Decision for dispute CAC-UDRP-100629

Case number	CAC-UDRP-100629
Time of filing	2019-03-05 08:52:30
Domain names	stickandpoketattooshop.com, stickandpoketattoo.com, handpoketattookit.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	STICK AND POKE LLC

Complainant representative

Organization	Dimov Internet Law Consulting

Respondent

Name	Hodei Etxezarreta

Respondent representative

Organization	MAESTRE ABOGADOS

OTHER LEGAL PROCEEDINGS

To the best of the Panel's knowledge, there are no other pending legal proceedings between the Parties which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant has provided evidence indicating that it is the owner of the following trademarks:

- United States Trademark Registration No. 5275629, STICK AND POKE TATTOO KIT, registered on August 27, 2017;

- European Union Trade Mark Registration No. 1406635, STICK AND POKE TATTOO KIT, registered on May 8, 2018; and

- International Registration No. 1406635, STICK AND POKE TATTOO KIT, registered on May 8, 2018.

The Respondent has provided evidence indicating that he is the owner of the following trademark:

- Spanish Trademark Registration No. 3644256, STICK AND POKE TATTOO (and design), registered on May 31, 2017.

FACTUAL BACKGROUND

The Complainant is a United States limited liability company engaged in the business of compiling and selling amateur tattoo kits online. The Complainant's products consist of tattoo ink, sterile needles, stencil paper, wipes, medical gloves and after-care balm. The Complainant markets its products under its STICK AND POKE TATTOO KIT trademark, the details of which are provided above. The Complainant is the registrant of the domain name <stickandpoketattookit.com>, registered on February 26, 2013, from which it operates an online retail website selling its tattoo kits.

The Respondent is a Spanish individual, who is also engaged in the business of compiling and selling amateur tattoo kits online. The Respondent's products contain essentially the same components as those marketed and sold by the Complainant. The Respondent markets his products under the STICK AND POKE TATTOO (and design) trademark, details of which are also provided above.

The disputed domain name <stickandpoketattoo.com> was first registered on May 23, 2010, and was purchased by the Respondent in December 2016. The Respondent initially used the disputed domain name <stickandpoketattoo.com> in connection with an online store selling his tattoo kits. From early 2018, the Respondent has used the disputed domain name <stickandpoketattoo.com> for a blog-style website with various articles and photo editorials about tattooing. The website at "www.stickandpoketattoo.com" prominently features banner advertising, which leads Internet users to the website "www.stickandpoketattooshop.com", where the Respondent's tattoo kits are offered for sale.

The disputed domain name <stickandpoketattooshop.com> was first registered on October 19, 2016, and was subsequently acquired by the Respondent in January 2018.

The disputed domain name <handpoketattookit.com> was registered by the Respondent on December 8, 2017. It resolves to a website offering the Respondent's tattoo kits for sale.

In terms of the chronology of events leading up to the present dispute, drawing upon the assertions of both Parties and the evidence put forward in the Complaint, the Response, the Complainant's unsolicited supplemental filing, and the Respondent's reply to the Complainant's unsolicited supplemental filing, the Panel has been able to discern the following:

From approximately March 2013 onwards, the Complainant has been operating a business selling amateur tattoo kits under the name "Stick and Poke Tattoo Kits".

In August 2016, the Complainant contacted the owner of the website "www.littletattoos.co", having become aware that images from the Complainant's website were being displayed on the website at "www.litttletattoos.co" without authorization from the Complainant. The website at "www.littletattoos.co" also displayed images of the Respondent's products. At that time, the Respondent appears to have been operating his website via the domain name <thestickandpoketattoo.com>, which is no longer registered to the Respondent. Subsequent to the Complainant's contact, the owner of the website "www.littletattoos.co" attempted to enter into a business relationship with the Complainant. This did not prove successful.

As noted above, the Respondent purchased the disputed domain name <stickandpoketattoo.com> in December 2016 and has provided evidence of product sales via the website previously appearing at that domain name from December 2016 onwards.

On December 20, 2016, the Complainant sent a cease-and-desist letter to the owner of the website "www.littletattoos.co", making reference to the disputed domain name <stickandpoketattoo.com> and the products offered at the website to which that disputed domain name resolved. In particular, the cease-and-desist letter made reference to the similarities of the products offered via the website "www.stickandpoketattoo.com" and those offered by the Complainant.

On December 21, 2016, the Respondent applied for the Spanish trademark STICK AND POKE TATTOO (and design).

The packaging of the products offered via the Respondent's website at "www.stickandpoketattoo.com" was subsequently altered, including a change from brown boxes, resembling the packaging of the Complainant's products, to white boxes.

On January 11, 2017, the Complainant filed an application for the United States Trademark STICK AND POKE TATTOO KIT.

On May 31, 2017, the Respondent's trademark application was granted.

On August 29, 2017, the Complainant's trademark application was granted.

In October and early November 2017, the Complainant began making trademark claims via Instagram, Amazon and Shopify regarding the Respondent's products. On November 6, 2017, the Respondent contacted the Complainant regarding the Complainant's trademark claims.

On December 8, 2017, the Respondent registered the disputed domain name <handpoketattookit.com>, and in January 2018, the Respondent purchased the disputed domain name <stickandpoketattooshop.com>.

On January 12, 2018, the Complainant sent a cease-and-desist letter to the Respondent, making specific reference to the disputed domain name <stickandpoketattoo.com> and the website "www.littletattoos.com", asserting that the Respondent had engaged in trademark infringement, and requested that the Respondent cease and desist further sales or marketing of any product infringing the Complainant's registered STICK AND POKE TATTOO KIT trademark.

On May 23, 2018, the Complainant attempted to purchase the Respondent's business for EUR 6,000. On May 28, 2018, the Respondent made a counteroffer of EUR 30,000 for the sale of his business. In subsequent communications, the Respondent declined to disclose certain information about his business when requested by the Complainant, including the business's sales figures. From that point, communications between the Parties broke down, which ultimately led to the present dispute.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

In its Complaint submission, the Complainant contends, in relevant part, as follows:

The Complainant submits that the disputed domain names are confusingly similar to a trademark in which it has rights. The Complainant asserts both common law and registered rights in the trademark SITCK AND POKE TATTOO KIT. The Complainant submits that the disputed domain names are confusingly similar to the Complainant's trademark. Specifically, the disputed domain name <stickandpoketattooshop.com> contains four of the five words making up the Complainant's trademark, simply replacing the final word "kit" with the word "shop". The disputed domain name <stickandpoketattoo.com> reproduces the same four words, simply omitting the word "kit". The disputed domain name <handpoketattookit.com> includes three of the five words making up the Complainant's mark, replacing "stick and" with the word "hand". The Complainant submits that these variations do not avoid confusion with the Complainant's trademark. The Complainant states that the generic Top-Level Domain ("gTLD") ".com" is a "generic commonly used extension."

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain names. It claims that there is no evidence, before any notice of this dispute, of the Respondent using the disputed domain names in connection with a bona fide offering of goods or services. The Complainant asserts that the Respondent unlawfully uploaded pictures of the Complainant's products on the website "www.littletattoos.co", which were removed after the Complainant sent a copyright notice to the owner of that website. The Complainant claims that advertising banners on the

website "www.littletattoos.co" displayed the Complainant's trademark, but were used to drive Internet users to the Respondent's websites. The Complainant asserts that the Respondent offered to form a business partnership with the Complainant after he had registered the disputed domain name <stickandpoketattoo.com>. When the Complainant refused, the Respondent decided to become a competitor of the Complainant. The Complainant claims that the Respondent registered the disputed domain names with the aim of benefiting from the reputation of the Complainant's trademark, and that the Respondent was aware of the Complainant's website prior to registering the disputed domain names, therefore, the Respondent's use of the disputed domain names is not bona fide. The Complainant further submits that there is no evidence that the Respondent has ever been commonly known by the disputed domain names, or that he has acquired trademark rights. Rather, since registering the disputed domain names the Respondent has benefited from the well-established trademark of the Complainant. The Complainant further argues that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names. The Complainant adds that although the Respondent owns the Spanish trademark STICK AND POKE TATTOO, the application for it was submitted some three years after the Complainant began using the unregistered trademark "Stick and Poke Tattoo Kit". In this regard, the Complainant alleges that the Respondent's trademark application was filed with the aim of frustrating any potential UDRP proceedings.

The Complainant asserts that the Respondent registered and is using the disputed domain names in bad faith. The Complainant claims the Respondent was aware of the Complainant and its website prior to registering the disputed domain names, and registered the disputed domain names in order to prevent the Complainant from reflecting its trademark in a corresponding domain name. The Complainant states that the Respondent registered the disputed domain name <stickandpoketattoo.com> in order to gain bargaining power in an attempt to become a business partner of the Complainant, and when this failed, decided to become a competitor of the Complainant. The Complainant asserts that by using the disputed domain names to sell goods which are substantially similar to those sold by the Complainant under the trademark STICK AND POKE TATTOO KIT, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his websites, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites. The Complainant further argues that the Respondent registered the disputed domain names for the purpose of selling the domain name registrations to the Complainant for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the disputed domain names, as evidenced by the Respondent's offer to sell his business for EUR 30,000. The Complainant also states that there are false statements on the Respondent's website, which further indicate the Respondent's bad faith.

RESPONDENT:

The Respondent asserts that the phrase "stick and poke tattoo" is a generic phrase used since at least the 1970s that describes a method of hand tattooing. Specifically, the Respondent states that "[a]s a definition 'stick and poke' or 'hand poke' is the same method of tattooing […]. The Tattoo process is the same as using a tattoo machine (gun), but the needle is manipulated by the hand rather than with an electric tattoo gun. Fundamentally, hand poke tattooing uses a sharp point to deposit ink pigment into one's skin to leave a permanent mark. […] Hand poke tattoos are very distinctive in their look, and many styles can be achieved with various techniques. It is often agreed that hand pokes look more natural and organic." As such, the alleged trademark STICK AND POKE TATTOO KIT is a generic and common expression in the tattoo and punk communities, the disputed domain names are not identical to the alleged trademark and they are composed of common terms, therefore the Complainant has failed establish the first element of the Policy.

The Respondent claims that he is using the disputed domain name <stickandpoketattoo.com> in connection with a blog-style website to promote professional tattoo artists who use the "stick and poke" technique. As such, the Respondent argues that he is making a legitimate noncommercial or fair use of that disputed domain name. In relation to the disputed domain names <stickandpoketattooshop.com> and <handpoketattookit.com>, the Respondent states that these domain names resolve to websites selling kits and tools related to the "stick and poke" tattoo method. The Respondent states that he has sold its products since 2016. The Respondent notes that in May 2017, he was granted a trademark for STICK AND POKE TATTOO (and design), at which time there were no registered trademarks including the term "stick and poke tattoo". The Respondent states that he develops intense activity in social networks, being active on a wide range of social-media platforms. The Respondent notes that he is located in Spain and operates primarily on the European market. Taking into account his trademark, activity on social media, and his business operations, the Respondent asserts that the relevant public

associates the disputed domain names with the Respondent and his tattoo shop. As such, the Respondent submits that he has been and is commonly known by the disputed domain names. The Respondent notes under the second element that the markets in which the Parties operate are distinct, alleging that for customs reasons, the Complainant is unable to ship its items to Spain, therefore the Parties' products cannot conflict with one another. The Respondent also states that the website "www.littletattoos.co" has "no relationship with the Respondent." For the foregoing reasons, the Respondent submits that he has rights or legitimate interests in the disputed domain names, and that the Complainant has failed to establish the second element of the Policy.

The Respondent asserts that the Complainant never contacted the Respondent. The Respondent states that the first contact between the Parties was on November 6, 2017, when the Respondent sent an email to the Complainant. The Respondent claims at that time, the Complainant engaged in a "campaign of harassment" against the Respondent by attempting to shut down the Respondent's accounts on Instagram, Shopify and Etsy. The Respondent states that, on the advice of counsel, he did not reply to the Complainant's cease-and-desist letter of January 12, 2018. The Respondent claims that in November 2018, the Complainant attempted to have the Respondent's websites shut down by making a complaint to the hosting provider, and that the Complainant made a further complaint in relation to the Respondent's Facebook page in December 2018. The Respondent asserts that he never showed any predisposition to sell the disputed domain names prior to the Complainant's expression of interest in purchasing the Respondent's business. The Respondent argues that the Complainant's offers were not genuine, but rather were attempts to build an argument in the current UDRP proceeding.

The Respondent claims that he bought the disputed domain name <stickandpoketattoo.com> because the term "stick and poke tattoo" has been widely used by enthusiasts of that method of tattooing since the 1970s, that the disputed domain name is easy to remember, and that he was able to create matching social media accounts. The Respondent asserts that he did not register the disputed domain names for the purpose of selling them to the Complainant. The Respondent acquired the disputed domain name <stickandpoketattoo.com> in December 2016 in order to use it in connection with its descriptive meaning. The Respondent notes that in 2010, the disputed domain name <stickandpoketattoo.com> was used in connection with a website selling a "stick and poke tattoo kit". The Respondent states that the disputed domain names consist of a common expression, and that they have been used to sell products that correspond to the descriptive meaning of that expression, or to give information about them. The Respondent further states that he has built his business exploiting the fashion trend and general interest in the "stick and poke" method of tattooing. He states that he has amassed a large clientele, and that he has a website and social media presence different from that of the Complainant. For the abovementioned reasons, the Respondent submits that he registered and is using the disputed domain names in good faith.

THE COMPLAINANT'S UNSOLICITED SUPPLEMENTAL FILING:

Following the submission of the Response, the Complainant submitted an unsolicited supplemental filing to present further evidence of the relationship between the owner of the website "www.littletattoos.co" and the Respondent. The Complainant argues that there is a link between the two on the basis of the following: First, the logos displayed on products advertised on the "www.littletattoos.co" website closely resemble the logo displayed on the Instagram page connected to the disputed domain name <stickandpoketattooshop.com>. Second, the registrant of the domain name <littletattoos.co> and the Respondent are both located in the province of Gipuzkoa in the Basque Country, Spain. Third, in June 2017, the website "www.littletattoos.co" displayed the Respondent's "Stick and Poke Tattoo" logo, as well as the element "DOTBYDOT", also used by the Respondent. Fourth, the Respondent applied for his STICK AND POKE TATTOO trademark one day after the Complainant contacted the owner of "www.littletattoos.co", which cannot be coincidental. Fifth, the Respondent's packaging was changed from brown to white boxes immediately after the Complainant contacted the owner of the website "www.littletattoos.co". The Complainant submits that the Respondent's awareness of the Complainant is further evidenced by the Respondent's copying of parts of an instruction manual created by the Complainant in 2014. Sixth, the Respondent used the code "LITTLETATTOOS" to sell his product called the "Stick and Poke Dot by Dot Tattoo".

In response to the Respondent's claim that the Parties operate in separate markets, the Complainant refers back to evidence of its product sales in Europe. The Complainant reiterates that the Respondent registered his trademark only after being put on notice of the Complainant's unregistered trademark rights. The Complainant argues that in light of the timing of the Respondent's trademark application, its sole purpose was to prevent a UDRP proceeding, and that the Panel should not

acknowledge the existence of the Respondent's rights. The Complainant asserts that the Respondent's underlying intent in registering the disputed domain names was to benefit from the goodwill associated with the Complainant's trademarks.

THE RESPONDENT'S REPLY TO THE COMPLAINANT'S SUPPLEMENTAL FILING:

As a preliminary matter, the Respondent opposes the admission of the Complainant's supplemental filing, noting that the identity of the registrant of the disputed domain names had been made clear to the Complainant prior to the filing of the Complaint, and that the arguments presented could have reasonably been included in the initial Complaint submission.

With regard to its relationship with the owner of the website "www.littletattoos.co", the Respondent states "the Respondent does not deny that he knows the person responsible for littletattoos.co. When the Respondent states that littletattoos.co 'has no relationship with the Respondent' he means that he does not own that web domain, has no professional link to that page and that communications which the Complainant received by email from that domain were not from the Respondent." The Respondent maintains that the first communication he had with the Complainant was in November 2017. The Respondent asserts that the Complainant has failed to demonstrate that the Respondent is the owner of the website "www.littletattoos.co" or the existence of collusion with the aim of harming the Complainant.

The Respondent states that he was aware of the Complainant's business at the time he registered the disputed domain names, but registered them for their descriptive value rather than to target the Complainant.

With regard to the alleged copying of the Complainant's instruction manual, the Respondent states that "the steps followed are the same as mentioned in hundreds of other pages as all tattooing guides must necessarily be similar", and notes that the Complainant itself appears to have copied extracts from other sources.

In terms of the markets in which the Parties operate, the Respondent asserts that tattoo ink is a restricted commodity that cannot be imported to the European Union from the United States without a health permit. The Respondent states that he can commercialize his product in Europe without any such issues and that European customers can purchase his products without needing health permits. The Respondent claims that the Complainant is endangering its customers by exporting ink from the United States to Europe, specifically to Spain.

Finally, the Respondent states that since initiating the present UDRP proceeding, the Complainant wrote to the Respondent's representative stating that it anticipated bringing an action in the Spanish courts, seeking monetary damages from the Respondent. The Respondent argues that the Complainant is not actually interested in the disputed domain names themselves, but rather wants to damage a legitimate business run legally by the Respondent for the last two and a half years.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has not, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

In light of the finding under paragraph 4(a)(ii) of the Policy, the Panel declines to opine on the third element.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

The Complainant submitted an unsolicited supplemental filing, to which the Respondent has filed a substantive reply, including a request for exclusion of the Complainant's supplemental filing from the record.

The Policy and the Rules contemplate the submission of a single complaint and a single response. Further statements may be requested by the Panel pursuant to paragraph 12 of the Rules, but there is no right of reply per se.

While there are matters in the Complainant's supplemental filing that were discoverable at the time of submission of the Complaint, the Panel finds that the Complainant's supplemental filing responds, in part, to matters raised in the Response that were not reasonably available at the time of filing the initial Complaint. Moreover, the Respondent's reply contains specific arguments relating to the assertions and evidence put forward in the Complainant's supplemental filing.

In the interests of forming the clearest picture possible of the facts in issue, as well as in the interests of fairness between the Parties, the Panel has determined to admit the Complainant's supplemental filing together with the Respondent's reply into the record. In any event, their exclusion would not have substantially altered the Panel's findings in the present case.

PRINCIPAL REASONS FOR THE DECISION

IDENTICAL OR CONFUSINGLY SIMILAR

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant is required to prove that it has rights in a trademark or service mark, and that the disputed domain names are identical or confusingly similar to the Complainant's mark.

Prior UDRP panels have consistently held that "[w]here the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case." See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.2.

The Panel finds that the Complainant has established rights in the trademark STICK AND POKE TATTOO KIT, by virtue of its trademark registrations, details of which are set out above.

The Panel notes that much of the Respondent's argument under this element focuses on the descriptive nature of the Complainant's trademark. While the descriptive nature of the Complainant's trademark may have bearing on the second and third elements, it is not determinant under the first. As noted by previous UDRP panels, "the first element test functions primarily as a standing requirement […] This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. […] While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant trademark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. […] Issues such as the strength of the complainant's mark of the respondent's intent to provide its own legitimate offering of goods or services without trading off the complainant's reputation are decided under the second and third elements." See WIPO Overview 3.0, section 1.7. Furthermore, the Panel cannot help but to detect some irony in such an argument, noting that the Respondent himself has gone to the effort of registering a trademark for STICK AND POKE TATTOO for use in connection with the sale of his tattoo kits, albeit in stylized form.

In the case of the disputed domain names <stickandpoketattoo.com> and <stickandpoketattooshop.com>, both of these disputed domain names incorporate a substantial portion of the Complainant's STICK AND POKE TATTOO KIT trademark, either omitting the word "kit" from <stickandpoketattoo.com>, or replacing the word "kit" with the word "shop" in <stickandpoketattooshop.com>. In both instances, a dominant feature of the Complainant's trademark is recognizable in the disputed domain names. In the case of the disputed domain name <handpoketattookit.com>, the Panel considers that the inclusion of the words "poke tattoo kit" are evocative of the Complainant's STICK AND POKE TATTOO KIT (noting that the disputed domain name in fact subsumes the elements "and poke tattoo kit" of the Complainant's trademark).

The gTLD ".com" is a standard registration requirement, and may be disregarded when determining identity or confusing

similarity under the first element.

For the reasons set out above, the Panel finds that the Complainant has fulfilled the requirements of paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

According to paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in the disputed domain names.

While the overall burden of proof in UDRP proceedings is on the complainant, 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 WIPO Overview 3.0, section 2.1.

As a preliminary matter, the Panel notes the Respondent's claim that the disputed domain name <stickandpoketattoo.com> is being used for a legitimate noncommercial or fair use within the meaning of paragraph 4(c)(iii) of the Policy. Both the header and the footer of the website at "www.stickandpoketattoo.com" display advertising for the Respondent's tattoo kits, which redirect Internet users to the Respondent's website at "www.stickandpoketattooshop.com". Various links embedded in the "articles" and "product reviews" sections of the Respondent's website at "www.stickandpoketattoo.com" serve to redirect Internet users to the Respondent's online store at "www.stickandpoketattooshop.com". While the Panel accepts that the Respondent's blog-style content is genuine, the systematic redirection of Internet users to the Respondent's online store grants a certain commerciality to the nature of the website at the disputed domain name <stickandpoketattoo.com> that cannot be ignored. As such, the Panel does not accept the Respondent's assertion that the disputed domain name <stickandpoketattoo.com> qualifies as a legitimate noncommercial or fair use within the meaning of the Policy.

The fundamental issues before the Panel in the present case are whether, prior to notice of the present dispute, the Respondent has made use of the disputed domain names in connection with a bona fide offering of goods or services, and whether the Respondent can be said to be commonly known by the disputed domain names, or a name corresponding to the disputed domain names.

The way in which both Parties' submissions have been presented can be described as opaque, and required consideration of unsolicited supplemental filings from both sides in order for the Panel to form a somewhat clear notion of what occurred. A summary of the Panel's understanding of the events occurring between the Parties is set out at under the factual background section above.

While certain chronological matters are disputed between the Parties, what is clear from the chain of events is that the Respondent has made a substantial investment to develop an actual business, including acquiring already-registered domain names, registering a trademark in the jurisdiction in which the Respondent resides and operates its business, amassing a substantial following on social media, engaging in product design, and developing a blog of tattoo artists and articles about the tattooing style employed by users of the Respondent's products. The Panel finds that the Respondent's business activities go beyond what may be considered to be merely pretextual in order to prevent an adverse outcome in a UDRP proceeding.

Notwithstanding the above, the Panel is not convinced that the Respondent has come forward with entirely clean hands. Notably, the Panel does not find the Respondent's assertions regarding its relationship, or lack thereof, with the owner of the website "www.littletattoos.co" to be credible. At first the Respondent disclaimed all relationship with the website owner, but he then backtracked on this statement, alleging that "the Respondent does not deny that he knows the person responsible for littletattoos.co. When the Respondent states that littletattoos.co 'has no relationship with the Respondent' he means that

he does not own that web domain, has no professional link to that page and that communications which the Complainant received by email from that domain were not from the Respondent."

The credibility of the Respondent's statements in this regard are undermined by the content of the "About Us" sections of the websites "www.smalltattoos.com", from which the online shop for the website "www.littletattoos.co" is operated, and the website at the disputed domain <handpoketattookit.com>. (For the sake of completeness, the domain names <littletattoos.co> and <smalltattoos.com> appear to be registered by the same registrant.) Notably both websites contain highly similar statements such as:

"In 2016, this site was born out of a fascination for the 'stick and poke' tattoo technique, and a love for creativity and individuality" (<handpoketattookit.com>)

"Small Tattoos was born between two close friends out of a fascination with little tattoos, and a love for creativity and individuality" (<smalltattoos.com>)

"With high hopes of what was to come, we got an office the size of a shoe box in sunny Spain. And guess what? We offer FREE shipping in all our kits. […] Who doesn't LOVE free shipping?" (<handpoketattookit.com>)

"With high hopes of what was to come, we got an office the size of a shoe box in sunny Spain. And guess what? We offer FREE SHIPPING WORLDWIDE in orders over 10$. Who doesn't LOVE free shipping?" (<smalltattoos.com>)

Furthermore, the fact that the Complainant may have copied extracts of third-party texts in preparing its instruction manual does not excuse the Respondent from what appears to be a clear attempt to reproduce substantial parts of the Complainant's instruction manual in his own instruction materials without the Complainant's permission to do so.

Nevertheless, the above does not serve to escape the fact that the Respondent had commenced his business activities substantially prior to when the Complainant had taken active steps to formally protect its intellectual property rights. Moreover, the Panel finds that the Respondent's registration of a trademark reflecting his products that are clearly marketed via the disputed domain names goes beyond a mere attempt to frustrate any potential UDRP proceedings.

Ultimately, the case boils down to whether the Respondent's offering of goods or services can be said to be bona fide. On the one hand, the Respondent asserts that the denomination "stick and poke" is descriptive of the products which he markets. On the other, the Respondent acknowledges his awareness of the Complainant at the time he created his business and commenced trading. The exact extent to which the Complainant can be said to have had unregistered trademark rights in "stick and poke tattoo kit" in 2016 is questionable, given the apparent descriptive nature of the mark – something which is acknowledged on the Complainant's United States trademark registration certificate, which includes a disclaimer for the term "tattoo kit". As noted in WIPO Overview 3.0, section 1.3 "[i]n cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning." While the Panel notes that the trademark does have some descriptive value, given the highly specific niche market in which the Complainant and the Respondent operate, the Panel accepts that the denomination "stick and poke" may have gained some secondary meaning as being associated with the Complainant's amateur tattoo kits.

Having carefully weighed the evidence on record, the Panel finds that the Complainant has failed, on the balance of probabilities, to prove that the Respondent has no rights or legitimate interests in the disputed domain names. This finding should by no means be interpreted as a positive finding that the Respondent does in fact have rights or legitimate interests in the disputed domain names, but merely that the Panel is unable to conclude the contrary under paragraph 4(a)(ii) of the Policy.

In its analysis under this element, the Panel has come to the conclusion that the dispute between the Parties goes well beyond the disputed domain names themselves, and that it would not end with the transfer of the disputed domain names to the Complainant. As noted in the Final Report of the First WIPO Internet Domain Name Process of April 30, 1999, the UDRP

was intended to provide a time- and cost-efficient means of resolving clear cases of abusive domain name registration. The present case raises complex issues of competing trademark rights and unfair competition. The Panel is of the view that the Parties' dispute would be more suitably resolved in a court of competent jurisdiction, which would be better equipped through the benefit of discovery, interrogatories and witness testimony to determine the present dispute. For the foregoing reasons, the Panel finds that the present dispute is not appropriately determined under the Policy, and the Complaint is therefore denied. The Panel's findings in the present proceeding are without prejudice to the outcome of any future court proceedings between the Parties.

REGISTRATION AND USE IN BAD FAITH

In light of the findings under the second element, the Panel declines to opine on the third element.

REVERSE DOMAIN NAME HIJACKING

The Panel notes the Respondent's assertions that the Complainant has engaged in Reverse Domain Name Hijacking, which is defined in the Rules as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name."

While the Panel has some reservations about the lack of clarity in both Parties' submissions, the Panel considers that there is a genuine dispute between the Parties, albeit one that goes well beyond the scope of the Policy itself. Having carefully considered the Complainant's case, the Panel finds that the filing of the present Complaint was not in bad faith, and that the Complainant has not engaged in Reverse Domain Name Hijacking.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **STICKANDPOKETATTOOSHOP.COM**: Remaining with the Respondent
2. **STICKANDPOKETATTOO.COM**: Remaining with the Respondent
3. **HANDPOKETATTOOKIT.COM**: Remaining with the Respondent

PANELLISTS

Name	**Jane Seager, Marie-Emmanuelle Haas, Avocat, Douglas M. Isenberg**

DATE OF PANEL DECISION 2019-05-31

Publish the Decision