

## **ADMINISTRATIVE PANEL DECISION**

Side by Side, Inc. /dba/ Sidetrack v. Alexander Lerman  
Case No. D2012-0771

### **1. The Parties**

The Complainant is Side by Side, Inc. /dba/ Sidetrack of Chicago, Illinois, United States of America (“United States”), represented by Quarles & Brady LLP, United States.

The Respondent is Alexander Lerman of Berkeley, California, United States, represented by John Berryhill, Ph.D., Esq., United States.

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

The disputed domain name <sidetrack.com> is registered with Name.com LLC.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 13, 2012. On April 16, 2012, the Center transmitted by email to Name.com LLC a request for registrar verification in connection with the disputed domain name. On April 16, 2012, Name.com LLC transmitted by email to the Center its verification response confirming that the 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced April 20, 2012. In accordance with the Rules, paragraph 5(a), the due date for Response May 10, 2012. The Response was filed with the Center May 10, 2012.

The Center appointed Peter L. Michaelson, Karen Fong and Tony Willoughby as panelists in this matter on June 5, 2012. The Panel finds that it was properly constituted. Each member of 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.

Based on the deadline set forth in paragraph 15 of the Rules, a decision is to be issued by the Panel by June 19, 2012. However, due to exceptional circumstances recently experienced by the Panel, the Panel extended the deadline to July 3, 2012.

#### **4. Factual Background**

As indicated in the Whois registration record appearing in Annex 1 to the Complaint, the disputed domain name <sidetrack.com> was created on September 23, 1998 and will expire on September 22, 2013.

##### **A. The Complainant's SIDETRACK Marks**

The Complainant owns three United States registrations for the mark SIDETRACK in block letters. The Complainant has provided, in Annex 4 to the Complaint, a copy of the records for these registrations as listed on the publicly accessible TESS (Trademark Electronic Search System) database provided by the United States Patent and Trademark Office (PTO). Pertinent details of the registrations are as follows:

1. SIDETRACK (block letters)  
United States registration no. 3,563,800  
registered: January 20, 2009; filed: May 22, 2008

This mark is registered for use in connection with: "Sunglasses; magnets", "Pins", "Post cards", "Sports jerseys, clothing, namely, T-shirts, sweatshirts and jackets; and hats", "Buttons", "Candy", and "Book matches" in respectively international class 9, 14, 16, 25, 26, 30 and 34. The record for this mark indicates that both first use of the mark in conjunction with all these goods and first use in commerce commenced as of April 1, 1982.

2. SIDETRACK (block letters)  
United States registration no. 3,168,520  
registered: November 7, 2006; filed: December 21, 2005

This mark is registered for use in connection with: "Conducting entertainment exhibitions in the nature of video performances; Entertainment in the nature of dance performances; Entertainment in the nature of fashion shows; Entertainment in the nature of visual and audio performances, and musical, variety, news and comedy shows; Entertainment namely, live performances by a musical band; Entertainment services namely live, televised and movie appearances by a professional entertainer; Entertainment services, namely, conducting contests; Entertainment services, namely, personal appearances by a celebrity; Entertainment services, namely, wine tastings; Entertainment, namely, live music concerts; Entertainment, namely live performances by musical bands; Organizing community sporting and cultural events; Planning arrangement of showing movies, shows, plays or musical performances; Providing facilities for movies, shows, plays, music or educational training", all in international class 41. The record for this mark indicates that both first use of the mark in conjunction with these goods and first use in commerce commenced as of April 1, 1982.

3. SIDETRACK (block letters)  
United States registration no. 3,168,518  
registered: November 7, 2006; filed: December 21, 2005

This mark is registered for use in connection with: "Providing community centers for social gatherings and meetings", in international class 43. The record for this mark indicates that both first use of the mark in conjunction with these goods and first use in commerce commenced as of April 1, 1982.

##### **B. Complainant**

The Complainant, starting in or around 1982, operates an establishment in Chicago called SIDETRACK

which provides bar and nightclub services, and which is directed to the gay community. This establishment has received a degree of local and national recognition as indicated in the articles provided in Annex 10 to the Complaint. The Complainant also provides a variety of SIDETRACK-branded goods and services ranging from clothing, including t-shirts, sweatshirts, jackets, and hats, to events such as wine tastings, food drives, fashion shows, and other special events.

The Complainant has spent over USD 2,500,000 on marketing and advertising in conjunction with branded goods and services offered under the mark. This advertising has included local, national, and international newspapers, magazines, and websites. Since February 1, 2000, one of the Complainant's websites is <sidetrackchicago.com>.

In particular, the Complainant has advertised in a magazine called "The Guide," since at least 1992. The Guide frequently features various cities and travel destinations of interest to the gay community (along those lines, a copy of one such article and a listing, from the Wayback Machine, of other travel articles from the magazine's website since as early as May 11, 2000 all appears in Annex 3 to the Complaint), among providing other substantive content. The Guide has circulation totals in the United States, Canada, Europe and Australia (among other areas) of between about 10,000-40,000+ print copies per month. Starting in 1990, at least 1,000 copies of the Guide were distributed monthly in Los Angeles, Palm Springs and San Francisco.

### **C. Respondent**

The Respondent purchased the disputed domain name in February 25, 2004 in a portfolio purchase of 10 domain names (including <begging.com>, <districts.com>, <does.com>, <latently.com>, <merits.com> and others) for a total price of USD 18,000. A copy of the transaction receipt for this purchase, made through Escrow.com, is provided in Exhibit B to the response.

The Respondent is using the term "sidetrack" generally in accordance with its commonly understood meaning in relation to travel, *i.e.*, a diversion or detour from a main course.

Since July 2004, the Respondent has used the name to resolve to its web site which provides travel advertising, including links to third-party sites associated with travel. Evidence provided by the Respondent included archived web pages covering a span of time, starting in July 2004, during which the Respondent has operated its website. This same basic use presently continues to this day.

## **5. Parties' Contentions**

### **A. Complainant**

#### **(i) Identical or Confusingly Similar**

The Complainant contends that the disputed domain name is identical to the Complainant's SIDETRACK Marks because the name, apart from the generic top level domain (gTLD) suffix, solely contains the term "sidetrack".

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

#### **(ii) Rights or Legitimate Interests**

The Complainant contends that, for various reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Respondent is not a licensee of the Complainant, nor has the Complainant given the Respondent

express or implied authorization or consent to use the Complainant's SIDETRACK Marks.

Second, the Respondent has not been commonly known by the name as an individual, a business or other organization.

Third, the Respondent is not using the name in connection with a *bona fide* offering of goods and services. Specifically, the name resolves to the Respondent's website which includes a plurality of travel links from which the Respondent presumably receives pay-per-click advertising revenue. The Complainant asserts that the Respondent established this site set to mislead and/or divert Internet users, who intend to reach the Complainant's website for its Chicago establishment, but instead diverted to the Respondent's site, and then financially exploit those users who reach the Respondent's website for the Respondent's own commercial gain. Further, this use does not constitute a legitimate noncommercial or fair use of the domain name.

### **(iii) Registered and Used in Bad Faith**

Lastly, the Complainant contends, also for various reasons, that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

First, the Respondent registered the name to prevent the Complaint from reflecting its mark in a corresponding domain name. Specifically, at or about November 2005, a representative of the Complainant's business Sidetrack contacted the Respondent concerning the disputed domain name. At that time, the Respondent's website, to which the disputed domain name then resolved, displayed a link which stated "Bar in Chicago Sidetrack". The Complainant's representative requested that the Respondent change the link to point to the Complainant's business. Shortly thereafter, the Respondent removed the link from its website. As indicated in the hard-copy printouts in Annex 6 to the Complaint, the Respondent's current web site contains links that relate to Chicago generally, traveling to Chicago, and bars and restaurants in Chicago. Hence, the Respondent had knowledge of the Complainant's business and registered the name to trade off the Complainant's goodwill and reputation.

Second, the Respondent has engaged in a long-standing pattern of illicit conduct. Specifically, the Respondent has registered 5,304 other domain names, some of which are confusingly similar variants of well-known trademarks, business and/or domain names, such as, for example, <autotrader.com>, <wather.com>, and <wetherchannel.com> with respect to <autotrader.com>, <weather.com> and <weatherchannel.com>. The Respondent, as is the case here, is using each of these and other confusingly similar domain names to trade off the reputation and goodwill of each corresponding trademark owner by misleading and/or diverting Internet users and then commercially exploiting those users by exposing them to pay-per-click links displayed on the Respondent's corresponding websites.

Third, the Respondent has utilized the disputed domain name in an attempt to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with the Complainant's mark SIDETRACK as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In particular, the Respondent is using the disputed domain name for "commercial gain" to divert Internet users, who are intent on reaching the Complainant's website, to his own website and then commercially benefit through doing so by exposing those users to pay-per-click advertising. Inasmuch as the Respondent's web site includes a variety of travel links -- none of which include the Complainant's bar in Chicago and some of which are modified based on search criteria, the Respondent is deceiving those users into believing that the Complainant and the Respondent's web sites are affiliated or related in some fashion - when in fact they are not. Hence, a user looking for the Complainant's establishment can enter "Sidetrack Bar Chicago" into a search box on the Respondent's web site and in response, is shown a list of links to various establishments; however, none of them is that of the Complainant. The Respondent has known of the Complainant's Chicago bar since at least November 2005.

Fourth, the Complainant's common law trademark rights, which commenced as of April 1982, predate the

September 1998 registration date of the disputed domain name. In spite of those rights, the Respondent continues to utilize the disputed domain name in conjunction with his web site.

## **B. Respondent**

### **(i) Identical or Confusingly Similar**

The Respondent contends that the Complainant did not have common law trademark rights at the time the Respondent acquired the disputed domain name sufficient to exclude the Respondent from using the name.

Specifically, at the time he acquired the disputed domain name, the Respondent was located in California. The Complainant claims no particular promotional or other activities conducted using its SIDETRACK mark in California apart from a listing of the name of its bar in a directory, of which the Complainant claims a few thousand copies were distributed in cities in California constituting populations of millions of people. The fact that the Complainant may have been listed in a thinly distributed directory does not constitute the provision or conduct of any goods or services using the mark in California, and further does not establish a common law mark in California.

### **(ii) Rights or Legitimate Interests**

The Respondent contends, contrary to the Complainant's assertions, that it has rights and legitimate interests in the disputed domain name.

Specifically, the Respondent's use of the name in conjunction with its advertising web site is a legitimate use and one which here began before the Respondent received any notice of the present dispute.

### **(iii) Registered and Used in Bad Faith**

The Respondent contends that he did not register or use the disputed domain name in bad faith.

Though the Respondent has accumulated domain names which may raise issues with respect to third-party mark owners, those issues are irrelevant here. Moreover, the Respondent had no prior knowledge of the Complainant's establishment Sidetrack in Chicago until the Complainant contacted him, which occurred several months after the Respondent acquired and began using the name in conjunction with his travel website.

Further, as discussed previously, the name was originally purchased at a price of USD 18,000 in a transaction involving multiple domain names, all of which including the disputed domain name, were simple, common dictionary terms. Where a complainant's mark is a common word with substantial third party use, as it is here, the complainant must proffer evidence that demonstrates that a respondent has specifically intended to confuse consumers seeking out the complainant. There is no such proof here. Moreover, it is particularly difficult when the asserted rights, as here in operating a bar, are so narrow that the Complainant's own claim does not preclude allowed claims by others in connection with related goods as beer and glassware (see TESS records of two allowed United States trademark applications for the term "sidetrack" provided in Exhibit C to the Response).

## **6. Discussion and Findings**

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

The Panel finds that the disputed domain name is identical to the Complainant's mark SIDETRACK.

From a simple comparison of the name to the Complainant's mark SIDETRACK, no doubt exists that the disputed domain name is identical to the Complainant's mark.

In particular, the name <sidetrack.com>, apart from its inclusion of the generic top level domain (gTLD) suffix “.com”, is otherwise identical to the mark. The addition of the gTLD suffix is generally irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored. See, e.g., *Kayak Software Corporation v. KAYAK.travel*, *KAYAK.travel Corporation*, *Kayak Las Vegas, LLC*, WIPO Case No. D2011-0425 and *Photo Tour Books, Inc. d/b/a PhotoSecrets v. Beate Chelette*, WIPO Case No. D2010-1373.

Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

The Panel will not assess issues of priority, specifically whether the Complainant's first use of its mark SIDETRACK, sufficed to accord it rights that would have legally precluded the Respondent's use, at the time, of the mark SIDETRACK, as part of the disputed domain name. Such issues often require significant fact-finding and thus are not appropriate for the rather summary nature of a UDRP proceeding. Nevertheless, all such issues are moot in view of the Panel's conclusions in the following two sections.

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

The Panel finds that the Respondent has rights and legitimate interests in the disputed domain name.

The Respondent acquired the disputed domain name in a bulk purchase on February 25, 2004 of ten domain names, all of which comprised ordinary dictionary words. Shortly thereafter and prior to the Complainant notifying the Respondent of any dispute over the domain name <sidetrack.com>, the Respondent began using the name in conjunction with his travel-related web site that provided a list of pay-per-click links to third-party websites for travel-based products and services.

Paragraph 4(c) of the Policy states:

Any of the following circumstances [ . . . ] shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii): [ . . . ]

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services;

While a complainant carries the overall burden of proof under paragraph 4(a)(ii) of the Policy, prior UDRP panels have recognized that this could result in an often impossible, or certainly rather difficult, task of proving a negative, particularly since doing so requires information that is often primarily within the knowledge and/or control of a respondent. Therefore, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, a complainant is generally deemed to have satisfied paragraph 4(a)(ii). Here, however, the Respondent has done so. See, generally section 2.1 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”) and specifically, as cited therein, e.g., *Accor v. Eren Atesmen*, WIPO Case No. D2009-0701; *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. D2008-1393; *Banco Itau S.A. v. Laercio Teixeira*, WIPO Case No. D2007-0912; *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. D2004-0110; and *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455.

Under the facts of record, the Panel views the Respondent's use of its domain name in connection with its site of pay-per-click travel advertisements as *bona fide*, particularly here given that the Respondent is using the term “sidetrack” generally in accordance with its commonly-understood meaning in relation to travel, i.e. a diversion or detour from a main course, and the Panel on balance accepts that the Respondent had no prior knowledge of the Complainant and its activities until more than a year after the Respondent commenced use of the disputed domain name.

Hence, the Panel finds that the Complainant has failed to meet its burden under paragraph 4(a)(ii) of the Policy.

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

The Panel also finds that the Respondent did not register and has not used the disputed domain name in bad faith.

From the press articles exhibited to the Complaint it appears that the Complainant has indeed operated a bar/nightclub in Chicago since 1982. One of the articles in question celebrates the 25<sup>th</sup> anniversary of the establishment in 2007.

However, there is nothing before the Panel to indicate fame or notoriety outside the Chicago bar scene. Specifically, there is nothing to show why the Respondent in California should have been aware of the Respondent's establishment in Chicago in February 2004 when the Respondent acquired the disputed domain name. There is nothing to show that the Respondent is in any way associated with the bar scene in Chicago, particularly gay bars, and might therefore have been aware of it. There is nothing about the Respondent's use of the disputed domain name to suggest any knowledge of it. The Complainant purports to produce such evidence, but the Panel finds it does not adequately support the allegations of bad faith use.

The Complainant's contention that the Respondent acquired the disputed domain name with a view to taking advantage of the Complainant's claimed reputation and goodwill in respect of the Complainant's trade mark is undermined by the evidence of the Respondent as to the circumstances under which the disputed domain name was acquired. The documents produced by the Respondent make it abundantly clear that the disputed domain name was acquired as part of a job lot of 10 domain names, all of which were ordinary dictionary words. The disputed domain name has been used consistently to derive pay-per-click revenue from travel-related advertising links, not links focusing on bars and nightclubs.

At one point in the Complaint, the Complainant appears to accept the possibility that the disputed domain name may not have been registered in bad faith, but contends that the subsequent bad faith use is sufficient to get the Complainant home under paragraph 4(b)(iv) of the Policy. As already indicated, there is no credible evidence of bad faith use, but even if there had been, for the preponderance of UDRP panels, proof of bad faith registration of a domain name is a crucial requirement. The position has most recently been explained in *Poundland Limited v. Dealz.com*, WIPO Case No. D2012-0918 in the following terms:

"The Panel finds the key issue in the present case is whether the Disputed Domain Name was registered and used in bad faith under paragraph 4(a)(iii) of the Policy. Therefore, the Panel prefers to move directly to addressing that third element of the Policy.

In *Mile, Inc. v. Michael Burg*, WIPO Case No. D2010-2011 ("Mile") the Panel stated that 'the consensus view since the Policy was implemented in 1999 has been that the conjunctive 'and' indicates that there must be bad faith both at the time of registration and subsequently'.

This view has been challenged in some recent decisions, which treated "registration" and "use" as a unified concept (see e.g. *City View Limited v. Moniker Privacy Services / Xander, Jeduyu, ALGEBRALIVE*, WIPO Case No. D2009-0643 ("*Mummygold*") and *Octogen Pharmacal Company, Inc. v. Domains By Proxy, Inc. / Rich Sanders and Octogen e-Solutions*, WIPO Case No. D2009-0786 ("*Octogen*").

The panel in *Mile* addressed the *Mummygold* and *Octogen* approach as follows:

'If a consensus developed that a line of prior decisions had reached the wrong result, and if panels generally adopted a new approach on an issue, this Panel also would be open to considering whether a new approach was appropriate, both substantively under the Policy and in order to promote consistency. However, the *Mummygold/Octogen* reasoning has not prompted any such consensus; to the contrary, a number of decisions have expressly considered and rejected it. See, e.g., *Validas*, supra; *Eastman Sporto*, supra; *Torus*

*Insurance Holdings Limited v. Torus Computer Resources*, WIPO Case No. D2009-1455; *Camon S.p.A. v. Intelli-Pet, LLC*, WIPO Case No. D2009-1716; *Tata Communications International Pte Ltd (f/k/a VSNL International Pte Ltd) v. Portmedia Inc. / TRUERROOTS.COM c/o Nameview Inc. Whois*, WIPO Case No. D2010-0217 (majority opinion); *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. D2010-0470; *A. Nattermann & Cie. GmbH and Sanofi-aventis v. Watson Pharmaceuticals, Inc.*, WIPO Case No. D2010-0800 (majority opinion). The fact that so many panelists have declined to follow the *Mummygold/Octogen* approach argues against an emerging consensus to overturn a long-established doctrine and provides yet another reason for this Panel to decline to adopt the *Mummygold/Octogen* reasoning.’

The Panel endorses the above passage. See also *Xbridge Limited v. Marchex Sales, Inc*, WIPO Case No. D2010-2069 for additional discussion on these issues. Construction of “registration” as a continuous process would negate the distinction between “registration” and “use” within the Policy. The objective of the Policy was to combat the undue and abusive registration of domain names in “cybersquatting” cases.”

The Respondent denies that at date of acquisition of the disputed domain name he had prior knowledge of the Complainant and its Chicago establishment. There is nothing before the Panel to suggest that that denial should be disbelieved. On the contrary, the evidence of the Respondent supports the Respondent’s claim that he acquired the disputed domain name for the purpose for which he has consistently used it, namely to derive revenue from travel-related advertising links.

The Complainant makes other allegations of bad faith (e.g. one based on paragraph 4(b)(iii) of the Policy), but they all founder in the face of the Respondent’s evidence.

Hence, the Panel finds that the Complainant has also failed to meet its burden under paragraph 4(a)(iii) of the Policy.

## **7. Decision**

Accordingly, the Panel denies the relief sought by the Complainant.

**Peter L. Michaelson**  
Presiding Panelist

**Karen Fong**  
Panelist

**Tony Willoughby**  
Panelist  
Dated: July 2, 2012