

ADMINISTRATIVE PANEL DECISION

The Lumineers, LLC v. Super Privacy Service LTD c/o Dynadot / Andrey Weprikov

Case No. D2022-1637

1. The Parties

The Complainant is The Lumineers, LLC, United States of America (“United States”), represented by Creative Law Network, LLC, United States.

The Respondent is Super Privacy Service LTD c/o Dynadot, United States / Andrey Weprikov, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <thelumineers2022.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 5, 2022. On May 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 7, 2022, 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 and contact information in the Complaint.

The proceedings were suspended on May 17, 2022. The Center reinstated the proceedings on August 15, 2022.

The Center sent an email communication to the Complainant on August 15, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on August 15, 2022.

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

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 7, 2022.

The Center appointed Assen Alexiev as the sole panelist in this matter on September 20, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is an American folk-rock band established in the 2000s. Since 2012, they have issued four albums, three of which were number one or number two albums on Billboard 200, made four world tours and have been nominated for two Grammy awards. The Complainant has its official website at the domain name <thelumineers.com>.

The Complainant is the owner of, *inter alia*, the following trademark registrations for THE LUMINEERS (the "THE LUMINEERS trademark"):

- the United States trademark THE LUMINEERS with registration No. 4,406,893, registered on September 24, 2013, for services in International Class 41, with first use in commerce on July 9, 2009;
- the United States trademark THE LUMINEERS with registration No. 4,406,895, registered on September 24, 2013, for goods in International Class 25, with first use in commerce on August 1, 2010;
- the United States trademark THE LUMINEERS with registration No. 4,406,896, registered on September 24, 2013, for goods in International Class 9, with first use in commerce on November 14, 2009; and
- the International trademark THE LUMINEERS with registration No. 1,160,926, registered on April 16, 2013, for goods and services in International Classes 9, 25, and 41.

The disputed domain name was registered on February 9, 2022. It resolves to a website that lists the Complainant's planned live performances and offers for sale tickets for them through third-party resellers.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name is confusingly similar to its THE LUMINEERS trademark, because it incorporates the trademark entirely as its prominent and primary element. The only difference between the disputed domain name and the THE LUMINEERS trademark is the addition of the number "2022", which refers to the Complainant's upcoming 2022 global tour. According to the Complainant, this adds to the likelihood of confusion.

The Complainant maintains that the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it has not been commonly known by the disputed domain name or acquired any trademark or service mark rights, has no connection or affiliation with the Complainant or with any agent, licensee, assignee, or other affiliate of the Complainant, and has no rights to use the THE LUMINEERS trademark in the disputed domain name or otherwise. The Complainant maintains that the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services. Rather, the Respondent has used the disputed domain name to illegitimately benefit from the Complainant's goodwill in the THE LUMINEERS trademark. The Complainant notes that all the contents of the website under the disputed domain name are directly related to the Complainant, reference the Complainant, and capitalize on the goodwill the Complainant has established in the THE LUMINEERS trademark. According to the

Complainant, the Respondent uses the disputed domain name with the intent for commercial gain to mislead the Complainant's legitimate consumers and to divert them to the website at the disputed domain name, which contains links to third-party websites that benefit from the goodwill of the THE LUMINEERS trademark without authorization.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. According to it, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website at the disputed domain name by creating a likelihood of confusion with the THE LUMINEERS trademark as to the source, sponsorship, affiliation, and endorsement of the website under the disputed domain name. The Complainant notes that the website at the disputed domain name includes content identical or similar to content on the Complainant's website including a list of the Complainant's upcoming live performances and links to purchase tickets for them through "secondary market" ticket "resellers", some of which may operate illegally. The Complainant explains that ticket resellers purchase tickets to the Complainant's live performances from the exclusive retailer of said tickets and then resell the same tickets for a profit. According to the Complainant, this process provides an undeserving profit to the reseller who benefits from the goodwill associated with the Complainant's THE LUMINEERS trademark, reputation, and performance, and diverts legitimate consumers from purchasing tickets from the retailer with the exclusive right to sell the tickets and compensate the Complainant.

B. Respondent

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

6. Discussion and Findings

6.1. Some Procedural Considerations

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

The Respondent's physical mailing address is in Ukraine, and the indicated phone number of the Respondent includes the dialing code for Ukraine. Ukraine is currently subject to a military conflict with the Russian Federation and this may impact case notification. It is therefore appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

Having considered the circumstances of the case, the Panel decides that they do not justify a suspension or termination of the proceeding, and that it is proper to conclude it with a decision on the substance of the dispute.

The Panel notes that the Center sent the Notification of Complaint by email to the Respondent at its email address as registered with the Registrar, as well as through a web form on the same website. There is no evidence that the case notification email messages to these email addresses were not successfully delivered. The website hosted at the disputed domain name has changed its content after the submission of the Complaint and the notification of the proceeding, which supports an inference that the Respondent has access to it and to the disputed domain name, and should be able to receive communications related to them.

It is moreover noted that, for the reasons which are set out later in this Decision, the Panel has no serious doubt (albeit in the absence of any Response) that the Respondent registered and has used the disputed domain name in bad faith and with the intention of unfairly targeting the Complainant's goodwill in its trademark.

Based on the above, the Panel is satisfied that each of the Parties has been given a proper notice of the proceeding and a fair opportunity to present its case, and proceeds to issue the present Decision.

The Panel also notes that the Complainant has submitted, with respect to any challenges that may be made by the Respondent to a decision by the Panel to transfer or cancel the disputed domain name, to the jurisdiction of the courts at the location of the principal office of the Registrar, *i.e.*, the courts in California, United States.

6.2. Substantive issues

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the transfer of the disputed domain name:

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

In this case, the Center has employed the required measures to achieve actual notice of the Complaint to the Respondent, in compliance with the Rules, paragraph 2(a), and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name [...]”.

The Respondent however did not make any submission in this proceeding.

A. Identical or Confusingly Similar

The Complainant has provided evidence that it is the owner of the THE LUMINEERS trademark and has thus established its rights in this trademark for the purposes of the Policy.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the Top-Level Domain (“TLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” TLD section of the disputed domain name.

The relevant part of the disputed domain name for purposes of the first element analysis is therefore the sequence “thelumineers2022”, which reproduces the THE LUMINEERS trademark entirely with the addition of the number “2022”. The THE LUMINEERS trademark is easily recognizable. As discussed in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

In view of the above, the Panel finds that the disputed domain name is confusingly similar to the THE LUMINEERS trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

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

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because it has not been authorized to use the THE LUMINEERS trademark, has no relevant trademark rights and have not been commonly known under the disputed domain name. The Complainant adds that the Respondent has not made any *bona fide* use of the disputed domain name, but uses it for a website that features the THE LUMINEERS trademark and offers for sale tickets for the concerts of the Complainant through third-party resellers.

The Respondent has not submitted a Response and has not disputed the Complainant’s contentions and evidence in this proceeding.

As discussed in section 2.8.1 of the [WIPO Overview 3.0](#), panels acting under the Policy have recognized that resellers or distributors using a domain name containing the complainant’s trademark to undertake sales related to the complainant’s goods may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (the “Oki Data test”), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder;
and
- (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

In view of the circumstances of the present case, the Panel accepts that the requirements of the Oki Data test have not been complied with by the Respondent. The disputed domain name incorporates the THE LUMINEERS trademark in combination with the number “2022”, which suggests that it is an official website of the Complainant related to its activities in the year 2022, more so in view of its strong similarity to the Complainant’s official website at “www.thelumineers.com”. Indeed, the disputed domain name resolves to a website that offers for sale tickets for the live performances of the Complainant in 2022 to be delivered during its world tour in the same year. These tickets are offered through links on the Respondent’s website to third-party resellers. The Complainant maintains that these third-party resellers have not been authorized by it to sell tickets for its concerts, that they buy such tickets from the Complainant’s exclusive retailer and then resell them at a profit. It is unclear whether such resold tickets would be valid, and there is no evidence in the case to suggest the opposite.

The Respondent's website contains the following text:

"THE LUMINEERS 2022 TOUR & TICKETS

This website is operated by a ticket broker. Ticket prices are set by third-party sellers and may be above or below face value. We are not affiliated with The Lumineers."

The Panel does not regard this statement as an accurate and prominent disclosure of the Respondent's relationship with the Complainant, because it does not disclose that the tickets offered through the website are sold by third parties that are not affiliated to the Complainant and have not been authorized by it to sell tickets for its concerts. This, coupled with the suggestion made by the composition of the disputed domain name – that it is an official website of the Complainant for its 2022 activities, may well confuse Internet users to believe that the Respondent's website represents a legitimate online distribution channel for tickets for the Complainant's concerts in 2022 that has been authorized by the Complainant.

Based on the above considerations, the Panel concludes that the Respondent does not meet the Oki Data criteria. The Panel also finds that the composition of the disputed domain name carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

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

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

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

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

As discussed above in this decision, the disputed domain name is confusingly similar to the Complainant's THE LUMINEERS trademark and is being used for a website that contains information about the Complainant's concerts in 2022, and offers for sale tickets for such concerts through third-party resellers. As noted by the Complainant and not disputed by the Respondent, these third-party resellers buy tickets from the Complainant's exclusive retailer and then resell them at a profit – an activity that has not been authorized by the Complainant. The Respondent's website does not disclose to its visitors that the tickets offered through it are not being sold through the official retail channel authorized by the Complainant. This leads the Panel to the conclusion that the Respondent is aware of the Complainant, its services and trademark, and has targeted them with the registration and use of the inherently misleading disputed domain name, in an attempt to unfairly capitalize on the Complainant's goodwill for commercial gain by attracting Internet users to the Respondent's website and misleading them that tickets for the Complainant's concerts offered through this website are being sold through a legitimate and official retail channel endorsed by the Complainant.

This satisfies the Panel finds that the disputed domain name was registered and is being used in bad faith under paragraph 4(b)(i) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <thelumineers2022.com> be transferred to the Complainant.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: October 4, 2022