

ADMINISTRATIVE PANEL DECISION

Spokane Hoopfest Association v. Glenn Smith, Hoopfest Basketball Case No. D2024-0797

1. The Parties

Complainant is Spokane Hoopfest Association, United States of America (“United States”).

Respondent is Glenn Smith, Hoopfest Basketball, United States.

2. The Domain Name and Registrar

The disputed domain name <hoopfestbasketball.com> (hereinafter “Disputed Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 21, 2024. On February 22, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On the same date, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on February 28, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on the same date.

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

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on March 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 27, 2024. Respondent’s representative sent an email communication to the Center on March 28, 2024.

The Center appointed Lawrence K. Nodine as the sole panelist in this matter on April 10, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Complainant is a Washington nonprofit corporation that was formed in 1990. In the 30 years since its formation, Complainant has organized and produced basketball tournaments using the trademark HOOPFEST (hereinafter the "Mark"). Complainant claims that it created its website, <spokanehoopfest.net>, in January 2000.

Complainant owns United States Trademark Registration No. 6,238,326 (registered on January 5, 2021) for the trademark HOOPFEST (hereinafter the "Mark"). Complainant filed its application for this registration on June 9, 2020. The Panel notes that the Mark is subject of cancellation proceeding currently pending before the United States Patent and Trademark Office; yet the registration is valid as at the date of this Decision.

In Complainant's tournament, teams of three players ("3-on-3") compete in Spokane, Washington, on city streets blocked off for the event. There is no allegation or evidence that Complainant conducts or licenses basketball tournaments anywhere outside Spokane.

Complainant alleges that its tournament is the world's largest such event. In 2010, an online publication stated that Spokane's HOOPFEST event could boast the world record as the largest 3-on3 basketball tournament played on city streets. In 2015, ESPN broadcast nationally from Spokane during the event. In the year 2019, approximately 250,000 people, including 24,000 players and 3,000 volunteers, from 44 states and six countries, attended the tournament. Complainant also sells apparel and other goods under the Mark.

Respondent registered the Disputed Domain Name in July 1, 2020, about three weeks after Complainant applied to register the Mark. The website associated with the Disputed Domain Name (hereinafter sometimes "Disputed Website") displays the names of multiple basketball tournaments such as "Thanksgiving Hoopfest," "Hoopfest in Paradise," and "Piney-Woods Hoopfest." The Disputed Website also includes links to websites where users can purchase tickets to the basketball events promoted on the website, as well as apparel.

Respondent first used the "Hoopfest" as the name for its basketball tournaments in 2009. The Panel derives this information from the website associated with the Disputed Domain Name. Complainant submits copies of excerpts from these websites as evidence. The Panel reviewed the website, including the "About Us" page which states:

HOOPFEST BASKETBALL ABOUT US

In November 2009 [...] the **Thanksgiving Hoopfest** began. The brainchild of serial entrepreneur Glenn Smith, the Thanksgiving Hoopfest has grown from a single event to the Hoopfest Basketball Series with stops in Lufkin, Dallas and Texarkana, Texas, Salt Lake City, Utah; and Nassau, Bahamas.

The website also describes Respondent's 2023 "Thanksgiving Hoopfest": "The 15th Annual Thanksgiving Hoopfest will once again be one of the premier high school basketball events in the country." The webpage also includes a scrolling banner that includes the phrase "HOOPFEST BASKETBALL YEAR FIFTEEN".

To evaluate the credibility of Respondent's claim that his use of "Hoopfest" began in 2009, the Panel conducted its own research and found a YouTube Video that corroborates the claim.
"www.youtube.com/watch?v=k8kdk1pcMhc."

Respondent's basketball tournaments are different than Complainant's. Rather than a large festival on the streets Spokane featuring 3-on-3 contests for a wide range of ages and talent levels, Respondent's tournaments are for high school students. The "Vision" statement on Respondent's website declares that "Hoopfest Basketball envisions becoming the leading platform for high school basketball events, known for their commitment to excellence, innovation, and the celebration of young talent." Images on Respondent's website show high school athletes wearing traditional uniforms playing basketball in gymnasiums.

As Complainant alleges, Internet visitors can buy merchandise and tickets to the events listed on Respondent's website.

On May 5, 2023, Complainant sent a letter to Respondent complaining that the Disputed Domain Name infringed Complainant's rights in the Mark. Shortly thereafter, counsel for Respondent telephoned counsel for Complainant and said that Respondent would submit a written response to Complainant's letter, but no response was ever received. On December 28, 2023, counsel for Complainant sent another letter to counsel for Respondent, but Complainant has not received a response.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

B. Respondent

Respondent did not respond to the merits of Complainant's contentions. Respondent's counsel did send an email to the Center stating that Respondent denied all of the allegations in the Complaint, but he never followed up with any additional substantive response.

6. Discussion and Findings

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 Complainant's trademark and the Disputed Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The fact that cancellation proceedings are pending in respect of the Mark does not alter this finding, as this registration currently remains valid;

The Panel also finds, based on Complainant's long use (30 years) and significant media exposure, that Complainant has acquired common law rights in the Mark. These common law rights exist now, and that is sufficient for purposes of Policy paragraph 4(a)(i), but it is unclear whether or when Complainant's common law rights expanded beyond the Spokane region. This uncertainty is not relevant with respect to the first element of the Policy, but it is relevant with respect to the next two elements.

The entirety of the mark is reproduced and recognizable within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, “basketball,” may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the Disputed Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 Respondent may demonstrate rights or legitimate interests in a Disputed Domain Name.

Although the overall burden of proof in UDRP proceedings is on 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 Respondent. As such, where a complainant makes out a prima facie case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on Complainant). If Respondent fails to come forward with such relevant evidence, Complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Although Respondent did not file a substantive response, the website associated with the Disputed Domain Name states that Respondent began using “Hoopfest” in 2009. This evidence is sufficient to rebut Complainant’s prima facie case and demonstrate rights or legitimate interests. The evidence supports a finding under Policy paragraph 4(c)(i) that before any notice of the dispute, Respondent used a name corresponding to the Disputed Domain Name in connection with a bona fide service. It also supports a finding under the Policy paragraph 4(c)(ii) that Respondent has become commonly known by the Disputed Domain Name.

This Panel distinguishes this case from *Spokane Hoopfest Association v. Travis Haddock, National Hoopfest*, WIPO Case No. [D2023-0785](#),¹ where the respondent did not begin using the domain name at issue there before notice of the dispute. On the contrary, the respondent Haddock received notice of Complainant’s claim of trademark infringement before he registered the domain name at issue there. Also, Complainant’s federal trademark registration No. 6,238,326 issued a year prior, so there was no question about the scope of Complainant’s common law rights.

Complainant has not met its burden to show that Respondent’s prior use was not bona fide. Indeed, the Complaint ignored the evidence of Respondent’s fifteen-year use of “Hoopfest,” even though the evidence is prominently displayed throughout the website from which Complainant collected screenshots that it submitted as evidence.

It is significant that Respondent began using “Hoopfest” in 2009 in Texas, a state far from Spokane Washington. This is more than ten years before Complainant applied for a federal trademark registration. When Complainant’s registration issued in 2021, it did not cut off Respondent’s pre-existing common law rights. 15 U.S.C. 1057(c)(1). See 2 McCarthy on Trademarks and Unfair Competition § 16:18.50(5th ed.) (“Federal registration does not cut off the pre-existing common law rights of others”). Complainant has not demonstrated that its common law rights extended to Texas in 2009 when Respondent began using “Hoopfest” in connection with its tournaments.

Complainant may seek to prove in a court that its common law rights in 2009 extended to Texas, and that Respondent infringed those right, but such infringement claims are outside the scope of the Policy.

¹ Although the respondent in *Spokane Hoopfest Association v. Travis Haddock, National Hoopfest*, WIPO Case No. [D2023-0785](#) did not file a response and therefore defaulted, Mr. Haddock did subsequently file a petition to cancel Complainant’s federal trademark registration for HOOPFEST. See United States Patent and Trademark Office, Trademark Trial and Appeal Board Cancellation No. 92082893. As of the date of this decision, the cancellation proceedings are still pending.

In any event, the record evidence does not support a finding that Respondent adopted the “Hoopfest” name in order to capitalize on Complainant’s reputation. Respondent’s tournament is aimed at high school basketball players who aspire to compete at the collegiate and professional level. It is not apparent to the Panel that Respondent would benefit from a mistaken perception of affiliation with Complainant’s street festival open to everyone in the community. In any event, there is no evidence that Respondent implied an affiliation with Complainant or sought to derive any benefit from Complainant’s reputation when it began use “Hoopfest” in 2009 or in 2024 when the complaint was filed.

The Panel finds the second element of the Policy has not been established.

C. Registered and Used in Bad Faith

The Panel finds that Complainant has not proved that Respondent registered the Disputed Domain Name in bad faith. Complainant contends that Respondent registered the Disputed Domain Name to attract Internet users to its website for commercial gain by causing a likelihood of confusion with its Mark.

The balance of the evidence does not support Complainant’s contention that Respondent targeted Complainant’s “Marks, in bad faith, with the intention of obtaining a free ride on the established reputation of the Complainant and its trademarks.” It is possible that Respondent registered the Disputed Domain Name to facilitate communications about its own use of “Hoopfest” as a trademark for high school basketball tournaments without any intention to exploit Complainant’s reputation or goodwill. By the time he registered the Disputed Domain Name in 2020, Respondent had been using “Hoopfest” as a trademark to promote basketball tournaments for highly competitive high school players for ten years. Respondent’s vision statement states that he “envisions becoming the leading platform for high school basketball events, known for their commitment to excellence, innovation, and the celebration of young talent.” This is different from Complainant’s community festival, and the difference does not match with Complainant’s contention that Respondent intended to cause confusion and exploit Complainant’s goodwill. No aspect of the submitted evidence regarding Respondent’s website reflects any effort to impersonate or target Complainant or its festival.

The Panel finds that Complainant has failed to prove by a preponderance of the evidence that Respondent targeted Complainant when he registered the Disputed Domain Name.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Lawrence K. Nodine/

Lawrence K. Nodine

Sole Panelist

Date: May 14, 2024