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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91219067
Party	Defendant Jersey Boardwalk Franchising Co., Inc.
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**THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration No. 4,056,183 issued on November 15, 2011

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NEW JERSEY TURNPIKE  
AUTHORITY,

Petitioner,

v.

BOARDWALK PIZZA, INC.,

Respondent.

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Cancellation No. 92059657

**RESPONDENT/REGISTRANT'S ANSWER AND AFFIRMATIVE  
DEFENSES TO SECOND AMENDED PETITION FOR CANCELLATION AND  
AMENDED COUNTERCLAIM FOR CANCELLATION AND OTHER  
DECLARATORY RELIEF**

Respondent/Registrant Boardwalk Pizza, Inc., (hereinafter "Respondent/Registrant") by and through its counsel, Marks & Klein, LLP, 63 Riverside Avenue, Red Bank, New Jersey 07701, by way Answer and Affirmative Defenses to Petitioner New Jersey Turnpike Authority's ("Petitioner" or "NJTA") Second Amended Petition for Cancellation ("Petition") states, as follows:

Respondent/Registrant admits that it registered the mark, Registration No. 4,056,183 issued on November 15, 2011 ("Registrant's Mark") that is the subject of this action, and that Respondent/Registrant is a Florida corporation with a principal address of 20 High Point Road, Tavernier, Florida 033070. All of the

remaining unnumbered allegations contained in the preface of the Second Amended Petition for Cancellation are denied.

1. Respondent/Registrant has insufficient knowledge or information to form a belief as to the truth of the allegations contained in paragraph 1 of the Petition, and leaves Petitioner to its proofs.

2. Respondent/Registrant has insufficient knowledge or information to form a belief as to the truth of the allegations contained in paragraph 2 of the Petition, and leaves Petitioner to its proofs. Respondent/Registrant specifically denies that the Garden State Parkway is one of the most iconic and well-known highways in the United States.

3. Respondent/Registrant has insufficient knowledge or information to form a belief as to the truth of the allegations contained in paragraph 3 of the Petition, and leaves Petitioner to its proofs; except to deny that Petitioner has a registered mark depicting the green and yellow colored logo/design that is depicted in paragraphs 1 and 3 of the Petition. See Second Amended Petition, **Tab A**, Registration No. 2,452,349 depicting a black-and-white version of the logo depicted in the body of the Petition.

4. Respondent/Registrant denies all of the allegations contained in paragraph 4 of the Petition. Specifically, the USPTO's records reflect that Petitioner does not own any federal trademark registrations for the Garden State

Parkway sign logo in connection with any good or service other than the aforementioned highway maintenance and management services and travel information services, nor has Petitioner used the Garden State Parkway sign logo in commerce in connection with any other good or service. Respondent/Registrant denies that Petitioner offers any of the same goods and/or services as Respondent/Registrant including but not limited to restaurant service and/or pizza and related cuisine. Respondent/Registrant has insufficient knowledge or information to form a belief as to the truth of the remaining allegations contained in paragraph 4 of the Petition, and leaves Petitioner to its proofs.

5. Respondent/Registrant denies that the Garden State Parkway Logo mark has achieved the status of being a famous mark. Respondent/Registrant has insufficient knowledge or information to form a belief as to the truth of the remainder of the allegations contained in paragraph 5 of the Petition, and leaves Petitioner to its proofs.

6. Respondent/Registrant has insufficient knowledge or information to form a belief as to the truth of the allegations contained in paragraph 6 of the Petition, and leaves Petitioner to its proofs; except that Respondent/Registrant denies that Petition has actively and successfully “policed” the infringing third-party uses of its mark.

7. Respondent/Registrant admits that on November 15, 2011, nearly three years prior to the filing of the Petition, it obtained the subject registration for the mark depicted in paragraph 7 of the Petition in International Class 43 for restaurants. Respondent/Registrant denies all of the remaining allegations contained in paragraph 7

of the Petition. Respondent/Registrant is in the restaurant service business in the State of Florida and is engaged in the sale of Italian cuisine, only. Petitioner is a New Jersey State agency that allegedly owns the registered marks associated with the Garden State Parkway logo and design in connection with highway management and maintenance services and travel information services. Respondent/Registrant denies that Petitioner's registered mark is famous and further denies that there is any goodwill associated with it. Respondent/Registrant denies the accuracy of the side by side comparison of the "Petitioner's Mark" and the "Registrant's Mark", as Petitioner's registered mark is in black and white and does not claim color as a feature of the mark.

8. Respondent/Registrant denies all of the allegations contained in paragraph 8 of the Petition.

#### **COUNT I - Likelihood of Confusion**

9. Respondent/Registrant denies all of the allegations contained in paragraph 9 of the Petition. Specifically, there is no likelihood that a reasonable consumer can mistake the goods and services being offered by Respondent/Registrant, namely restaurant services, as being promoted, sold or originated by or from Petitioner, a provider of highway management and maintenance services and travel information services. Respondent/Registrant denies that Petitioner provides any goods or services to the consuming public under the Petitioner's registered mark.

10. Respondent/Registrant denies all of the allegations contained in paragraph 10 of the Petition for Cancellation. Petitioner and Respondent/Registrant's registered marks are not confusingly similar, as they contain obvious and distinct differences, and are used in vastly different categories of services.

11. Respondent/Registrant denies all of the allegations contained in paragraph 11 of the Second Amended Petition for Cancellation.

12. Respondent/Registrant denies the allegations contained in paragraph 12 of the Second Amended Petition for Cancellation.

13. Respondent/Registrant denies the allegations contained in paragraph 13 of the Petition for Cancellation. Specifically, the alleged fact that there are many "service areas", a term not defined in the Petition "along the Garden State Parkway" in the State of New Jersey that include restaurants, or pizza restaurants (all of which are privately owned), in no way renders the Respondent/Registrant's mark confusingly similar or otherwise misleading to the consumer public in the State of Florida. Petitioner's registration is limited to highway management and maintenance services and travel information services, not restaurant services.

14. Respondent/Registrant denies the allegations contained in paragraph 14 of the Petition.

**WHEREFORE** Respondent/Registrant prays that the Second Amended Petition for Cancellation be dismissed, with prejudice.

## **COUNT II - Abandonment**

15. Respondent/Registrant admits, denies and/or has insufficient knowledge or information to form a belief as to the truth of the allegations contained in paragraphs 1-14, as identified above.

16. Respondent/Registrant denies all of the allegations contained in paragraph 16 of the Petition except admits that registrant is not currently providing restaurant services or actively conducting business providing restaurant services, but remains in existence.

17. Respondent/Registrant admits that the name of the restaurant has changed and that a new logo has been adopted along with the previous logo.

18. Respondent/Registrant denies all of the allegations contained in paragraph 18 of the Petition.

19. Respondent/Registrant denies all of the allegations contained in paragraph 19 of the Petition.

20. Respondent/Registrant denies all of the allegations contained in paragraph 20 of the Petition.

21. Respondent/Registrant denies all of the allegations contained in paragraph 21 of the Petition.

22. Respondent/Registrant denies all of the allegations contained in paragraph 22 of the Petition.

23. Respondent/Registrant denies all of the allegations contained in paragraph 23 of the Petition.

24. Respondent/Registrant denies all of the allegations contained in paragraph 24 of the Petition.

25. Respondent/Registrant denies all of the allegations contained in paragraph 25 of the Petition.

26. Respondent/Registrant denies all of the allegations contained in paragraph 26 of the Petition.

**WHEREFORE** Respondent/Registrant prays that the Second Amended Petition for Cancellation be dismissed, with prejudice.

**SEPARATE AND AFFIRMATIVE DEFENSES**

1. The Trademark Trial and Appeal Board ("TTAB") registered Respondent/Registrant's Mark, Registration No. 4,056,183 that is the question of the Petition for Cancellation, on November 15, 2011.

2. Upon registration of the Boardwalk Pizza Mark, the USPTO took no office action adverse to Respondent/Registrant upon the original registration of the Mark.



3. Petitioner has not, and will not, be damaged commercially or otherwise by the registration or use of Respondent/Registrant's Boardwalk Pizza Mark.

4. The relief sought by Petitioner is barred based upon Petitioner's use of naked licensing in connection with its Mark. Petitioner has, upon information and belief, engaged in the licensing and use of its mark to various third-party individuals and/or businesses for commercial use. Upon further information and belief, such licensing agreements contained virtually no quality control standards such as standards on advertising, operations, and/or the sale of merchandise.

5. Petitioner has failed to state a claim upon which relief can be granted pursuant to Fed. R. Civ. P. 12(b)(6), as applied to these proceedings.

6. Pursuant to 15 U.S.C. § 1069, Petitioner is barred from seeking the relief of cancellation of the Respondent/Registrant's challenged mark by the equitable doctrine of waiver.

7. Petitioner is barred from seeking the relief of cancellation of the Respondent/Registrant's challenged mark by the equitable doctrines of laches, as Petitioner unreasonably delayed in filing of any Petition for Cancellation for two years and eight months after the registration of the subject mark.

8. Petitioner is barred from seeking the relief of cancellation of the Respondent/Registrant's challenged mark by the doctrine of equitable estoppel.

9. Petitioner is barred from seeking the relief of cancellation of the Respondent/Registrant's challenged mark by the doctrine of unclean hands.

10. The relief sought by Petitioner is also barred by the equitable doctrine of acquiescence pursuant to the decision in *Morehouse Mfg. Corp. v. Strickland & Co.*, 407 F.2d 881 (C.C.P.A. 1969) as applied to these TTAB proceedings.

11. Petitioner has abandoned its Mark by failing to enforce its alleged trademark rights against numerous other businesses and entities that have and continue to use marks and logos that are substantially similar to Petitioner's Mark, and that have been used in the State of New Jersey.

### **COUNTERCLAIM**

Registrant/Counterclaimant Boardwalk Pizza, Inc., seeks relief by way of Counterclaim against Petitioner/Counterclaim Respondent New Jersey Turnpike Authority, Inc. ("NJTA") as follows:

### **THE PARTIES**

1. NJTA is a New Jersey agency organized under the laws of the State of New Jersey with a principal place of business located at 58 Main Street, Woodbridge, New Jersey, that purportedly owns the United States Service Mark Registration No. 2,452,349 for the Garden State Parkway Logo ("GSP Mark"). See NJTA Petition for Cancellation, 2-3; Tab A.

2. Boardwalk Pizza, Inc. (hereinafter “Boardwalk Pizza”) is a Florida corporation that owned and operated a pizza restaurant in Tavernier, Florida (the “Florida Restaurant”).

3. In July 2014, NJTA brought the instant action seeking to cancel the registration of the registered service mark, Registration No. 4,056,183, which was issued on November 15, 2011 to Boardwalk Pizza (“Boardwalk Pizza Mark”).

4. The Boardwalk Pizza Mark was subsequently assigned to Boardwalk Franchising Co., Inc.

5. In or around April, 2014, Boardwalk Pizza began using the tradename “Jersey Boardwalk Co.” to identify the Florida Restaurant.

6. In support of its Second Amended Petition, the NJTA alleges that the Boardwalk Pizza Mark is deceptively similar to NJTA’s mark and is likely to cause consumer confusion regarding the origin of the services that Boardwalk Pizza or any of its affiliates renders and that the NJTA has been damaged by the registration of the Boardwalk Pizza Mark.

7. As set forth in its Answer to Petition and Affirmative Defenses, Boardwalk Pizza categorically denies any purposeful copying or trading-off of NJTA’s GSP Mark and further denies that the Boardwalk Pizza Mark is confusingly similar to that owned by the NJTA, or that the NJTA has sustained damages.

## NATURE OF RELIEF SOUGHT

8. NJTA's Petition for Cancellation seeks protection for its mark/logo depicting the highway/road sign for the Garden State Parkway.

9. As set forth herein, NJTA's GSP Mark is a traffic symbol in the public domain and the NJTA, as the purported owner of the Mark cannot avail itself of the protections afforded by the TTAB and sought in its Petition for Cancellation.

10. Boardwalk Pizza now seeks, by way of this Amended Counterclaim, an Order determining that: (i) the relief sought by NJTA is untenable and NJTA has no legal basis to seek cancellation of the Boardwalk Pizza Mark; and (ii) NJTA's GSP Mark should be cancelled as it exists in the public domain and, according to federal regulation of traffic control device design, should not continue to qualify for trademark protection

11. Boardwalk Pizza is entitled to costs and fees in connection with the defense of the instant action and the prosecution of this Counterclaim.

12. The relief sought herein is timely as marks in the public domain or generic marks lack protection and are subject to cancellation at any time, even if it is incontestable. See 15 U.S.C. 1064(3).

## **BACKGROUND FACTS**

### **A. Boardwalk Pizza's Florida Business Operations**

13. Boardwalk Pizza opened the Florida Restaurant in an effort to bring the experience of enjoying delicious, New Jersey-style pizza to southern Florida.

14. The Florida Restaurant adopted and used the following logo (the "Boardwalk Pizza Logo") when it opened in 2005:



15. Boardwalk Pizza applied for, and obtained, a federal registration for the Boardwalk Pizza Logo on the Principal Register of the United States Patent and Trademark Office ("USPTO") approximately five years ago in November of 2011.

16. Notably, the then-existing database included the NJTA's registration for the Garden State Parkway sign logo at Registration No. 2,452,349 in connection with highway management and maintenance services and travel information services (the "GSP Registration").

17. The mark that is the subject of the GSP Registration appears below:



18. The mark that is the subject of the GSP registration is in black and white,

rather than in green and yellow. Accordingly, the distinctive nature of the mark does not extend to the design element, which again, does not even claim color as a feature of the mark.

**B. The NJTA's Purpose and Limitations**

19. The NJTA is a state agency established in the State Department of Transportation pursuant to the New Jersey Turnpike Authority Act (the "Turnpike Act"). *N.J.S.A. §27:23-5*.

20. The NJTA was created to facilitate vehicular traffic and remove the handicaps and hazards (including potholes) on the congested highways in the state of New Jersey, and to provide for the acquisition and construction of modern express highways embodying every known safety device.

21. In 2003, the NJTA and the New Jersey Highway Authority ("NJHA") were consolidated into one entity by statute, *N.J.S.A. §27:23-1 et seq.* leaving the NJTA as the successor in interest to the NJHA.

22. The statutory function of the NJTA is limited to only those powers expressly conferred on it by the Turnpike Act, none of which include the power to operate or license to others the right to operate pizzerias identified by the Garden State Parkway guide sign.

23. The Turnpike Act only authorizes and empowers the NJTA to acquire, construct, maintain, improve, manage, repair and operate transportation projects.

*N.J.S.A. §27:23-2.*

24. The Turnpike Act further imposes strict limitations on the NJTA and expressly provides that the authority shall not “engage in the acquisition, construction or operation of any facility or any activity not directly or indirectly related to the use of a transportation project.” *N.J.S.A. § 27:23-5.9.*

25. Furthermore, the Turnpike Act prohibits use of toll revenues derived from the Garden State Parkway for projects other than highway projects, except in the limited circumstances to finance or support transportation projects that are not highway projects on an interim basis. *N.J.S.A. § 27:23-5.9(g).*

26. The Turnpike Act does not authorize the NJTA to acquire, hold, or dispose of intellectual property<sup>1</sup>, nor does it authorize the NJTA to engage in general commercial business practices involving the use and/or license of trademarks or their intellectual property.

27. Thus, the NJTA is not currently engaged in any way in the rendering of restaurant services or the sale of pizza or other Italian cuisine. Further, the NJTA is expressly precluded by statute from engaging in any such business, and, by extension to use its marks for any such commercial purpose.

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<sup>1</sup> The Turnpike Act only authorizes the NJTA to “acquire, hold and dispose of real and personal property in the exercise of its powers and the performance of its duties under the Turnpike Act.”

**C. Garden State Parkway Guide Sign**

28. The Garden State Parkway (GSP), a New Jersey State highway, was constructed in the 1950's and was maintained by the NJHA until 2003 when the NJHA and the NJTA were consolidated by statute.

29. The GSP guide sign was created and placed in the public domain to identify the toll-road and to guide motorists to the highway in 1956.

30. Such guide signs were originally posted without any copyright or trademark notice, as the notion that the design of the highway guide sign was somehow subject to intellectual property rights was neither intended nor contemplated by anyone, including the NJHA.

31. In fact, as set forth herein the GSP guide sign is a traffic control device that, by law, shall not be protected by patent, trademark or copyright.

32. After existing in the public domain for over forty-three (43) years, in 1999 the NJHA for the first time submitted a trademark registration application to register the parkway sign in black and white format, only, on the Principal Register of the USPTO for highway management and maintenance services (Class 37) and travel information services (Class 39).

33. The USPTO issued an Office Action objecting to registration of the mark, and ultimately a Final Refusal due to the descriptive nature of the mark.



34. The NJHA thereafter filed a petition to revive the application claiming the “mark” had acquired distinctiveness.

35. While the question of whether the NJHA ever “used the mark in commerce”, which is an essential pre-requisite to obtaining a federal registration, is doubtful, the USPTO issued a registration based, in part, on “acquired distinctiveness” pursuant to 2(f).

36. The USPTO’s registration expressly limits the mark’s distinctiveness element to the word component of the mark: “GARDEN STATE PARKWAY”.

37. Accordingly, the distinctive nature of the mark does not extend to the design element, which again, does not even claim color as a feature of the mark.

**D. NJTA and its Predecessor's Failure to Enforce Rights as Owners of Mark**

38. NJTA has been lax in the enforcement of its Mark and has permitted and/or failed to police numerous third-parties that continue to appropriate and use its mark and/or variations thereof.

39. For years, numerous individuals and businesses throughout the state of New Jersey have used exact replicas of the Garden State Parkway sign logo, or slightly modified versions thereof, in connection with the offer and sale of various goods and services to the general consuming public in New Jersey. NJTA has, to date, taken no action with respect to certain of these third-parties.

40. Indeed, the NJTA asserts it has actively and successfully policed against

third-party uses of the mark. A diligent search of public records does not yield such a conclusion.

41. Further, on July 17, 2013, the NJTA attempted, and failed, to enforce exclusive rights to its word mark against a third-party in the National Arbitration Forum (NAF) as to the domain name "gardenstateparkway.com". See Ex. A, NAF Decision in *New Jersey Turnpike Authority v. On-Site et al.*

**E. Public Domain Status of NJTA's Mark Precludes Any Right of Enforcement and Requires Cancellation**

42. The NJTA has brought this action to protect a Mark that is not legally protectable and constitutes a traffic control device in the public domain.

43. Federal law provides for a uniform system of traffic control devices.

44. In 1971, the United States Department of Transportation, Federal Highway Administration issued regulations designed to bring uniformity to the roadways of the United States pursuant to the Highway Safety Act of 1966.

45. These regulations are set forth in the federal Manual on Uniform Traffic Control Devices ("MUTCD").

46. The MUTCD is promulgated by the Department of Transportation and sets "the national standard for all traffic control devices installed on any street, highway, or bicycle trail open to public travel".

47. In order to remain eligible for federal highway and highway safety program funds, a state, must adopt the federal MUTCD as a state regulation, adopt a

state MUTCD that is approved by the Secretary of Transportation as being in “substantial conformance” with the federal MUTCD, or adopt the federal MUTCD in conjunction with a state supplement. *See* 23 USC §109(d), 23 USC §402(c); 23 CFR 655.603(b)(3).

48. Consistent with the aforesaid federal provisions, the State of New Jersey has adopted the MUTCD. *§1627-3.1.*

49. The MUTCD, as adopted by the state of New Jersey, suggests a default design for state highway route markers, but permits states the option to create a unique design, and New Jersey has chosen to maintain the GSP design.

50. As set forth herein, the GSP sign is a highway route marker, or guide sign and falls within the definition of a “traffic control device” under the MUTCD and New Jersey law.

51. According to the State of New Jersey's statutory regulations, a “traffic control device” is defined as:

a sign, signal, flashing beacon, marking, or other device used to regulate, warn, or guide traffic, placed on, over, or adjacent to a street, highway, pedestrian facility, or shared-use path by authority of a public agency having jurisdiction.

*See New Jersey Administrative Code (N.J.A.C.) §16:27 -2.1.*

52. *N.J.S.A.* §16:27-3.1 provides that “[t]he basic principles concerning the design and usage of traffic control devices are governed by the MUTCD.”

53. The MUTCD, as adopted by the state of New Jersey, provides that such

designs are in the public domain:

Any traffic control device design or application provision contained in this Manual shall be considered to be in the public domain. Traffic control devices contained in this Manual **shall not be protected by a patent, trademark, or copyright**, except for the Interstate Shield and any items owned by [the Federal Highway Safety Administration]. (Emphasis Added.)

54. Even in light of the USPTO's prior registration of the GSP Mark, the State of New Jersey's wholesale adoption and codification by reference of the MUTCD establishes that the subject design is in the public domain and is not legally protectable.

55. Continued registration of the GSP Mark by the NJTA constitutes an improper effort to gain exclusive rights to, obtain a monopoly privilege in a descriptive mark, specifically the GSP logo, a highway sign road marker/traffic control device design that exists solely in the public domain.

56. Continued registration of the GSP mark is also a source of injury to Counterclaimant Boardwalk Pizza and to numerous third parties who currently use, and are entitled to continue to use, marks that may be similar in design and style to the GSP logo, and it confers upon NJTA the improper presumption(s) that it enjoys the exclusive right to use the subject traffic control design, when no such exclusive rights actually exist.

**WHEREFORE**, Registrant/Counterclaimant respectfully requests the following relief:

- (a) a determination that the relief sought by NJTA is untenable and that the NJTA has no legal basis to seek cancellation of the Boardwalk Pizza Mark;
- (b) the GSP Mark should be cancelled as it exists in the public domain and, according to federal regulation of traffic control devices, should not continue to qualify for trademark protection; and
- (c) Boardwalk Pizza is entitled to costs and fees in connection with the defense of the instant action and the prosecution of this Counterclaim.

Respectfully submitted,

Dated: April 27, 2016

**MARKS & KLEIN, LLP**

/s/ Justin M. Klein

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JoyAnn Kenny, Esq.  
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**CERTIFICATE OF SERVICE**

I hereby certify that on April 27, 2016, I filed the within Answer and Affirmative Defenses to Petitioner’s Petition for Second Amended Cancellation and Amended Counterclaim via the USPTO’s electronic filing system. I have also served a copy of the Answer and Affirmative Defenses to Petitioner’s Petition for Second Amended Cancellation and Amended Counterclaim to Counsel for Petitioner, Ronald Israel, Esq., Chiesa, Shahinian & Giantomasi PC, via electronic mail and first class mail at the following address:

Ronald Israel, Esq.  
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By:       /s/Justin M. Klein        
Justin M. Klein, Esq.

# **EXHIBIT A**



## NATIONAL ARBITRATION FORUM

### DECISION

New Jersey Turnpike Authority v. On-Site (GARDENSTATEPARKWAY-DOM) and On-Site (NJTURNPIKE3-DOM)

Claim Number: FA1305001502281

### PARTIES

Complainant is New Jersey Turnpike Authority ("Complainant"), represented by Peter E. Nussbaum of Wolff & Samson PC, New Jersey, USA. Respondent is On-Site (GARDENSTATEPARKWAY-DOM) and On-Site (NJTURNPIKE3-DOM) ("Respondent"), New Jersey, USA.

### REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <gardenstateparkway.com> and <njturnpike.com>, registered with Melbourne IT, Ltd. d/b/a Internet Names Worldwide.

### 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.

Jonas Gulliksson as Panelist.

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on May 29, 2013; the National Arbitration Forum received payment on May 29, 2013.

On May 30, 2013, Melbourne IT, Ltd. d/b/a Internet Names Worldwide confirmed by e-mail to the National Arbitration Forum that the <gardenstateparkway.com> and <njturnpike.com> domain names are registered with Melbourne IT, Ltd. d/b/a Internet Names Worldwide and that Respondent is the current registrant of the names. Melbourne IT, Ltd. d/b/a Internet Names Worldwide has verified that Respondent is bound by the Melbourne IT, Ltd. d/b/a Internet Names Worldwide registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").



On May 30, 2013, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of June 19, 2013 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@gardenstateparkway.com, postmaster@njturnpike.com. Also on May 30, 2013, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on June 18, 2013.

Complainant submitted an Additional Submission, which was determined to be compliant on June 21, 2013.

Respondent submitted an Additional Submission in the form of an e-mail to the Forum, which was determined to be compliant on June 25, 2013.

On July 3, 2013, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Jonas Gulliksson 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" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

## RELIEF SOUGHT

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

## PRELIMINARY ISSUE: Multiple Respondents

In the instant proceedings, Complainant has alleged that the entities which control the domain names at issue are effectively controlled by the same person and/or entity, which is operating under several aliases.

Paragraph 3(c) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") provides that a "complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder."

Complainant contends that Respondents On-Site (GARDENSTATEPARKWAY-DOM)

and On-Site (NJTURNPIKE3-DOM) are one in the same and under the control of the same entity, because the WHOIS information for each of the domain names lists the same address at 104 Embury Avenue, Ocean Grove, New Jersey 07756. Complainant further alleges that both domain names identify the same Administrative and Technical Contact, "David P Matteo," at 108 South Main Street, Ocean Grove, New Jersey, as well as the same phone number, fax number, and e-mail address. Complainant also argues that both disputed domain names resolve to the same website.

Respondent has submitted a Response and an Additional Submission in which the Respondent refers to the registrations and use of the disputed domain names jointly and as controlled by Mr. David P. Matteo.

In the light of the above, the Panel finds that Complainant has presented sufficient evidence that the disputed domain names are controlled by the same entity.

Thus, the Panel will proceed with the instant proceedings.

## PARTIES' CONTENTIONS

### A. Complainant

Complainant owns the GARDEN STATE PARKWAY and NEW JERSEY TURNPIKE marks, both of which it has used in connection with its highway management and maintenance services, toll collection services, and travel information services for over five decades, as well as on its merchandise and other goods. Complainant owns trademark registrations with the United States Patent and Trademark Office ("USPTO") for its GARDEN STATE PARKWAY mark and design (e.g., Reg. No. 2,452,349 filed October 22, 1998, registered May 22, 2001) and its NEW JERSEY TURNPIKE mark (e.g., Reg. No. 4,160,283 filed July 26, 2011, registered June 19, 2012). The marks relate to two of the most "iconic and well-known highways in the United States," which are travelled by millions of people each year and are currently symbolic fixtures within the United States. The New Jersey Turnpike opened in 1951 and stretches for over 148 miles through New Jersey, connecting motorists between New York and Pennsylvania. The Garden State Parkway opened in 1954 and runs from New York State to the end of the New Jersey shore. Complainant has made significant time and money contributions in order to advertise and promote its marks, which currently have wide consumer recognition and goodwill.

Respondent registered the <gardenstateparkway.com> and <njturnpike.com> domain names on July 31, 1998, several decades following Complainant's first use of the marks. The <gardenstateparkway.com> domain name is identical to Complainant's GARDEN STATE PARKWAY mark, and the <njturnpike.com> domain name is confusingly similar to Complainant's NEW JERSEY TURNPIKE mark. Respondent previously linked the domain names to a website that provided advertisements and information regarding the

town of Ocean Grove, New Jersey. After Complainant learned of Respondent's domain names, it demanded Respondent cease and desist its activity as to the domain names, at which time Respondent rerouted his domain names to a website at the <fnjtolls.com> domain name, which features a "middle finger" logo containing advertisement and negative content on the topic of paying New Jersey highway tolls. Respondent also sells merchandise, including clothing, bearing the <fnjtolls.com> name and logo.

Respondent does not have any rights or legitimate interests in the <gardenstateparkway.com> and <njturnpike.com> domain names, as his use of the domain names improperly suggests affiliation with Complainant, and Respondent does not use the domain names for a legitimate business purpose. Respondent has never been commonly known by the disputed domain names, and his use of the domain names tarnishes the marks' reputations and good will. Respondent has not in the past, nor does it presently, make any legitimate noncommercial use of the <gardenstateparkway.com> and <njturnpike.com> domain names, and his current use of the domain names to criticize Complainant can only be seen as a direct response to Complainant's cease and desist letter.

Respondent registered and uses the <gardenstateparkway.com> and <njturnpike.com> domain names in bad faith, as the roadways to which the domain names refer are well-known and "intrinsically tied to the fabric of the State of New Jersey," which makes it unlikely that Respondent, who himself resides in New Jersey, would be unaware of Complainant's marks. Respondent's initial use of the domain names to feature advertisements and information about Ocean Grove, New Jersey was in bad faith, as the website promoted Respondent's commercial interests; and Respondent's current use of the domain names to redirect to a website containing negative content about Complainant is also in bad faith. Respondent attempts to confuse Internet users by diverting them from Complainant's website to Respondent's own site and causing a mistaken belief that Respondent is somehow affiliated with Complainant.

## B. Respondent

Respondent purchased the <gardenstateparkway.com> and <njturnpike.com> domain names on July 31, 1998 after researching the trademarks, neither of which had a trademark registration associated with them at the time. Complainant's attorney filed trademark petitions for items such as mugs, beach towels, cardboard items, and paper goods thirteen years after Respondent initially registered the disputed domain names. Owning rights to novelty items does not give Complainant trademark rights to the name of a geographical roadway. Respondent, on the other hand, used the disputed domain names for informational websites since at least November of 2004.

Government-owned geographical landmarks, roadways, offices, and educational resources all have domain name extensions that can be used in order to reach them on

the Internet—in the case of the New Jersey Turnpike Authority, that domain name is <state.nj.us/turnpike>. Respondent insists he will continue to use the <gardenstateparkway.com> and <njturnpike.com> domain names as informational websites, and although he has received several offers to sell the domain names, he has no interest in or motivation to sell them.

Respondent has never intended to harm Complainant, but insists that the statute of limitations applies to Complainant's attempt to claim the <gardenstateparkway.com> and <njturnpike.com> domain names, because the passage of fifteen years in which Respondent has owned the domain names is evidence that they belong rightfully to Respondent.

### C. Additional Submissions

#### 1. Complainant makes the following claims in its Additional Submission:

Complainant reiterates its argument that it owns undeniable rights in the GARDEN STATE PARKWAY and NEW JERSEY TURNPIKE marks, which function as famous, source-identifying marks and have been used since the 1950s in connection with highway management and maintenance services, toll collection services, and travel information services. Respondent attempts to convince the Panel that Complainant filed for its trademark mark registrations at the time it learned of the domain names in dispute, which is untrue. Respondent fails to recognize that Complainant owns several trademark registrations covering both claimed marks, and further, Complainant's common law rights in both marks prevail over Respondent's domain name registrations by nearly four decades. Complainant has pending applications for the GARDEN STATE PARKWAY and NEW JERSEY TURNPIKE marks covering various merchandise goods which were filed a full year prior to Complainant's becoming aware of the disputed domain name, and filed in connection with Complainant's ongoing merchandising efforts. Complainant uses its marks in connection with the iconic and well-known U.S. highways—the New Jersey Turnpike, and the Garden State Parkway. Consumers both locally and throughout the nation have come to associate both of the marks with Complainant and its offered services.

Respondent's claim that Complainant violates the doctrine of laches by bringing forth the Complaint has no reasonable basis, as laches is an equitable defense when a claimant "inexcusably delays in asserting its claim and thereby unduly prejudices the party against whom the claim ultimately is asserted." Complainant asserts that as a general matter, panels do not apply the defense of laches to analysis under the Policy. Complainant's first notice of the domain names at issue was in July of 2012. Respondent's websites do not appear within the first ten pages of a Google search for the terms "NJ TURNPIKE" and "GARDEN STATE PARKWAY," which demonstrate that Respondent took pains to hide his websites. Respondent will suffer no undue prejudice if ordered to transfer the

domain name, as Respondent does not operate a business utilizing the "Garden State Parkway" or "NJ Turnpike" names. Instead, Respondent registered the domain names with the purpose of confusing the public regarding its goods and services because it improperly suggests an affiliation with Complainant, which Respondent does not have.

Respondent cannot claim to be unaware of Complainant's marks when it registered the disputed domain names, as the marks upon which the domain names are based have been widely utilized for decades. Respondent only uses the disputed domain names to deceptively route Internet users who mean to search for Complainant's website and instead reach Respondent's website, where Respondent sells merchandise and advertising space, which cannot be considered legitimate business corresponding to the domain names.

## 2. Respondent makes the following claims in its Additional Submission:

Respondent contends that his Response contains the bulk of its arguments, reiterating that he has paid for, maintained, designed, and managed the `<gardenstateparkway.com>` and `<njturnpike.com>` domain names over the last fifteen years, which has value in its own right. Respondent expresses willingness to accept a monetary settlement in exchange for transferring the domain names to Complainant. Respondent claims that his `<njturnpike.com>` domain name does not infringe on Complainant's NEW JERSEY TURNPIKE mark, as the domain name is not the same as the mark.

## FINDINGS

The `<gardenstateparkway.com>` and `<njturnpike.com >` were registered on July 31, 1998.

The Complainant is the holder of the following registered service marks with the USPTO (United States Patent and Trademark Office):

- GARDEN STATE PARKWAY, Reg. No. 4,121,263 int. class 036 (Highway toll collection services) filed July 26, 2011, registered January 17, 2012.
- GARDEN STATE PARKWAY, Reg. No. 4,134,513 int. class 037 (e.g. Highway management and maintenance) filed July 26, 2011, registered May 1, 2012.
- GARDEN STATE PARKWAY, Reg. No. 4,166,853 int. class 039 (Transportation services) filed July 26, 2011, registered April 17, 2012.
- GARDEN STATE PARKWAY, (fig.) Reg. No. 2,451,349 int. class 037 (e.g. Highway management and maintenance) filed October 22, 1998, registered May 22, 2001.
- NEW JERSEY TURNPIKE, Reg. No. 4,160,283 int. class 039 (Transportation services) filed July 26, 2011, registered June 19, 2012.
- NEW JERSEY TURNPIKE, Reg. No. 4,160,284 int. class 036 (Highway toll collection services) filed July 26, 2011, registered June 19, 2012.
- NEW JERSEY TURNPIKE, Reg. No. 4,204,630 int. class 037 (e.g. Highway

management and maintenance) filed July 26, 2011, registered September 11, 2012.

## DISCUSSION

### The ICANN rules application to domain names registered prior to its implementation

In its Response, Respondent contends that it registered and purchased the <gardenstateparkway.com> and <njturnpike.com> domain names fifteen years ago, on July 31, 1998, and asserts that at the time, ICANN did not yet exist.

The Panel notes that ICANN adopted and implemented the UDRP on October 24, 1999. Further, the Panel notes that the disputed domain names were renewed on June 11, 2003.

In *City of San Diego v. NA*, FA836577 (Nat. Arb. Forum Dec. 28, 2006), the panel held that while the respondent registered the disputed domain name in 1998, prior to the 1999 effective date of the UDRP, the respondent renewed the domain name's registration in February of 2006, thereby expressly committing itself to be "bound by the terms of the Policy by virtue of its domain registrar's domain registration agreement."

The Panel finds that because Respondent in the present case renewed registration of the <gardenstateparkway.com> and <njturnpike.com> domain names in 2003, five years after ICANN implemented the UDRP, Respondent is now subject to the Policy's constraints. See also *Furrytails Ltd v. Mitchell*, D2001-0857 (WIPO Sep. 6, 2001) (finding the controversy before the panel to be within the jurisdiction of the Panel despite the respondent's objection on the grounds that it registered the domain name prior to the existence of ICANN).

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."

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 claims, in its Complaint and Additional Submission, to own rights in the

GARDEN STATE PARKWAY mark (e.g., Reg. No. 2,452,349 filed October 22, 1998, registered May 22, 2001) and the NEW JERSEY TURNPIKE mark (e.g., Reg. No. 4,160,283 filed July 26, 2011, registered June 19, 2012).

Previous panels have stated that trademark registrations with the USPTO serve to establish a complainant's rights in its marks under the Policy. See *Paisley Park Enters. v. Lawson*, FA 384834 (Nat. Arb. Forum Feb. 1, 2005).

The Panel similarly finds that Complainant's rights in the GARDEN STATE PARKWAY mark and the NEW JERSEY TURNPIKE mark are demonstrated through its USPTO registrations under Policy ¶ 4(a)(i). The Panel concludes that Complainant's rights in each of its marks pursuant to Policy ¶ 4(a)(i) accrue from the filing date of the corresponding trademark application. See *Thompson v. Zimmer*, FA 190625 (Nat. Arb. Forum Oct. 27, 2003) ("As Complainant's trademark application was subsequently approved by the U.S. Patent and Trademark Office, the relevant date for showing 'rights' in the mark for the purposes of Policy ¶ 4(a)(i) dates back to Complainant's filing date.").

While Respondent argues that his registration of the <gardenstateparkway.com> and <njturnpike.com> domain names predates Complainant's alleged rights in the marks, the Panel finds that such a determination is not necessary under Policy ¶ 4(a)(i) as this portion of the Policy considers only whether Complainant has rights in the marks and whether the disputed domain names are identical or confusingly similar to Complainant's marks. See *AB Svenska Spel v. Zacharov*, D2003-0527 (WIPO Oct. 2, 2003) (holding that the UDRP does not require a complainant to have registered its trademark prior to the respondent's registration of the domain name under Policy ¶ 4(a)(i) but may prevent a finding of bad faith under Policy ¶ 4(a)(iii)); see also *Clear!Blue Holdings, L.L.C. v. NaviSite, Inc.*, FA 888071 (Nat. Arb. Forum Mar. 5, 2007) ("Although the domain name in dispute was first registered in 1996, four years before Complainant's alleged first use of the mark, the Panel finds that Complainant can still establish rights in the CLEAR BLUE marks under Policy ¶ 4(a)(i).").

While Respondent contends that the <gardenstateparkway.com> and <njturnpike.com> domain names are comprised of common and geographically descriptive terms and as such cannot be found to be identical or confusingly similar to Complainant's marks, the Panel finds that such a determination is not necessary under Policy ¶ 4(a)(i) as this portion of the Policy considers only whether Complainant has rights in the marks and whether the disputed domain names are identical or confusingly similar to Complainant's marks. See *Precious Puppies of Florida, Inc. v. kc*, FA 1028247 (Nat. Arb. Forum Aug. 10, 2007) (examining Respondent's generic terms arguments only under Policy ¶ 4(a)(ii) and Policy ¶ 4(a)(iii) and not under Policy ¶ 4(a)(i)); see also *Vitello v. Castello*, FA 159460 (Nat. Arb. Forum July 1, 2003) (finding that the respondent's disputed domain name was identical to complainant's mark under Policy ¶ 4(a)(i), but later determining the issue of whether the disputed domain name was

comprised of generic terms under Policy ¶¶ 4(a)(ii) and 4(a)(iii)).

Complainant sets forth the contention that the <gardenstateparkway.com> domain name is identical to its GARDEN STATE PARKWAY mark, as the domain name incorporates Complainant's mark and includes the generic top-level domain ("gTLD") ".com."

The Panel notes that the <gardenstateparkway.com> domain name also fails to include the spaces that exist in the GARDEN STATE PARKWAY mark. The Panel finds the <gardenstateparkway.com> domain name identical to Complainant's GARDEN STATE PARKWAY mark pursuant to Policy ¶ 4(a)(i), regardless of the minor changes made within the domain name. See *Diesel v. LMN*, FA 804924 (Nat. Arb. Forum Nov. 7, 2006) (finding <vindiesel.com> to be identical to complainant's mark because "simply eliminat[ing] the space between terms and add[ing] the generic top-level domain ("gTLD") '.com' . . . [is] insufficient to differentiate the disputed domain name from Complainant's VIN DIESEL mark under Policy ¶ 4(a)(i)").

Complainant also concludes that the <njturnpike.com> domain name is confusingly similar to its NEW JERSEY TURNPIKE mark, alleging that the domain name includes the gTLD ".com," and substitutes the state code "NJ" in place of the state's full name and the first two terms of Complainant's mark, "NEW JERSEY."

The Panel observes that the <njturnpike.com> domain name omits the spaces within the NEW JERSEY TURNPIKE mark. The Panel determines that as a result of the changes made, the <njturnpike.com> domain name is confusingly similar to Complainant's NEW JERSEY TURNPIKE mark pursuant to Policy ¶ 4(a)(i). See *Am. Int'l Group, Inc. v. Domain Admin. Ltd.*, FA 1106369 (Nat. Arb. Forum Dec. 31, 2007) (finding that "spaces are impermissible and a generic top-level domain, such as '.com,' '.net,' '.biz,' or '.org,' is required in domain names. Therefore, the panel finds that the disputed domain name [<americangenerallifeinsurance.com>] is confusingly similar to the complainant's [AMERICAN GENERAL] mark."); see also *Minn. State Lottery v. Mendes*, FA 96701 (Nat. Arb. Forum Apr. 2, 2001) (finding that the <mnlottery.com> domain name was confusingly similar to the complainant's MINNESOTA STATE LOTTERY mark under Policy ¶ 4(a)(i)).

The first element of the Policy is thus fulfilled.

### Rights or Legitimate Interests

Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), and then the burden shifts to Respondent to show he does have rights or legitimate interests. See *Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (Nat. Arb. Forum Aug.



18, 2006) (holding that the complainant must first make a prima facie case that the respondent lacks rights and legitimate interests in the disputed domain name under UDRP ¶ 4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name); see also AOL LLC v. Gerberg, FA 780200 (Nat. Arb. Forum Sept. 25, 2006) (“Complainant must first make a prima facie showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.”).

Complainant makes the contention that Respondent has never been commonly known by the either the <gardenstateparkway.com> or <njturnpike.com> domain name, or any variation thereof. Complainant makes the allegation that Respondent’s domain names suggest a relationship with Complainant, which Respondent does not have. Previous panels have stated that without a complainant’s approval to use the mark, a respondent has no rights or legitimate interests in a corresponding domain name where no evidence exists to suggest that the respondent is commonly known by the domain name. See IndyMac Bank F.S.B. v. Eshback, FA 830934 (Nat. Arb. Forum Dec. 7, 2006) (finding that the respondent failed to establish rights and legitimate interests in the <emitmortgage.com> domain name as the respondent was not authorized to register domain names featuring the complainant’s mark and failed to submit evidence that it is commonly known by the domain name).

The Panel draws the conclusion that because Respondent lacks permission or approval from Complainant to use either mark and because nothing in the record suggests that Respondent is in fact commonly known by the disputed domain names, Respondent is not commonly known by either the <gardenstateparkway.com> or <njturnpike.com> domain names.

Complainant contends that Respondent does not possess rights or legitimate interests in the <gardenstateparkway.com> or <njturnpike.com> domain names, due to Respondent’s initial use of the domain names to promote the town of Ocean Grove, New Jersey. Complainant alleges that Respondent previously used the resolving websites to display information relating to Ocean Grove and to sell advertising space and merchandise. Complainant provides evidence in the form of a screenshot that shows advertisement for Ocean Grove accommodations.

Complainant also makes the assertion that Respondent’s current use of the <gardenstateparkway.com> and <njturnpike.com> domain names to redirect to a website criticizing Complainant’s business by displaying a “middle finger” logo is a direct response to Complainant’s cease and desist letter, and fails to demonstrate a legitimate use of the domain names. Complainant includes evidence showing a screen shot of the currently resolving website, which displays criticisms of Complainant, and also

advertises a gift shop offering apparel bearing the middle finger logo, the words "FNJ tolls," and various disparaging phrases.

Respondent argues that the terms of the <gardenstateparkway.com> and <njturnpike.com> domain names are common and geographically descriptive, and therefore, Complainant does not have an exclusive monopoly on the terms on the Internet. Respondent contends that private individuals own the <brooklynbridge.com> and <whitehouse.com> domain names, both of which would seem to refer to government-owned property, but are not at issue because government entities have extensions that are granted to them for establishing websites relating to such properties.

In cases of domain names consisting of generic terms, prior panels have found that a respondent can establish rights or legitimate interests in a disputed domain name pursuant to Policy ¶ 4(a)(ii) when used in relation to the relied-upon meaning. See *Kaleidoscope Imaging, Inc. v. V Entm't*, FA 203207 (Nat. Arb. Forum Jan. 5, 2004) (finding that the respondent was using the <kaleidoscope.com> domain name for a bona fide offering of goods or services because the term was "generic" and respondent was using the disputed domain name as a search tool for Internet users interested in kaleidoscopes); see also *Qwest Commc'ns Int'l v. QC Publ'g Grp., Inc.*, FA 286032 (Nat. Arb. Forum July 23, 2004) (stating that "Complainant's rights in the QWEST mark are limited to its application to the tele-communications industry," where a variety of other businesses used the mark in unrelated fields).

The Panel finds that the domain name registrations do not in themselves confer rights or legitimate interests in the disputed domain names and that Respondent's websites do not demonstrate a Policy ¶ 4(c)(i) bona fide offering of goods or services, or a Policy ¶ 4(c)(iii) legitimate noncommercial or fair use of the domain names, due to the Respondent's use of the resolving websites to promote a destination in New Jersey completely unrelated to Complainant's business respectively make apparel sales and post vilifying content about Complainant. See *Golden Bear Int'l, Inc. v. Kangdeock-ho*, FA 190644 (Nat. Arb. Forum Oct. 17, 2003) ("Respondent's use of a domain name confusingly similar to Complainant's mark to divert Internet users to websites unrelated to Complainant's business does not represent a bona fide offering of goods or services under Policy ¶ 4(c)(i) or a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii)."); see also *Weekley Homes, L.P. v. Fix My House Or Else?*, FA 96609 (Nat. Arb. Forum Apr. 18, 2001), where the panel stated that the respondent's use of the complainant's mark in the domain name to host a website critical of the complainant is not a legitimate use because the disputed domain name is confusingly similar to the complainant's mark.

All in all, the Panel finds that Complainant has made a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain names under Policy ¶ 4(a)(ii). Accordingly, the burden has shifted to Respondent to show it does have rights or legitimate interests. The Panel finds that no evidence submitted in this case indicates

that the Respondent has rights or legitimate interests in the disputed domain names. Therefore, the Respondent has not fulfilled its burden and the second element of the Policy is fulfilled.

### Registration and Use in Bad Faith

Complainant alleges, in its Complaint and Additional Submission, that it has used the GARDEN STATE PARKWAY mark and the NEW JERSEY TURNPIKE mark since the 1950s, in connection with the famous roadways bearing the respective names. Complainant argues that the strength of the marks creates a protectable trademark interest in the marks on behalf of Complainant, which Complainant has cultivated by investing a great deal of time and monetary resources to promote and advertise the marks, leading to substantial consumer recognition and goodwill.

Complainant argues that its marks were well-established for decades prior to Respondent's registration of the domain names, and Complainant's roadways under the GARDEN STATE PARKWAY and NEW JERSEY TURNPIKE marks were so well known and "intrinsically tied to the fabric of the State of New Jersey" that Respondent cannot claim to have been unaware of Complainant's marks. Further, Complainant asserts that Respondent is located in the state of New Jersey and displays negative content regarding paying tolls on New Jersey highways on its website, which demonstrates that Respondent was aware of Complainant's marks.

Respondent argues that because his domain names were registered thirteen years before Complainant applied for trademark registrations for its marks, Respondent's rights to the <gardenstateparkway.com> and <njturnpike.com> domain names trump Complainant's. Respondent allege to have researched for trademarks for both names before the registration of the disputed domain names and that no trademarks were associated with these names at that time. Respondent contends that the <gardenstateparkway.com> and <njturnpike.com> domain names are comprised entirely of common and geographic terms that have many meanings apart from use in Complainant's GARDEN STATE PARKWAY and NEW JERSEY TURNPIKE marks. Moreover, Respondent contends that the registration and use of domain names comprising such common terms is not necessarily done in bad faith.

The Panel notes that Respondent's disputed domain name registrations predate the Complainant's filing of the adduced service marks. Generally, when a domain name is registered by the respondent before the complainant's relied-upon trademark right is shown to have been first established (whether on a registered or unregistered basis), the registration of the domain name would not have been in bad faith because the registrant could not have contemplated the complainant's then non-existent right. See *Open Sys. Computing AS v. degli Alessandri*, D2000-1393 (WIPO Dec. 11, 2000) (finding no bad faith where the respondent registered the domain name in question before application

and commencement of use of the trademark by the complainant).

Therefore, Complainant will have to rely upon unregistered rights in order to prove Respondent's bad faith registration. The Panel finds that it is Complainant's burden to show that the marks had achieved common law rights prior to their registration. Relevant evidence includes i.e. length and amount of sales under the marks, the nature and extent of advertising, consumer surveys and media recognition. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), para 1.7 ("[...] a conclusory allegation of common law or unregistered rights (even if undisputed) would not normally suffice; specific assertions of relevant use of the claimed mark supported by evidence as appropriate would be required.")

No evidence in support of the Complainant's invoked longstanding use of the marks or widespread recognition and fame of the marks has been submitted in this case. Accordingly, the Panel finds that Complainant has not proven common law rights to the GARDEN STATE PARKWAY and NEW JERSEY TURNPIKE marks prior to the disputed domain name registrations.

Without proof of trade or service mark rights to GARDEN STATE PARKWAY and NEW JERSEY TURNPIKE at the time of the domain names's registrations, they are to be considered as consisting of common terms at the time of their registration. Therefore, the Panel finds that Respondent did not register the <gardenstateparkway.com> and <njturnpike.com> domain names in bad faith under Policy ¶ 4(a)(iii). See *Zero Int'l Holding v. Beyonet Servs.*, D2000-0161 (WIPO May 12, 2000) ("Common words and descriptive terms are legitimately subject to registration as domain names on a 'first-come, first-served' basis."); see also *Target Brands, Inc. v. Eastwind Group*, FA 267475 (Nat. Arb. Forum July 9, 2004) (holding that the respondent's registration and use of the <target.org> domain name was not in bad faith because the complainant's TARGET mark is a generic term); see also *Miller Brewing Co. v. Hong*, FA 192732 (Nat. Arb. Forum Dec. 8, 2003) (finding that because the respondent was using the <highlife.com> domain name, a generic phrase, in connection with a search engine, the respondent did not register and was not using the disputed domain name in bad faith).

The Panel finds that the third element of the Policy is not fulfilled.

## DECISION

Having not established all three elements required under the ICANN Policy, the Panel concludes that relief shall be DENIED.

Accordingly, it is Ordered that the <gardenstateparkway.com> and <njturnpike.com> domain names REMAIN WITH Respondent.

Jonas Gulliksson, Panelist

Dated: July 17, 2013

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