

ADMINISTRATIVE PANEL DECISION

The Royal Edinburgh Military Tattoo Limited v. Identity Protection Service,
Identity Protect Limited / Martin Clegg, WM Holdings
Case No. D2016-2290

1. The Parties

The Complainant is The Royal Edinburgh Military Tattoo Limited of Edinburgh, United Kingdom of Great Britain and Northern Ireland (“United Kingdom” or “UK”), represented by Wiggin LLP, United Kingdom.

The Respondents are Identity Protection Service, Identity Protect Limited of Godalming, United Kingdom / Martin Clegg, WM Holdings of Glasgow, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <edinburghmilitarytattootickets.com> is registered with 123-Reg Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 10, 2016. On November 10, 2016, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 11, 2016, 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 Center sent an email communication to the Complainant on November 15, 2016, 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 November 17, 2016.

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 November 23, 2016. In accordance with the Rules, paragraph 5, the due date for Response was December 13, 2016. The Respondent sent an email communication to the Center on December 14, 2016. The Respondent did not however submit any

responsive formal response. Accordingly, the Center notified the Parties about the commencement of the Panel Appointment Process on December 14, 2016.

The Center appointed Nick J. Gardner as the sole panelist in this matter on December 22, 2016. 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 a company incorporated under the laws of Scotland. It is responsible for the organising and promoting of a military pageant event called the Royal Edinburgh Military Tattoo (the "Tattoo"). The Tattoo is an annual event dating back to 1948 comprising military music and display. The Tattoo reflects military traditions dating back several centuries. It is a popular tourist event which is televised (in over 40 countries) and which attracts large audiences (attracting a total audience of around 100 million viewers). The Complainant sells a large number of tickets each year which enable members of the public to attend the Tattoo. Box office receipts are approximately GBP 10 million per annum.

The Complainant is the owner of various trademark registrations for the words Royal Edinburgh Military Tattoo including for example UK trademark number 2316442, filed on November 21, 2002 and entered in the register on August 27, 2004, and UK trademark number 2583865, filed on June 8, 2011 and entered in the register on February 3, 2012. These trademarks are referred to collectively in this decision as the "Military Tattoo Trademarks".

The Respondents use the Disputed Domain Name to link to a website which provides tickets for attendance at the Tattoo. The Respondents are not authorised by the Complainant to carry out this activity. The tickets they provide appear to be genuine tickets issued by the Complainant which will allow purchasers to attend the Tattoo. Questions as to how and where the Respondents obtain their supply of tickets from, and whether any contractual restrictions attached to the tickets might prevent them being dealt with in this manner are outside the scope of this Panel's remit.

Until December 2015 or thereabouts the Respondents' website contained no disclaimer of any sort. On November 13, 2015 the Complainant's legal representatives wrote to the Respondents complaining about their activities. At some stage after December 12, 2015, the Respondents introduced a disclaimer onto their website. It would appear that since then it has from time to time varied in size and positioning. At present the landing page of the Respondents' website contains some images and banner displays, and underneath these a body of text in the same font and size as other text on the site which commences with the wording "Customers Please Note. This is not the official Edinburgh Tattoo website. We are secondary ticket agents and therefore prices may be above or below face value."

5. Parties' Contentions

A. Complainant

The Complainant's case can be summarised as follows.

a) The Disputed Domain Name is confusingly similar to the Military Tattoo Trademarks as (i) it incorporates the main elements of the Complainant's well-known and distinctive Military Tattoo Trademarks, and (ii) the combination thereof with generic terminology — the word "tickets" — is insufficient to distinguish the Disputed Domain Name from the Complainant's trademark.

b) The Respondents do not have any rights or legitimate interests in the Disputed Domain Name.

c) The Respondents use the Disputed Domain Name in bad faith as the website to which the Disputed Domain Name resolves, make use of the Complainant's Military Tattoo Trademarks in order to sell tickets to the Complainant's event when the Respondents are not authorised to do so. They are doing so in a manner which confuses visitors to their website into thinking they are dealing with the Complainant or one of its authorised ticketing agents.

The Complainant makes a number of other detailed submissions and refers to various previous UDRP cases in support of its arguments. It is not necessary to set these out in detail. Where relevant they are discussed further below.

B. Respondents

On December 14, 2016 an email was sent from the Respondents to the Center which reads in full as follows:

"Dear Sirs,

I'm writing to you regarding the complaint of our domain name "edinburghmilitarytattootickets.com", We feel that we are not infringing on the UK trademark of the Edinburgh Tattoo as our company is not registered in the U.K.

We have also made it perfectly clear on our website that we are not the primary agent and have no association with the Edinburgh Tattoo so our visitors are aware that we are a secondary market ticket platform and not the primary agent."

Although this email does not comply with the formal requirements for a Response the Panel in its discretion will treat it as such.

6. Discussion and Findings

Preliminary Matters

As a preliminary issue the Panel notes this is a case where one of the Respondents (WhoisGuard Protected/WhoisGuard Inc.) appears to be a privacy or proxy registration service while the other Respondent (Martin Clegg, WM Holdings) appears to be the underlying (or substantive) Respondent. The Panel in this case adopts the approach of most UDRP panels, as outlined in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 4.9, as follows: "Most panels in cases involving privacy or proxy services in which such disclosure of an underlying registrant has occurred, appear to have found it appropriate to record in their issued decision both the name of the privacy or proxy registration service appearing in the Whois at the time the complaint was filed, and of any disclosed underlying registrant". Accordingly this decision refers to both Respondents. It is not in practical terms necessary to distinguish which Respondent was responsible for specific acts.

Substantive Matters

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

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

A. Identical or Confusingly Similar

The Complainant has submitted detailed evidence that it is the owner of various trademarks consisting of the words “Royal Edinburgh Military Tattoo”.

The Panel holds that the Disputed Domain Name is confusingly similar to the above trademarks. The Disputed Domain Name, as registered by the Respondents, incorporates the main elements of the Military Tattoo Trademarks, omitting only the “Royal” prefix. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy, “when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name” (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662). The only differences in the present case are the omission of the word “Royal” and the addition of the generic word “tickets”. This addition does not suffice to negate the similarity between the Disputed Domain Name and the Complainant’s Military Tattoo Trademarks. This is particularly so given that the phrase “Edinburgh Military Tattoo” is highly distinctive and has no meaning other than to refer to the Complainant and the Tattoo it promotes.

It is established that, where a mark is the distinctive part of a disputed domain name, the disputed domain name is considered to be confusingly similar to the registered mark (*DHL Operations B.V. v. DHL Packers*, WIPO Case No. D2008-1694).

The “.com” top-level domain is generally to be disregarded when considering identity between the Disputed Domain Name and the Complainant’s trademark – see for example *Herbalife International, Inc. v Herbalife.net*, WIPO Case No. D2002-0234.

Accordingly the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy non-exhaustively lists three circumstances that demonstrate a right or legitimate interest in the domain name:

- i. before any notice to you 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 (as an individual, business or other organisation) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- iii. you 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.

As the Panel understands it the Respondents’ case is that (i) applies. It says that it sells genuine tickets for the Tattoo and that its website makes clear its status as what it describes as a “secondary market ticket platform”.

On the evidence before the Panel the tickets sold by the Respondents via the website linked to the disputed domain name appear to be genuine products, legitimately acquired by the Respondent via unknown means. The question that arises is whether the Respondent can claim to have a legitimate interest in using a domain name that is confusingly similar to the Complainant’s trademark in order to sell genuine tickets for the Complainant’s events.

The Panel considers (and the Complainant in its submissions approached the case on this basis) that the starting point in addressing this question is what is known as the *Okidata* test arising from the decision in

Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903. The substance of the test is set out in paragraph 2.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition as follows (excluding cited cases):

“2.3 Can a reseller/distributor of trademarked goods or services have rights or legitimate interests in a domain name which contains such trademark?”

Consensus view: Normally, a reseller or distributor can be making a *bona fide* offering of goods and services and thus have a legitimate interest in the domain name if its use meets certain requirements. These requirements normally include the actual offering of goods and services at issue, the use of the site to sell only the trademarked goods, and the site’s accurately and prominently disclosing the registrant’s relationship with the trademark holder. The respondent must also not try to “corner the market” in domain names that reflect the trademark. Many panels subscribing to this view have also found that not only authorized but also unauthorized resellers may fall within such *Oki Data* principles. Pay-per-click (PPC) websites would not normally fall within such principles where such websites seek to take unfair advantage of the value of the trademark.

However: Some panels take the position (while subscribing to the consensus view) that it will generally be very difficult for a respondent to establish rights or legitimate interests where that respondent has no relevant trademark rights and without the authority of the complainant has used a domain name identical to the complainant’s trademark (*i.e.*, <trademark.tld>). [See further View 1 in paragraph 2.4 below regarding impersonation.]

Furthermore: A small number of panels have taken the view that, without express authority of the relevant trademark holder, a right to resell or distribute that trademark holder’s products does not create a right to use a domain name that is identical, confusingly similar, or otherwise wholly incorporates the relevant trademark.”

In the present case the Panel notes that (1) the Respondents are not authorised resellers of the Complainant’s tickets and (2) the Disputed Domain Name comprises simply the main elements of the Complainant’s Military Tattoo trademark combined with the word “tickets”. Members of the public searching for tickets to the Complainant’s event are likely to search using combinations of the words “Edinburgh”, “Military”, “Tattoo” and “Tickets” and will as a result inevitably encounter the Respondents’ website (this seems self-evident but is in any event confirmed by the Complainant’s filed evidence). Some such customers will no doubt visit the site and some of those visitors will no doubt purchase tickets. They have been attracted by the Respondents using what are in substance the main elements of the Complainant’s Military Tattoo Trademarks.

In this regard it is in the Panel’s view important to note that the *Oki Data* case was concerned with the activities of authorised distributors and resellers who, by definition, will be in a contractual relationship with the complainant and where the complainant can if it wishes regulate the respondent’s activities accordingly. So the Panel in that case observed: “If trademark owners wish to prevent the use of their marks by authorized sales and repair agents in domain names, they should negotiate such protections through appropriate contractual language or, when permitted under the relevant law, seek recovery in classic trademark infringement or dilution litigations. In the absence, however, of some element of illegitimacy, they should not use the Policy to prevent uses that ICANN deemed to be legitimate, including the use of domain names in connection with the *bona fide* offering of goods and services”. The present case concerns an unauthorized distributor where no such contractual nexus exists. As the WIPO Overview 2.0 notes, panels have extended the *Oki Data* principles to unauthorized distributors as well, but in the opinion of this Panel whether it is appropriate to do so will depend on all of the facts including the nature of the business concerned and the domain name in question.

In the case of the resale of tickets for events, if the domain name is too close to the Complainant’s trademark then it may in the Panel’s view be inappropriate to apply the *Oki Data* principles to an unauthorized reseller (for further consideration of the applicable principles see below). This is likely to be a fact specific enquiry

which depends on all the relevant facts including of course the domain name in question. For examples where previous panels have declined to apply the *Okidata* principles as such to domain names used by unauthorized resellers of tickets see:

National Collegiate Athletic Association and March Madness Athletic Association, L.L.C. v. Mark Halpern and Front & Center Entertainment, WIPO Case No. D2000-0700 <finalfour-tickets.com> et al.;

The Arsenal Football Club Public Limited Company v. Official Tickets Ltd, WIPO Case No. D2008-0842 <official-arsenal-tickets.com>;

Fédération Française de Tennis (FFT) v. Versio, VERSIO.NL Domein Registratie, WIPO Case No. D2013-2021 <frenchopen2014.com>;

Fédération Française De Tennis (FFT) v. Ticketfinders International LLC / Michael Cook, WIPO Case No. D2013-2024 <frenchopen2018.com> et al.;

Comerica Bank v. Dough Thompson, WIPO Case No. D2014-1060 <ticketscomericatheatre.com>.

For an example of where a previous Panel did apply the *Okidata* principles, see *National Association for Stock Car Auto Racing, Inc. v. Racing Connection / The Racin' Connection, Inc.*, WIPO Case No. D2007-1524 <nascartours.com>. In that case the respondent's activities extended well beyond just ticket provision.

It seems to the Panel that these cases each depend on their specific facts. In this regard the more recent case of *Eli Lilly and Company and Novartis Tiergesundheits AG v. Manny Ghuman / Mr. NYOB / Jesse Padilla*, WIPO Case No. D2016-1698, is in the opinion of the Panel helpful in assessing the approach to be adopted in assessing whether to apply the *Okidata* principles to cases involving unauthorized resellers. In that case the Panel explained its approach in the following manner:

The *Okidata* approach acknowledges certain scenarios relating to the potential legitimacy of using another's trademark in a domain name, often referred to as "nominative fair use". An overarching principle of the *Okidata* approach is that a use of a domain name cannot be "fair" if it suggests affiliation with the trademark owner; nor can a use be "fair" if it is pretextual. See *201 Folsom Option JV, L.P. and 201 Folsom Acquisition, L.P. v. John Kirkpatrick*, WIPO Case No. D2014-1359 (*Okidata* approach considers and applies nominative fair use principles with reference to the limited scope of the Policy, and specifically with respect to the respondent's use of the complainant's mark in a domain name); *Project Management Institute v. CMN.com*, WIPO Case No. D2013-2035 ("[I]t is critical to the establishment of rights or legitimate interests under *Okidata*, and to a claim of nominative fair use, that the [r]espondent take steps to avoid using of the [c]omplainant's mark in a manner likely to cause consumer confusion as to source, sponsorship, affiliation or endorsement").

Generally speaking, UDRP panels have found that domain names identical to a third-party trademark carry a high risk of such affiliation. Where the domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP jurisprudence broadly holds that this cannot constitute nominative fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. It is difficult to state with precision what qualitative aspects of such additional term would automatically suggest such impersonation, sponsorship, or endorsement. Certain geographical terms (e.g., trademark-nyc.com, or trademark.nyc), or terms with an "inherent Internet connotation" (e.g., e-trademark.com, buy-trademark.com, or trademark-online.com) would seem, by their nature, to fall within this category. At the other extreme, certain critical terms (e.g., trademarksucks.com) would in most contexts at least *prima facie* communicate that there is no affiliation. In the gray zone, certain terms within the trademark owner's field of commerce, or indicating services related to the brand while referring to the relevant mark (e.g., <okidataparts.com>, or <trademark.feedback>), may not necessarily trigger an inference of affiliation by themselves, but would normally require a further examination by the panel of the broader facts and circumstances of the case including the associated website content to assess the propriety of the use made of the domain name (e.g.,

under the *Oki Data* approach). See, e.g., *201 Folsom Option JV, L.P. and 201 Folsom Acquisition, L.P. v. John Kirkpatrick, supra*.

Although the panel's reasoning in *Eli Lilly and Company and Novartis Tiergesundheit AG v. Manny Ghumman / Mr. NYOB / Jesse Padilla, supra*, draws on principles of "nominative fair use" from the United States of America, the present Panel considers the reasoning to be of general applicability in cases where the domain name in question combines a complainant's trademark with an additional term.

In the present case the Panel is satisfied that application of the *Oki Data* principles is inappropriate because of the overarching principle that the Respondents' use is not fair, because of the manner in which it combines the principal elements of the Complainant's trademark with the entirely descriptive word "tickets". The result is that the Disputed Domain Name is confusingly similar to the Complainant's highly distinctive Military Tattoos Trademarks and is in the Panel's opinion likely to be taken as being that of the Complainant. The Disputed Domain Name is linked to a website used for the unauthorized resale of tickets to the Complainant's event. That does not in the Panel's opinion establish a legitimate interest applying the same reasoning as that of the Panel in *Eli Lilly and Company and Novartis Tiergesundheit AG v. Manny Ghumman / Mr. NYOB / Jesse Padilla, supra*.

The Panel would also observe that even if the *Oki Data* principles were applied to the present case, this would not assist the Respondents. The disclaimer introduced by the Respondents is not prominently displayed, and the wording used erroneously gives the impression that some form of agency arrangement exists. In any event the disclaimer itself was only introduced after notice of the Complainant's objection to the Respondents' activities was received so paragraph 4(c)(i) of the Policy is not applicable.

The Panel therefore finds that the Respondents have no rights or legitimate interests in the Disputed Domain Name and paragraph 4(a)(ii) of the Policy has been satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that "for the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that [the respondent has] registered or has 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 the complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the domain name; or
- (ii) that [the 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 [the respondent has] engaged in a pattern of such conduct; or
- (iii) that [the 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, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] web site or location."

In the present circumstances, the distinctive nature of the Military Tattoo Trademarks, and the evidence as to the extent of the reputation the Complainant enjoys in the Military Tattoo Trademarks, and the confusingly similar nature of the Disputed Domain Name to the Military Tattoo Trademarks, leads the Panel to conclude the registration and use was in bad faith. In the present case, the Respondent manifestly selected the

Disputed Domain Name because of its similarity to the Complainant's name and its Military Tattoo Trademarks and this was done purportedly as part of a venture to sell tickets to the Complainant's events. The Panel has no doubt the Respondent was by use of the Disputed Domain Name seeking to attract customers who were looking for the Complainant. As such its behaviour clearly amounts to that specified in paragraph 4(b)(iv) of the Policy as being evidence of registration and use in bad faith, namely "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location". As a result the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith. Accordingly the third condition of paragraph 4(a) of the Policy has been fulfilled.

Finally the Panel notes the Respondents' further arguments that they are not registered as a business in the United Kingdom and are not infringing any UK trademark. These issues do not alter the Panel's analysis and conclusions.

7. Decision

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

Nick J. Gardner

Sole Panelist

Date: January 5, 2017