

## **ADMINISTRATIVE PANEL DECISION**

Traffic Jam Swing, Inc. v. Brandon Bair  
Case No. D2023-4131

### **1. The Parties**

The Complainant is Traffic Jam Swing, Inc., United States of America ("United States"), represented by Foley & Lardner LLP, United States.

The Respondent is Brandon Bair, New Zealand.

### **2. The Domain Name and Registrar**

The disputed domain name <secondcityswingout.com> is registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 4, 2023. On October 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 4, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy / Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 10, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 15, 2023. Further to the Center's request for amendment, the Complainant filed an amendment to the Complaint on October 25, 2023.

The Center verified that the Complaint together with the amended 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 the Respondent of the Complaint, and the proceedings commenced on October 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 17, 2023.

The Center appointed Mihaela Maravela as the sole panelist in this matter on December 7, 2023. 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**

According to information in the Complaint, the Complainant is a nonprofit organization dedicated to supporting Chicago Swing Dance and Lindy Hop by promoting the education, history, and culture of swing dance in Chicago through events, workshops, and classes. In 2018, the Complainant created Second City Swingout, a national dance workshop event held in the city of Chicago to teach and educate attendees about swing dance. The Complainant markets its Second City Swingout event throughout the United States and the world under its unregistered trademark SECOND CITY SWINGOUT.

Also, according to information in the Complaint, the Complainant has spent a significant amount of time, money, and effort in promoting and advertising its SECOND CITY SWINGOUT events around the world, firmly establishing the Complainant's rights in the mark. Specifically, the Complainant has used the SECOND CITY SWINGOUT trademark since as early as 2018. The Complainant's annual dance events regularly register close to 300 attendees, with ticket sales totaling between USD 30,000 – USD 50,000 and several additional thousands of dollars in merchandise sales. The Complainant and its SECOND CITY SWINGOUT trademarks have been prominently featured in online and print advertisements, promotions, and in other industry or well-known domestic publications in the United States, and have been advertised extensively on Facebook.

As per the Complaint, the disputed domain name was initially registered by the Complainant on October 29, 2017, but was inadvertently allowed to lapse. The Complainant further claims that between January 14, 2018 and October 19, 2020, it exclusively owned and operated the website available at the disputed domain name at the time and used the site to provide authorized information and details about the Complainant's SECOND CITY SWINGOUT services, offer tickets to the events, and otherwise promote its dance educational services. The disputed domain name was registered by the Respondent on January 18, 2021 and was used to point to a website that was a near identical copy of the Complainant's previous website at the disputed domain name, including an advertisement of the Complainant's Second City Swingout dance event, except that the Respondent's website contained links to third-party gambling websites. At the date of the Decision, the access to the website at the disputed domain name was blocked for security reasons.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, as described in the factual section above, the Complainant contends that the SECOND CITY SWINGOUT trademark has acquired distinctiveness, became well known and is associated exclusively with the Complainant, thereby creating tremendous goodwill and value to the Complainant. The Complainant thereby asserts common law rights in the SECOND CITY SWINGOUT trademark.

As regards the second element, the Complainant argues that the Respondent, who was using a privacy shield, is not a licensee of the Complainant, nor is it authorized to use any of the SECOND CITY SWINGOUT trademarks or any marks confusingly similar thereto. Beginning on or about April 12, 2022, the Complainant learned that the disputed domain name was pointing to a website that was a near identical copy of the Complainant's site, except that the Respondent's site contained links to third-party gambling websites. The website at the disputed domain name used identical copies of the Complainant's SECOND CITY

SWINGOUT trademarks, including the Complainant's designs and logos. The Respondent's use of a domain name that is confusingly similar to the Complainant's SECOND CITY SWINGOUT trademarks in conjunction with a website that was an exact copy of the Complainant's former site and appeared to continue to offer dance instruction services, including reference to the Complainant's own events, along with links to gambling sites, is neither a *bona fide* offering of goods or services, nor is it a legitimate noncommercial or fair use pursuant to the Policy.

With respect to the third element, the Complainant argues that the Respondent registered the disputed domain name, which incorporates the Complainant's entire, identical well-known SECOND CITY SWINGOUT trademark more than three years after its use by the Complainant. Moreover, the website at the disputed domain name was pointing to is an exact replica of the Complainant's former site. The only reason the Respondent registered the disputed domain name was to attract users looking for the Complainant's website, for the Respondent's own commercial gain. The registration and use of an infringing domain name in order to misdirect consumers, display banner advertisements or links to third-party commercial websites, or subject users to unsolicited pop-up advertisements, is evidence of bad faith.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

No response has been received from the Respondent in this case. Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules. The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name, and (iii) the disputed domain name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or 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.

Based on the available record, the Panel finds the Complainant has established unregistered trademark or service mark rights for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.3.

As such, the Complainant submits it acquired common law trademark rights in the trademark SECOND CITY SWINGOUT. To establish unregistered or common law trademark rights for purposes of the UDRP, a complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services. In support of its claimed rights, the Complainant has provided screen captures of its previous website and Facebook page and other evidence that include promotion of its services, that feature SECOND CITY SWINGOUT to show that it has become distinctive of the Complainant's services such that the Panel finds that the un rebutted evidence filed by the Complainant prove that SECOND CITY SWINGOUT has acquired sufficient relevant secondary meaning in connection with the Complainant's services offered under the mentioned sign sufficient to confer trademark rights on the Complainant. The fact that the Respondent has targeted the Complainant by reproducing the contents of the

Complainant's previous website on the website at the disputed domain name confirms the Complainant's assertion that its trademark has acquired significance as a source identifier (section 1.3 and 1.15, [WIPO Overview 3.0](#)). The Panel thus finds that the Complainant has established trademark rights in SECOND CITY SWINGOUT for the purposes of paragraph 4(a)(i) of the Policy.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

There is no evidence that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services, nor does the Respondent appear to engage in any legitimate noncommercial or fair use of the disputed domain name within the meaning of paragraphs 4(c)(i) and (iii) of the Policy. Rather, according to the un rebutted evidence put forward by the Complainant, the disputed domain name was used to host a website copying the Complainant's former website at the disputed domain name, and later containing links to gambling websites, which shows in the Panel's view, the Respondent's intention to divert consumers for commercial gain to such websites, by taking unfair advantage of the goodwill and reputation of the Complainant's rights. Also, the evidence demonstrates that the disputed domain name was registered opportunistically by the Respondent after the previous registration by the Complainant was allowed to lapse. The Panel considers that such use does not confer rights or legitimate interests on the Respondent. The Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate interests in the disputed domain name.

Also, there is no evidence that the Respondent is commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy.

Based on the available record, the Panel finds the second element of the Policy has been established.

## **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

By registering the disputed domain name after it was inadvertently allowed to lapse following a period of registration and use by the Complainant, and by using it in the manner described above, it is clear to the Panel that the Respondent registered the disputed domain name with the Complainant in mind having no intent to use the disputed domain name for any legitimate purpose. Rather, the Respondent has made use of the disputed domain name in an effort to unfairly draw traffic based on the reputation of the Complainant. The Panel finds that the disputed domain name was registered in bad faith.

As regards the use of the disputed domain name, from the uncontested evidence in the case file, it results that the disputed domain name was used for a website reproducing the contents of the Complainant's official website previously appearing at the disputed domain name and including links to third-party gambling websites. Given the identity between the Complainant's trademark and the disputed domain name, and that according to unrebutted assertions of the Complainant, the Respondent might derive financial benefit from redirecting Internet users to third-party gambling websites, the Panel considers that the disputed domain name is intended to attract Internet users by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites or other online location or of a service offered on such other online location within the terms of paragraph 4(b)(iv) of the Policy.

Moreover, the Respondent has not formally participated in this proceeding and has failed to rebut the Complainant's contentions.

Based on the available record, the Panel finds that the Complainant has established the third element 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 name <secondcityswingout.com> be transferred to the Complainant.

*/Mihaela Maravela/*

**Mihaela Maravela**

Sole Panelist

Date: December 20, 2023