

DISPUTE RESOLUTION SERVICE**D00022077****Decision of Independent Expert**

Untuckit LLC

and

PrenticeSystems LLC

1. The Parties

Complainant: Untuckit LLC
110 Greene Street, Suite 400
New York, New York 10012
United States

Respondent: PrenticeSystems LLC
PO Box 82841
Tampa, Florida 33682
United States

2. The Domain Name

<untuckit.co.uk>

3. Procedural History

The Complaint was filed with Nominet on 18 November 2019. Nominet validated the Complaint on 19 November 2019 and notified the Respondent by post and by email the same day, stating that the due date for submission of a Response was 10 December 2019.

The Response was filed on 10 December 2019, which was notified to the Parties the same day. Nominet notified the Complainant that a Reply had to be received on or before 17 December 2019. The Complainant submitted a Reply on 17 December 2019.

The Informal Mediation procedure started on 20 December 2019 and failed to produce an acceptable solution for the Parties and so on 17 January 2020 Nominet informed the Complainant that it had until 31 January 2020 to pay the fee for the decision of an Expert

pursuant to paragraph 13 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 28 January 2020 the Complainant paid Nominet the required fee.

On 3 February 2020 the undersigned, David Taylor ("the Expert"), confirmed to Nominet that he was independent of each of the Parties and that, to the best of his knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed which might be of such nature as to call in to question his independence in the eyes of one or both of the Parties.

4. Factual Background

The Complainant, Untuckit LLC, is a limited company based in New York, United States. The Complainant designs, manufactures and sells men's and women's clothing both online and via physical retail stores.

For use in connection with its clothing-retail business, the Complainant owns trademark registrations for UNTUCKIT in various jurisdictions throughout the world, including the following:

- United Kingdom Trademark Registration No. UK0003145303, UNTUCKIT, registered on 10 June 2016;
- United States Trademark Registration No. 4062979, UNTUCKIT, registered on 29 November 2011;
- International Registration No. 1317431, UNUCKIT (figurative), registered on 21 July 2016, designating Australia, China, Colombia, the European Union, Israel, Japan, Mexico, and Singapore.

In addition the above, the Complainant has registered various domain names comprising its UNTUCKIT trademark, including <untuckit.com>, from which it operates its primary commercial website.

The disputed domain name <untuckit.co.uk> was registered on 5 June 2017. The disputed domain name does not appear to have been used in connection with an active website.

Prior to filing the Complaint, the Complainant attempted to contact the Respondent via the registrar with which the disputed domain name was registered in an effort to purchase the disputed domain name. The Respondent initially responded with an offer to sell the disputed domain name for USD 400,000, which was subsequently lowered to USD 200,000.

5. Parties' Contentions

Complaint

Complainant's Rights

The Complainant asserts rights in UNTUCKIT by virtue of its registered trademark rights, the details of which are provided in the factual background section above.

The Complainant further states that it has registered the domain names <untuckit.com> and <untuckit.ca> and that it has sold shirts under its UNTUCKIT mark since 2011.

The Complainant asserts that since 2011, its online and in-store gross sales have exceeded USD 300 million. According to the Complainant, those sales include sales to customers in the United Kingdom through the website "www.untuckit.com", and that these gross sales in the United Kingdom have exceeded USD 100,000. The Complainant states that its company received media attention and its UNTUCKIT mark is well-known by customers.

The Complainant submits that the disputed domain name is identical to the Complainant's UNTUCKIT trademark.

Abusive Registration

As noted above, in August 2019, the Complainant sought to purchase the disputed domain name from the Respondent. The Complainant submits evidence indicating that the Respondent initially offered to sell the disputed domain name for USD 400,000, and subsequently reduced its asking price to USD 200,000.

The Complainant asserts that in light of the distinctive and well-known nature of the UNTUCKIT trademark, it may be inferred that the Respondent was aware of the Complainant's rights in the mark at the time it registered the disputed domain name, by which time the Complainant had acquired several trademark registrations for UNTUCKIT, and had acquired significant reputation in the markets in which it operates.

In light of the above, the Complainant submits that the Respondent registered the disputed domain name for the purpose of selling it to the Complainant for consideration in excess of the Respondent's costs.

The Complainant further asserts that the Respondent has registered the disputed domain name for the purposes of taking advantage of or unfairly disrupting the business of the Complainant.

The Complainant claims that the disputed domain name, being identical to the Complainant's trademark, is likely to confuse people into believing the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainant. The Complainant submits that the disputed domain name is an exact match for the UNTUCKIT mark in which it has rights and that the Respondent has no reasonable justification for having registered the disputed domain name.

The Complainant notes finally that the Respondent has not used the disputed domain name since its registration in 2017.

Response

The Respondent argues that the disputed domain name is not an abusive registration.

First, the Respondent underlines that the disputed domain name could not have been registered for the purposes of selling it to the Complainant for consideration in excess of purchase cost because the disputed domain name is not for sale and has never been listed for sale. The Respondent states that the Complainant failed to provide any evidence to prove that the disputed domain name was registered for the purpose of selling it to the Complainant.

Secondly, the Respondent states that it responded to a solicitation request for the sale of the disputed domain name with the outrageously high figure of USD 200,000 in order to discourage any further solicitation requests.

Thirdly, the Respondent believes that it could not have been aware of any rights to the UNTUCKIT mark because it is not customary for one to search for rights to marks when purchasing domain names; and, the Respondent resides in a country other than those in which rights to the mark UNTUCKIT were granted.

Finally, the Respondent concludes that it is and always has been its intent to use the disputed domain name for a "telecommunications related fanatic group to discuss telecommunications cabling." The Respondent provided two images of telecommunications cabling as evidence in support of this assertion.

Reply

In its reply, the Complainant asserts that the Response fails to address the overwhelming evidence that the disputed domain name is an abusive registration for the following reasons:

The Respondent initially offered to sell the disputed domain name for USD 400,000 and after further discussions, the Respondent reduced the asking price to USD 200,000. The Complainant argues that the Respondent's conduct is consistent with someone who wishes to engage in negotiation – if the Respondent truly did not wish to sell the disputed domain name, it could have simply replied stating that it was not for sale. The Complainant also underlines that the disputed domain name is identical to Complainant's well-known mark, and the Respondent has made no use of the disputed domain name.

Moreover, the Complainant submits that the Respondent has engaged in a pattern of registering domain names comprising well-known names and trademarks, which is evidence of an abusive registration. The Complainant's research revealed that the Respondent has registered other domain names that include the names of well-known companies such as O'Reilly Auto Parts (<oreillyauto.co.uk> and <oreillyauto.mobi>), and No Wait, which provides technology solutions for restaurants to manage diner waitlists (<nowait.info> and <nowait.mobi>), as well as multiple domain names in connection with the University of South Florida football team, the South Florida Bulls (<bullstrong.co.uk>, <bullstrong.info>, <bullsunite.info>, <gobulls.co.uk>, <gousfbulls.info>, and <gousfbulls.org>).

The Complainant points out that even if the Respondent did not conduct a search for trademarks, by 5 June 2017, the date of the registration of the disputed domain name, UNTUCKIT had become a well-known brand.

The Complainant notes that the Respondent's claim that it "resides in a country other than the ones in which the rights to the mark UNTUCKIT was granted [sic]" is plainly false. The Complainant points out that it has been operating in the United States – the country in which the Respondent appears to be based – for several years. In addition, the Complainant owns federally registered United States trademarks, in addition to its trademark registrations in various other jurisdictions.

Finally, the Complainant submits that the Respondent has not provided any evidence that it has made demonstrable preparations to use the disputed domain name in connection with a genuine offering of goods or services. The Complainant states that even if the images somehow provided evidence of Respondent's intention to create a "telecommunications

related fanatic group” website (which the Complainant does not accept), the images provided by the Respondent post-date the filing of the Complaint, and therefore provide no evidence that the Respondent prepared to use the Domain Name.

6. Discussions and Findings

General

Under paragraph 2.1 of the Policy, for the Expert to order transfer of the disputed domain name, the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

- "1. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
2. The Domain Name, in the hands of the Respondent, is an Abusive Registration."

Complainant's Rights

The Policy defines Rights as "rights enforceable by the Complainant, whether under English law or otherwise."

The Expert is satisfied, based on the evidence presented, that the Complainant has established Rights in the trademark UNTUCKIT, by virtue of its registration and international use of said mark, the details of which are provided above.

The disputed domain name comprises the Complainant's UNTUCKIT trademark in its entirety without alteration, under the country code domain name extension ".co.uk". It is well established that the ".co.uk" suffix may be disregarded for the purposes of comparison under paragraph 2.1.1 of the Policy. Accordingly, the Expert finds that the Complainant has Rights in respect of a name which is identical to the disputed domain name.

The Complainant has satisfied the requirements of paragraph 2.1.1 of the Policy.

Abusive Registration

Paragraph 1 of the Policy defines "Abusive Registration" as a domain name which either:

- "i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- ii. has been used in a manner, which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

As far as paragraph 1.1 of the Policy is concerned, in order to assess whether the disputed domain name was registered or otherwise acquired in a manner which, at the time of registration, took unfair advantage of or was unfairly detrimental to the Complainant's Rights, it is necessary to determine whether the Respondent was aware of the existence of the

Complainant and its Rights at that time and, furthermore, with the aim of taking advantage of such Rights (see DRS 4331 (<verbatim.co.uk>)).

The Complainant has provided evidence of its widespread use of its trademark and the reputation that it has acquired as a result. Notably, the Complainant has provided a statement indicating that since 2011, its gross sales have exceeded USD 300 million. The Complainant has received coverage in international publications, and operates some 75 physical stores in the United States, including several in the State of Florida, where the Respondent is apparently located.

Contrary to the Respondent's assertions, the Complainant has provided evidence of having duly registered trademarks in the United States, where the Respondent appears to be located.

The Expert notes that the Respondent has denied knowledge of the Complainant and its Rights at the time of registration of the disputed domain name.

The Respondent justified its choice of the disputed domain name by its intent to use it for a "telecommunications related fanatic group to discuss telecommunications cabling". As supporting evidence, the Respondent submitted two photos of undefined cables. The Respondent did not present any proof whatsoever of the existence of such discussion group or of the perceived connection between the name "untuckit" and telecommunications cabling.

The Expert is of the view that the Respondent's registration of the disputed domain name identically reproducing the Complainant's trademark cannot be purely coincidental. Rather, the Expert infers that the Respondent was aware of the Complainant and its respective rights at the time of registration.

The Expert further finds the Respondent's explanation for registering the disputed domain name to be wholly unsupported in evidence and without merit. The Respondent has provided no evidence of any such "discussion board", and the photos submitted by the Respondent have little probative value, if any. In fact, the disputed domain name does not appear to have been used in connection with an active website since its registration in 2017. The Expert is not aware of any descriptive meaning that could be ascribed to the disputed domain name that might support the Respondent's purported future use of the disputed domain name. Indeed, it is difficult to conceive of any reason why the United States-based Respondent would proceed to register a domain name identical to the Complainant's trademark under the country code extension for the United Kingdom, other than to take advantage of the goodwill associated with the Complainant's mark.

Paragraph 5.1.6 of the Policy states that the following may be evidence of an "Abusive Registration":

"5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name."

In light of the above, the Expert finds that the disputed domain name in the hands of the Respondent is an Abusive Registration as contemplated by paragraph 5.1.6 of the Policy.

Furthermore, paragraph 5.1.1 of the Policy provides that the following may be evidence of an "Abusive Registration":

"5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name."

The Complainant has submitted evidence that when approached by the Complainant, the Respondent requested USD 400,000 in exchange for the disputed domain name. The Respondent later reduced its asking price to USD 200,000. The Respondent claimed that it proposed the sum of USD 200,000 in order to discourage any further solicitation requests.

The Expert does not find the Respondent's explanation to be credible, and accepts the Complainant's assertions that the Respondent's behaviour is consistent with someone who wishes to engage in negotiation, and that if the Respondent truly did not wish to sell the disputed domain name, that the Respondent's representative could have simply replied that the disputed domain name was not for sale.

The Expert is therefore of the view that the Respondent's registration of the disputed domain name constitutes an Abusive Registration within the meaning of paragraph 5.1.1.1 of the Policy.

The Expert therefore finds that the disputed domain name was registered in a manner which takes unfair advantage of, and is unfairly detrimental to, the Complainant's Rights, in accordance with paragraph 1.1 of the Policy.

For the sake of completeness, the Expert finds that none of the other circumstances as contemplated by paragraph 8 of the Policy which may be evidence that the disputed domain name is not an Abusive Registration applies in the circumstances of the present case.

For reasons set out above, the Expert finds that Complainant has also satisfied the requirements of paragraph 2.1.2 of the Policy.

7. Decision

The Expert finds that the Complainant has Rights in a name which is identical to the disputed domain name, and that the disputed domain name, in the hands of the Respondent, is an Abusive Registration. The disputed domain name should therefore be transferred to the Complainant.

David Taylor
24 February 2020