

ADMINISTRATIVE PANEL DECISION

Sight and Sound Ministries, Inc. v. Sight Sound, Sight & Sound Film, LLC
Case No. D2022-3118

1. The Parties

Complainant is Sight and Sound Ministries, Inc., United States of America (“United States”), represented by Gibbel Kraybill & Hess LLP, United States.

Respondent is Sight Sound, Sight & Sound Film, LLC, United States, internally represented¹.

2. The Domain Name and Registrar

The disputed domain name <sightandsound.film> (the “Domain Name”) is registered with IONOS SE (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 23, 2022. On August 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 25, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email to Complainant on August 26, 2022 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 August 26, 2022. The Center received several email communications from the Respondent on August 24, 26, and 31, 2022.

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”).

¹ Respondent’s email communications were not sent by the email address in the Registrar’s verification response, but from an email address “[...]@sightandsound.film”. The Panel considers that the email communications were sent by Respondent.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on August 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 18, 2022. On September 15, 2022, Respondent requested an extension to the Response due date. In accordance with paragraph 5(b) of the Rules, on September 15, 2022 the Center confirmed that the due date for Response has been extended to September 22, 2022. The Response was filed with the Center on September 22, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on September 28, 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.

On September 28, 2022, the Center received two email communications from Complainant and Respondent that the Panel has considered for the purposes of this decision.

4. Factual Background

Complainant alleges that it “owns and operates a theatrical services company in the business of performing, producing, and recording live public theatre events and productions related to Christian religious stories”. It appears that most of Complainant’s live productions are performed in Lancaster, Pennsylvania and Branson, Missouri, United States.

Complainant registered, with the United States Patent and Trademark Office (“USPTO”), the word mark SIGHT & SOUND on October 12, 2010, USPTO Reg. No. 3,859,775, in connection with “entertainment in the nature of spiritually themed live stage and multimedia shows”, with an August 1, 1976 date of first use in commerce. In addition, Complainant registered on October 12, 2010 the word mark SIGHT & SOUND THEATRES, USPTO Reg. No. 3,859,776, in connection with “entertainment in the nature of spiritually themed live stage and multimedia shows”, with a February 1, 1998 date of first use in commerce.

Complainant also registered the mark SIGHT & SOUND TV, Reg. No. 6,395,560, with the USPTO on June 22, 2021, with a July 23, 2020 date of first use in commerce. (This date of first use in commerce postdates the date on which Respondent registered the Domain Name.)

Further, on May 22, 2022, Complainant applied to the USPTO, Serial No. 97,432,338, to register the mark SIGHT & SOUND FILMS in connection with, among other things, “pre-recorded DVDs featuring films and movies” and “video production”, with no date of first use in commerce indicated on the application. Complainant asserts in the Complaint, however, that it first used SIGHT & SOUND FILMS as a trademark “since at least February 2021” in connection with its first full feature-length film, “I Heard the Bells”. It appears that this trademark application remains pending. (This trademark application filing and this first alleged use postdate the date on which Respondent registered the Domain Name.)

On March 9, 2020, Complainant registered Sight & Sound Films as a fictitious business name with the Commonwealth of Pennsylvania’s Department of State, United States. (This filing postdates the date on which Respondent registered the Domain Name.)

According to the Complaint, Complainant “also holds common law trademarks ... that it uses in the performance and sale of its live and recorded theatre productions and associated goods and services”. Complainant alleges that, for almost 40 years, it has “provided its live theatre services in-person under its SIGHT & SOUND family of marks”, and that in the course of “expanding its goods and services, Complainant now both records and streams both live and produced performances for retail and real-time sales”.

Complainant annexes to the Complaint two documents purporting to establish its “common law family of marks”. One document is a July 27, 2021 “Agreement of Mutual Rescission” between “Sight & Sound Films” and one of its employees. The other document is a March 5, 2021 “Production Services Agreement” between “Sight & Sound Ministries, Inc., d/b/a Sight & Sound Films” and a film studio, which agreement pertains to the production of the film “I Heard the Bells”. (Both of these contracts postdate Respondent’s registration of the Domain Name. Moreover, neither of these documents constitutes evidence of actual consumer recognition of any purported trademark; rather, both documents are private contracts between Complainant and an employee or a service provider.)

Respondent, incorporated in the State of New York, United States on September 18, 2018 under the name Sight & Sound Film, LLC, describes itself as “a creative B2B content agency for dozens of publicly-listed corporations, businesses and other commercial entities”. Most of Respondent’s business is conducted in New York, United States though Respondent alleges that it has also done work in Italy and the United Kingdom.

The Response includes links to Internet pages showing projects on which Respondent performed work, including at least one project dating back to 2018.

The Domain Name was registered on January 7, 2019. The Domain Name resolves to a commercial website which states: “Sight & Sound is a video & photography content production agency.” The site also states: “We create compelling images & stories for social, digital, streaming, broadcast, publication and other corporate communications.”

5. Parties’ Contentions

A. Complainant

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent asserts that it is operating a legitimate business and registered the Domain Name for that purpose without knowledge of Complainant or its trademarks.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

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

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark SIGHT & SOUND registration demonstrated in the record. The Panel also concludes that the Domain Name is identical to that mark.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel need not address this issue, given its ruling below on the “bad faith” element.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Complainant has failed to establish that Respondent registered and used the Domain Name in bad faith under the Policy. There is simply no evidence in the record that Respondent had knowledge of Complainant or its trademarks, or that there was any basis to conclude that such knowledge was even likely. Complainant has provided no evidence that its trademarks, while registered, enjoy any particular degree of renown. At the time the Domain Name was registered, it appears (from the record presented) that Complainant was producing live performances in two towns and may have been livestreaming those live performances via one or more Internet sites.

Respondent appears to have registered the Domain Name without knowledge of Complainant or its marks, and in aid of Respondent’s legitimate business activities.

The Complaint fails.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: October 3, 2022