalfour.com> and <2023mensfinalfour.com> are registered with Launchpad.com Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 6, 2022. On April 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 7, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on April 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 10, 2022. Respondent did not submit any response within the deadline. Accordingly, the Center notified Respondent’s default on May 13, 2022. Respondent sent two informal communications to the Center on May 14, 2022, and on May 20, 2022.

The Center appointed Brian J. Winterfeldt as the sole panelist in this matter on May 27, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the

Rules, paragraph 7.

4. Factual Background

Complainant National Collegiate Athletic Association (“NCAA”) governs intercollegiate athletics in the United States. Complainant is a member-led organization dedicated to college athletics and athletes that consists of 1,098 colleges and universities, 102 athletic conferences, and 40 affiliated sports organizations. Complainant organizes the athletic programs of many colleges and universities in the United States and Canada. Complainant has been using the mark FINAL FOUR in connection with its annual basketball tournaments since at least as early as 1977, and has expanded its use of FINAL FOUR and marks incorporating FINAL FOUR to include other products and services (the “FINAL FOUR Marks” or “the Mark”).

Complainant owns several trademark registrations for the FINAL FOUR mark and for marks containing FINAL FOUR in multiple jurisdictions, with sample registration details as follows:

- FINAL FOUR, United States Reg. No. 1,164,713, registered on August 11, 1981;
- FINAL FOUR, United States Reg. No. 1,488,836, registered on May 17, 1988;
- ROAD TO THE FINAL FOUR, United States Reg. No. 2,600,599, registered on July 30, 2002.

Complainant also owns numerous domains incorporating its FINAL FOUR Marks, including, but not limited to, <ncaafinalfour.com>, <ncaafinalfour.org>, <finalfour.com>, and <myfinalfour.com>. Complainant’s main domain name, <ncaa.com>, registered on December 29, 1997, is Complainant’s official website for its Basketball Tournament and Final Four round.

The disputed domain names were registered on December 3, 2021. Currently, the disputed domain names redirect to <wildcard.hostgator.com>, which resolves to an inactive parked webpage.

5. Parties’ Contentions

A. Complainant

According to Complainant, the disputed domain names are identical or confusingly similar to Complainant’s FINAL FOUR trademark in which Complainant has rights as demonstrated through its cited registrations. The Mark was adopted and has been continuously used since at least as early as 1977, in connection with its annual basketball tournaments. Complainant maintains its online presence primarily through its website hosted at <ncaa.com>.

Complainant argues that the disputed domain names fully incorporate the Mark. Complainant also argues that the addition of “2023” at the front of the Mark, and the addition of “2023mens” at the front of the Mark, is clearly not sufficient to avoid a finding of confusing similarity with Complainant’s prior rights. Complainant argues that the addition of the nondistinctive descriptive year “2023” and/or term “mens” clearly refer to Complainant’s 2023 Final Four round of the Tournament and/or 2023 Men’s Final Four round of the Tournament. Complainant argues that, due to the complete reproduction of Complainant’s company name and prior well-known trademarks, Internet users will obviously and wrongly think that the disputed domain names belongs to Complainant or have been registered in its name.

Complainant asserts that Respondent lacks any rights or legitimate interests in the disputed domain names. According to Complainant, Respondent does not have any trademark rights to the Mark, nor does Respondent make any *bona fide* offering of services on the website to which the disputed domain names resolve. Complainant alleges that no active websites are associated with the disputed domain names. Complainant argues that the passive holding of a domain name may not be a *bona fide* offering of goods or services or legitimate noncommercial or fair use under the Policy paragraph 4(c)(i) or (iii). Complainant also

asserts that it has not granted Respondent, by license or otherwise, permission to use the Mark in any way. Complainant argues that the disputed domain names were registered by Respondent without Complainant's consent.

Complainant argues that Respondent both registered and is using the disputed domain names in bad faith. According to Complainant, Respondent's registration of the disputed domain names consisting of Complainant's famous FINAL FOUR mark plus the terms "2023" and/or "mens" on its own constitutes bad faith on account of confusing similarity and the lack of any affiliation between Complainant and Respondent. Complainant argues that Respondents could not make any active good faith use of the disputed domain names without creating a false impression of association with Complainant, and so the passive holding of the disputed domain names under the current circumstances constitutes use in bad faith. Complainant argues that Respondent could not have been unaware of the existence of Complainant's famous FINAL FOUR mark when registering the disputed domain names. Complainant argues that the mere fact that Respondent has registered the disputed domain names, which incorporate the famous FINAL FOUR mark belonging to the well-known administrator of collegiate athletics, is alone sufficient to give rise to an inference of bad faith. Complainant sent a cease and desist letter to Respondent on January 26, 2022, and two follow-up emails thereafter but received no response, which Complainant argues is further evidence of bad faith. Complainant also argues that Respondent provided a false contact address when registering the disputed domain names. Complainant's demand letter sent to Respondent's address indicated in the Whois record was returned as "undeliverable." Complainant argues that this fact suggests that Respondent's address and contact information provided to the Registrar are false, which Complainant argues can also be considered a further inference of bad faith registration. Complainant argues that such actions clearly show the disputed domain names were registered and are being used in bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions. Respondent sent two informal communications to the Center one on May 14, 2022, and another one on May 20, 2022, asking what it is all about and stating that it does not make sense, the latter being sent despite the Center's email informing Respondent that a Complaint was filed against him under the UDRP.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain name were registered and are being used in bad faith.

A respondent's failure to reply to the complainant's contentions does not by itself satisfy a complainant's burden of proof and is not necessarily an admission that the complainant's allegations are true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Thus, even though Respondent has failed to address Complainant's contentions, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

A. Identical or Confusingly Similar

A national or international trademark registration is *prima facie* evidence that the holder has the requisite rights in the registered mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant has provided evidence that it owns multiple trademark registrations for the FINAL FOUR

trademark as referenced above. Therefore, Complainant has established that it has rights in the Mark.

The remaining question under the first element of the Policy is whether the disputed domain name (typically disregarding the Top-Level Domain (“TLD”) in which the domain name is registered) is identical or confusingly similar to Complainant’s mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. [WIPO Overview 3.0](#), section 1.7. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. *Id.*

Here, the disputed domain names incorporate the entirety of the Mark, adding only the year “2023” and/or term “mens”, which does not prevent a finding of confusing similarity. A side-by-side comparison of the Mark and the disputed domain names reveals that the Mark is easily identifiable within the disputed domain names.

Therefore, the Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain names are confusingly similar to its FINAL FOUR mark.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, Complainant must make at least a *prima facie* showing that Respondent possesses no rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), section 2.1. Once Complainant makes such a *prima facie* showing, the burden of production shifts to Respondent, though the burden of proof always remains on Complainant. If Respondent fails to come forward with evidence showing rights or legitimate interests, Complainant will have sustained its burden under the second element of the UDRP.

Paragraph 4(c) of the Policy lists the ways that Respondent may demonstrate rights or legitimate interests in the disputed domain names:

- (i) before any notice of the dispute, Respondent’s use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services; or
- (ii) Respondent (as an individual, business or other organization) has been commonly known by the disputed domain names, even if it has acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Here, Complainant has alleged that Respondent has no rights or legitimate interests in the disputed domain names. Respondent has failed to come forward with any evidence showing rights or legitimate interests. Respondent has not submitted any arguments or evidence to rebut Complainant’s contention that Respondent is not an assignee or licensee of Complainant and that Respondent has no other business relationship with Complainant. Complainant has contended that Respondent is not commonly known by the disputed domain names and that there is no evidence that Respondent has established trademark rights in the disputed domain names. Again, Respondent has not provided any evidence or arguments to demonstrate that it has such rights. Complainant has put forward a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain names, which Respondent has not rebutted.

Accordingly, the Panel finds that Respondent does not have any rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

Bad faith is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. Paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

Here, Respondent's actions align with 4(b)(iv) of the Policy. The disputed domain names contain the entirety of the FINAL FOUR mark, with the addition of the nondistinctive descriptive year "2023" and/or descriptive term "mens". Due to the well-known nature of Complainant's Mark, evidenced by its numerous trademark registrations for FINAL FOUR, as well as widespread brand recognition supported by numerous registered domain names maintaining its significant online presence, along with the unauthorized use of the Mark in the disputed domain names, Respondent was undoubtedly aware of Complainant and the Mark when it registered the disputed domain names and clearly intended to create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the website or online location to which the disputed domain names redirect.

This Panel therefore finds that Respondent acted in bad faith by its registration and use of the disputed domain names, intentionally creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the website with the purpose of attracting Internet users for commercial gain as per paragraph 4(b)(iv) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names, <2023finalfour.com> and <2023mensfinalfour.com>, be transferred to Complainant.

/Brian J. Winterfeldt/

Brian J. Winterfeldt

Sole Panelist

Date: June 10, 2022