

ADMINISTRATIVE PANEL DECISION

SoletLuna Holdings, Inc., Lifewave, Inc. v. Christiaan Macdonald,
Society Fools
Case No. D2024-4035

1. The Parties

The Complainants are SoletLuna Holdings, Inc. and Lifewave, Inc., United States of America (United States), represented by ARC IP Law, P.C, United States.

The Respondent is Christiaan Macdonald, Society Fools, Netherlands (Kingdom of the).

2. The Domain Name and Registrar

The disputed domain names <silentnights.art>, <silentnights.life>, <silentnights.net>, <silentnights.xyz> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 2, 2024. On October 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 2, 2024, 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 (GoDaddy East, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 4, 2024, 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 October 9, 2024.

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”).

The Respondent sent email communications to the Center on October 6, 2024, October 9, 2024, October 11, 2024, October 14, 2024, October 30, 2024, and October 31, 2024. The Respondent’s emails before October 30, 2024, led the Complainant to request a suspension of the proceeding to allow discussions with the Respondent. Apparently those discussions took place without satisfaction to either party and the Complainant requested resumption of the proceeding on October 29, 2024.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 30, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 19, 2024. The Response was filed with the Center on November 20, 2024.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on November 26, 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

Both Complainants are incorporated in Georgia in the United States. As discussed below, the First Complainant is the owner of a number of registered trademarks. It became the owner by assignment from the Second Complainant to whom the First Complainant has licensed back the trademarks including rights to handle the enforcement of the trademarks.

It appears from the Complaint and the Response that the Second Complainant manufactures, or at least supplies, non-transdermal adhesive patches. According to the Response, the Second Complainant appears to offer these products from a website at “www.lifewave.com” to which the domain name <silentnights.com> redirects.

As noted above, the First Complainant owns a number of registered trademarks for SILENT NIGHTS in different jurisdictions around the world. These include:

- (1) United States Registered Trademark No. 5,199,095, which was registered in the Principal Register on May 9, 2017, in respect of non-transdermal adhesive patches with a non-porous surface for phototherapy for general wellness in International Class 10 and which claimed first use in commerce in June 2008;
- (2) International Registration No. 1661347, which was registered on April 12, 2022 in respect of the same goods and designating Canada, European Union, Japan, Malaysia, Mexico, Philippines, Republic of Korea, Singapore, Thailand, United Kingdom, and Viet Nam;
- (3) Of those designated jurisdictions, the trademark has been registered in at least Canada (No. TMA1,226,565), European Union (No. 1661347), Malaysia (No. TM2022012255), Mexico (No. IR 1661347), Philippines (No. IR 1661347), Republic of Korea (No. 1661347), and United Kingdom (No. 1,661,347);
- (4) Taiwan, Province of China Registered Trademark No. 02275364, which was registered on January 16, 2023.

The disputed domain names were registered on June 10, 2024.

At the time this decision is being prepared, the disputed domain names resolve (in at least the United States and also the Panel’s location) to a parking page provided by the Registrar which under the heading “Related searches” includes three pay-per-click (PPC) links: such as “Lifewave Patches”, “Divan Beds”, and “Silent Night Mattress” in Annex 4 to the Complaint. According to the Complainant the PPC link to “Lifewave Patches” is, or includes, link to the Complainant’s products.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of a disputed domain name, the Complainants must demonstrate each of the following separately for each disputed domain name:

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

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

As noted above, the Response was submitted to the Center only on November 20, 2024, one day after the due date for its filing under the Rules and also after the Center notified the parties it was proceeding to appoint a Panel.

Although the Response was submitted one day late, there is no relevant prejudice to the Complainants (nor have the Complainants claimed any such prejudice). In the circumstances, the Panel proposes to admit it into the record in the exercise of the Panel's discretion under paragraph 10 of the Rules.

Further, given the relationship of the two Complainants as licensor and licensee of the First Complainant's trademarks and the submission of the Complaint jointly by both Complainants through the same counsel, it is appropriate to consolidate their respective complaints in the one proceeding against all disputed domain names. Each disputed domain name is held by the same person and the Complaint against each is in respect of the same trademark. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.11.

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 the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainants have proven ownership of registered trademarks for SILENT NIGHTS.

It is also well accepted that the Top Level Domain (TLD) component of a disputed domain name may be disregarded when comparing the disputed domain names to the Complainant's trademark. [WIPO Overview 3.0](#), section 1.11.

Disregarding the various TLDs, therefore, each disputed domain name is identical to the Complainants' trademark.

Accordingly, the Panel finds the first element of the Policy has been established.

B. Registered and Used in Bad Faith

In the circumstances of this case, it is appropriate to consider the third requirement under the Policy next.

Under the third requirement of the Policy, the Complainants must establish that the disputed domain names have been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g., *Group One Holdings Pte Ltd v. Steven Hafto*, WIPO Case No. [D2017-0183](#).

The Complainants rely on the resolution of the disputed domain names to a parking page with PPC links to establish this requirement under the Policy. They contend that this shows the Respondent has intentionally attempted to attract Internet users to the parking pages for commercial gain by creating a likelihood of confusion with the Complainants' trademark.

Such conduct is a typical ground for finding use in bad faith under the Policy. It may also be inferred from that conduct that the registration was also in bad faith.

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

In the present case, the Complainants contend that their trademark is widely known and closely associated with them as a result of extensive use since 2008 and the investment of substantial time, energy, and resources in developing and maintaining their reputation in the trademark through promotion.

First, the Panel is conscious that the Complainants' trademark is distinctive of their particular goods. It is nonetheless a common or stock phrase in many other contexts.

Secondly, the Complainants may in fact have such a reputation amongst the public interested in their products. However, their claims in this proceeding are mere assertion. The Complainants have not provided any evidence to corroborate their claims. For example, [WIPO Overview 3.0](#) section 1.3 points out that specific evidence of acquired distinctiveness is required to be provided to establish unregistered rights. Mere conclusory statements are inadequate. Correspondingly, where a complainant claims it has used its name so extensively that it is likely a respondent must have been aware of it, that also requires evidence of a similar character. In the present case, there is no evidence before the Panel of revenues or advertising expenditure or even of how the Complainants promote their product and, as already noted, the expression "Silent Nights" is not of such a character as to make its adoption by anyone other than the Complainants inherently implausible.

Apart from the PPC advertising, there is no evidence of the Respondent targeting the Complainants or their trademark in this case.

Evidence of the PPC advertising can, and typically does, provide a basis for inferring the knowledge required for bad faith under the Policy. That is so even where the Registrar and not the Respondent has activated the PPC advertising on the basis that the respondent has ultimate control over the use of its domain name. [WIPO Overview 3.0](#), section 2.9 (in the context of rights or legitimate interests). Where the Respondent's purpose is sought to be inferred, however, the strength of that inference falls to be assessed in light of all the circumstances. For example, *Haemonetics Corporation v. Brent Bristow*, WIPO Case No. [D2024-2838](#).

In the present case, the Respondent claims that he was originally seeking to register <silentnights.com> in connection with a yet to be announced art project but it was taken. When notified that <silentnights.com> was already registered, he entered it into his browser and was immediately redirected to the Second Complainant's website at "www.lifewave.com". The Respondent says he reviewed the website and noticed various patches being offered under the trademark LIFEWAVE but did not see any use of SILENT NIGHTS on the website and considered the Complainants' field quite remote from his plans.

According to the Respondent he then proceeded to register the disputed domain name <silentnights.net>. He also says, when registering that disputed domain name, he was offered the others for free and so accepted that offer.

Further, the Respondent claims he was unaware that the parking pages resolved to PPC advertising which, he says, was organized by the Registrar. According to the Respondent, when he contacted the Registrar to stop this after the Complaint was filed, the Registrar lock precluded any changes being made until this proceeding is concluded. (The Panel notes that this should not be the case; the existence of a UDRP case would prevent changes to the registration, but not site resolution so it is possible this is a misunderstanding on the part of the Registrar or Respondent; see definition of “lock” in the UDRP Rules.)

The Respondent has not provided any details, documentation or other corroboration of his planned art project of the kind which would be required to establish rights or legitimate interest in a disputed domain name on the basis of demonstrable preparations to use a disputed domain name in connection with a good faith offering of goods or services. [WIPO Overview 3.0](#), section 2.2.

The likely failure of a claim to rights or legitimate interests on the basis of use, or demonstrable preparations to use, in good faith would typically lead to a finding that the domain name in question had been registered in bad faith. Logically, however, that does not necessarily follow.

The Respondent has admitted that, when he registered the disputed domain names, he was aware that someone else had registered <silentnights.com>.

So, the Respondent had noticed that someone else was interested in the expression SILENT NIGHTS. The Respondent says, however, he followed that link to a website relating to a wholly unrelated field and which, the Respondent claims (and the Complainants have not disputed), did not feature the Complainants’ trademark at that time.

In the present case, the Panel is not in a position to accept the Complainants’ claim that their trademark is well-known around the world. In addition, the Complainants’ trademark potentially has multiple applications other than to reference the Complainants’ products. On the evidence before the Panel, therefore, it cannot be said the most likely explanation for the Respondent’s adoption of the name “Silent Nights” is to capitalise on a false association with the Complainants and the reputation of their trademark.

There is no evidence before the Panel contradicting his claim to have been unaware of the PPC advertising. That is not in itself sufficient to exonerate the Respondent. However, there is no evidence that he has engaged in the practice of using PPC advertising to generate revenues.

The Respondent has registered four disputed domain names based on the same expression. A respondent may be found to have registered and used a disputed domain name in bad faith under paragraph 4(b)(ii) of the Policy where the Panel finds the registration was to prevent the trademark owner from reflecting its trademark in a corresponding domain name provided the respondent has engaged in a pattern of such conduct. A pattern of conduct typically involves conduct directed against multiple trademark owners but may also involve multiple domain names directed against a single complainant.

In *Home Interiors & Gifts, Inc. v. Home Interiors*, WIPO Case No. [D2000-0010](#), for example, the learned panelist found an abusive pattern in the registration of two domain names about one week apart which the panelist considered demonstrated the respondent likely knew about the complainant and its trademark. *Salvatore Ferragamo S.p.A v. Ying Chou*, WIPO Case No. [D2013-2034](#) concerned four domain names based on “Ferragamo” registered over an 8-month period. Given the fame of the complainant’s trademark, the panel found the respondent must have known about it and had engaged in a pattern of conduct targeting the complainant’s trademark. The respondent did not dispute the complainant’s allegations. Typically, cases where abusive patterns have been found involve famous or distinctive trademarks.

While a “pattern” may be construed as the registration of as few as two abusive domain names, the Panel with some reservations is not prepared to find that the Respondent’s simultaneous registration of four disputed domain names an abusive pattern in the circumstances of this case. The Respondent has provided an explanation of how he came to register all the disputed domain names which, in the limited circumstances of this case, the Panel is not prepared simply to reject.

Given the absence of evidence about the fame and repute of the Complainants’ trademark, the comparatively limited and specialized field in which the Complainants use their trademark and, conversely, the wide scope for non-infringing uses of what is otherwise an ordinary, descriptive expression, the Panel is not prepared to infer that the Respondent has registered the disputed domain names to take advantage of their significance as the Complainants’ trademark. That is, the Panel is not prepared to infer on the very limited information presented by the Complainant in this proceeding that the Respondent registered the disputed domain names in bad faith.

As the Complainants must establish this requirement to succeed under paragraph 4(a)(iii) of the Policy, therefore, the Complaint must fail.

C. Rights or Legitimate Interests

As the Complaint must fail, no good purpose would be served by considering this requirement.

6. Decision

For the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: December 10, 2024