

Two 'tickets' to UDRP denial

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- The complainants, which owned registrations for the mark TICKETSMS, sought the transfer of 'ticketsms.com' and 'ticketsms.net' under the UDRP
- The panel found that, since the complainants' business and marks came into being several years after the registration of the domain names, it was implausible to assert that the respondent had targeted them
- The panel entered a finding that the complainants had engaged in RDNH

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied a UDRP complaint for the disputed domain names 'ticketsms.com' and 'ticketsms.net'. The decision was on the basis that the complainants had failed to show that the respondent had registered the domain names in bad faith. The panel also entered a finding that the complainants had engaged in reverse domain name hijacking (RDNH).

Background

The first complainant was TicketSms srl, an Italian company established in 2017 operating a digital ticketing system for event organisers. The second complainant was the founder and legal representative of the first complainant (collectively referred to as the 'complainants').

The complainants owned two trademark registrations for TICKETSMS, both registered in November 2020. They also registered the domain name 'ticketsms.it' in February 2015.

The respondent was an individual based in the United Kingdom who owned the UK trademark TICKET SMS SIMPLE MANAGED SOLUTION, registered in October 2015. He was also the owner of the domain name 'ticketsms.co.uk', registered in May 2011.

The respondent registered the disputed domain names in June 2009. On 9 October 2014 the disputed domain name 'ticketsms.com' redirected to the website at the domain name 'clickit4tickets.co.uk', which also belonged to the respondent. At the time of the UDRP complaint, the disputed domain names were resolving to parking pages.

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements under Paragraph 4(a):

1. the domain name registered by the respondent is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
2. the 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.

The complainants argued that, even though the domain names were registered in 2009, several years before the beginning of the complainants' business activity and trademark registrations, the respondent had never actively used them and his purpose had always been the sale of the domain names for profit. The complainants further underlined that the respondent had tried to sell them the domain names multiple times.

The respondent stated that he had registered the domain names in June 2009 in connection with his mobile ticketing technology projects. Back then, he also registered many other 'ticket'-related domain names with the same purpose. He claimed that, in July 2015, he was receptive to the complainants' enquiry about the purchase of the domain name 'ticketsms.com' because, by then, he had decided to abandon his various online ticketing projects. He further stated that the redirection of the domain name 'ticketsms.com' to the website at his other domain name was evidence of usage of the domain name. Finally, he pointed out that he could not have registered the disputed domain names by reference to the complainants because their trademark rights and business did not exist before 2015.

Decision

First limb

The panel accepted that the complainants had trademark rights in the TICKETSMS mark and that the domain names included the trademark in its entirety without any additional elements. They were therefore identical to the trademark in which the complainants had rights.

Second and third limbs

The panel did not consider the second limb in light of its analysis of the third limb.

In this regard, the panel found that the complainants had not satisfied the third limb as they had failed to prove that the respondent had registered the domain names in bad faith. The panel noted that the second complainant had started business activities under the TICKETSMS trademark in 2015, the first complainant was founded in 2017, and the TICKETSMS trademark was registered in 2020, while the domain names were registered in 2009. Therefore, the panel stated that the complainants had failed to show how the registration of the domain names could have been made in bad faith under these circumstances. The panel underlined that, since the complainants' business and trademarks came into being several years after the registration of the domain names, it was implausible to assert that the respondent had anticipated this and targeted them when registering the domain names.

The panel thus found that the complainants had failed to establish that the respondent had registered the domain names in bad faith. As both registration and use in bad faith are necessary to establish the third limb under Paragraph 4(a) of the UDRP and the complainants had failed to prove registration in bad faith, the panel did not consider it necessary to address the issue of use in bad faith. The panel therefore denied the complaint and entered a finding that the complainants had engaged in RDNH.

Comment

This decision highlights once again that trademark owners should think very carefully about filing a UDRP complaint when the domain name at issue was registered before their trademark. As explained in the [WIPO Overview 3.0](#), in such circumstances panels will not normally find bad faith on the part of a respondent. There are exceptions to this, but only in certain very limited circumstances where the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalise on the complainant's nascent trademark rights. Such scenarios include registration of a domain name shortly before or after announcement of a corporate merger, or further to a respondent's insider knowledge or significant media attention.

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