

## ADMINISTRATIVE PANEL DECISION

Titmouse, Inc. v. Paul Blank  
Case No. D2022-2208

### 1. The Parties

The Complainant is Titmouse, Inc., United States of America (“United States”), represented by Mandour & Associates, United States.

The Respondent is Paul Blank, United States, self-represented.

### 2. The Domain Name and Registrar

The disputed domain name <titmouse.com> (the “Domain Name”) is registered with eNom, LLC (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 16, 2022. On June 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 17, 2022, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 22, 2022, 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 June 25, 2022.

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 June 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 17, 2022. The Response was filed with the Center on July 17, 2022.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on July 26, 2022. 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 corporation established under the law of the State of Delaware in March 2000 and listing a principal place of business in Burbank, California, United States. The Complaint offers little information concerning the Complainant's business or reputation. However, the Complainant operates a website at "www.titmouse.net", which indicates that the Complainant is an "independent award-winning animation production company" with more than 700 employees working at studios in Los Angeles, New York City, and Vancouver, Canada. The Complainant has produced animation for popular television series, films, video games, and music videos, as well as commercial advertising and virtual reality productions. The Wikipedia and IMDB articles on the Complainant include citations to many published media articles referring to the Complainant and its work dating from the early 2000s to the present.

The Complainant holds the following TITMOUSE-formative United States trademark registrations:

MARK	REGISTRATION NUMBER	REGISTRATION DATE
TITMOUSE (word)	2727107	June 17, 2003
TITMOUSE (word)	3492354	August 26, 2008
TITMOUSE, INC. (word and design)	4624689	October 21, 2014

The Complainant claims first use in commerce for the word marks in April 1992. This must have been by a predecessor in interest, as the online database of the Delaware Secretary of State shows that the Complainant was formed in March 2000.

The Registrar reports that the Domain Name was created on March 6, 1998, and is registered to the Respondent Paul Blank, listing no organization and showing a postal address in the State of New Jersey, United States. The Respondent registered with a contact email in the domain <digitaldecade.com>, which is associated with a single-page website advertising network consulting services in the New York-New Jersey metropolitan area. As indicated in the Response, the Respondent is an individual residing in New Jersey who is the original registrant of the Domain Name.

The Domain Name resolves to a landing page with pay-per-click ("PPC") third-party advertising links for a variety of goods and services. The Panel notes that this is also true for other screenshots available through the Internet Archive's Wayback Machine. It appears that the Domain Name has only been parked for PPC advertising (when it did not simply produce an error message), and there is no record that the Respondent has ever developed a corresponding website.

The Complaint recites the following account of the Complainant's attempts to purchase the Domain Name from the Respondent. (The account is not supported by a sworn declaration or documentary evidence such as correspondence or emails.)

"Complainant and Mr. Blank entered into verbal discussions (through attorney for Respondent, Mr. David Scott, Esq.) for Complainant to purchase the domain, Titmouse.com.

Mr. Scott verbally communicated to Complainant that Respondent would sell the domain, Titmouse.com, to Complainant for \$3,000.00-\$5,000.00, stating that this amount was 'in the ballpark.'

Mr. Scott later offered to sell the domain to Complainant for the inflated cost of \$50,000.00 in June, 2008, far in excess of the value of the domain name, Respondent's investment in the domain name, and Respondent's original offer of \$3,000.00-\$5,000.00.

On information and belief, Complainant has not been able to communicate further with Respondent but it is Complainant's belief that the domain has not changed hands, and Respondent is the same person that purchased the domain, attempted to negotiate with Complainant for the sale of the domain, and continues to retain the domain.

Complainant has established a watch service through GoDaddy.com in an attempt to re-claim the domain, Titmouse.com, since 2003."

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant asserts that the Domain Name is "identical in sight, sound and meaning to Complainant's trademark".

The Complainant recounts its unsuccessful efforts to purchase the Domain Name from the Respondent and the Respondent's failure to anything with the Domain Name other than parking it for PPC advertising. The Complainant alleges, "[o]n information and belief, Respondent traffics in domain names for which he has no intent to make actual use."

The Complainant's arguments for bad faith are as follows:

"On information and belief, the domain name was registered in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, and that the Respondent has engaged in a pattern of such conduct.

On information and belief, the Respondent 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 web site or location or of a product or service on the Respondent's web site or location as shown in Annex 5 [screenshot of the PPC landing page].

Complainant has lost business as a direct result of prospective clients' confusion and inability to locate the Complainant's website as a result of Respondent's landing page, located at [www.titmouse.com](http://www.titmouse.com)."

### **B. Respondent**

The Respondent observes that "titmouse" is a dictionary word referring to a species of bird. The Respondent claims a legitimate interest in a domain name based on a dictionary word and denies any bad faith intent in registering and using the Domain Name. He observes that he registered the Domain Name in 1998 before the Complainant was founded in 2000 and before it registered a trademark in 2003.

"I believe that one cannot infringe upon a trademark that did not exist when first registering a domain name, especially when I, as registrant, had no knowledge of another entity's intention to register a trademark with a similar name, or was using a similar name in trade. I can swear/attest to this fact: I had no prior knowledge of such use." ...

"When I first registered the domain name in 1998, 24 years ago, I had an intended use for the name and still do.

One intended use is for a computer mouse, and the other is for a line of coffee products.

Note: Complainant claims that they attempted to negotiate a transfer of the name in June 2008. I have heard nothing substantive from them since. This is over 14 years ago. My mailing address, phone number, and email address has not changed in that time ...”

## 6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in respect of the domain name; and (iii) the domain name has been registered and is being used in bad faith. Under paragraph 15(a) of the Rules, “[a] Panel shall decide a 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”.

### A. Identical or Confusingly Similar

The first element of a UDRP complaint “functions primarily as a standing requirement” and entails “a reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7.

The Domain Name incorporates the Complainant’s registered TITMOUSE mark in its entirety. (As usual, the Top-Level Domain “.com” is disregarded as a standard registration requirement. See *id.* section 1.11.1.)

The timing of the Complainant’s acquisition of trademark rights is immaterial for this element of the Complaint.

The Panel finds, therefore, that the Domain Name is identical to the Complainant’s TITMOUSE mark and concludes that the Complainant has established the first element of the Complaint.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

(i) before any notice to it of the dispute, the respondent’s 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) that the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is 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.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

The Complainant has established trademark rights, a lack of permissive use, and the Respondent's failure to use the Domain Name for anything but PPC advertising, which in this case is not focused on uses relevant to the dictionary sense of the Domain Name (see [WIPO Overview 3.0](#), sections 2.9 and 2.10 on parking pages and legitimate uses of dictionary words). Thus, the Complainant has made a *prima facie* case, and the burden of production shifts to the Respondent. The Respondent has asserted legitimate interests in developing an associated website but has demonstrated no preparations to do so, despite holding the Domain Name for some 24 years; the Panel would be inclined to conclude, therefore, that the Complainant prevails on the second element of the Complaint; this is not necessary however given the finding below.

### **C. Registered and Used in Bad Faith**

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that "shall be evidence of the registration and use of a domain name in bad faith", including the following to which the Complainant alludes (in which "you" refers to the registrant of the domain name):

"(i) circumstances indicating that you have registered or you have 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 complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or ...

(iv) 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."

These examples do not apply in this case because there must be a showing of bad faith both in the registration and use of the Domain Name. As the Respondent observes, the Complainant did not exist when the Respondent registered the Domain Name in 1998, and there is no evidence that the Respondent had prior knowledge of the subsequent trademark. The Complainant claims earlier "first commercial use" but does not specify by whom and offers no proof substantiating an earlier common law mark (see [WIPO Overview 3.0](#), section 1.3 on what is required to prove an unregistered mark), much less evidence demonstrating the probability that the Respondent was aware of this common law mark. On this record, then, there can be no finding of bad faith in the Respondent's registration of the Domain Name.

The Panel concludes that the Complainant has failed to establish the third element of the Complaint.

### **7. Decision**

For the foregoing reasons, the Complaint is denied.

### **8. Reverse Domain Name Hijacking**

Paragraph 15(e) of the UDRP Rules provides that, if "after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking ('RDNH') or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding".

The self-represented Respondent did not request a finding of RDNH, but the Panel considers it appropriate to do so.

Reverse Domain Name Hijacking is defined under the UDRP Rules as “using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name”. Mere lack of success of a complaint is not sufficient to find RDNH. See [WIPO Overview 3.0](#), section 4.16. A finding of RDNH is warranted, however, when a panel finds that the complainant (especially one represented by counsel) should have recognized that it could not succeed on one of the three elements of the complaint under any fair interpretation of the available facts or brings a complaint based “on only the barest of allegations without any supporting evidence” (*id.*).

This is such a case. The Complaint entirely ignores the glaring difficulty that the Complainant must show bad faith in the registration of the Domain Name, which in this case preceded the existence of the Complainant itself as well as its registered marks. This issue is clearly addressed in [WIPO Overview 3.0](#), section 3.8: “where a respondent registers a domain name before the complainant’s trademark rights accrue, panels will not normally find bad faith on the part of the respondent”.

There are specific cases where a complainant can demonstrate that a respondent anticipated the trademark registration; some of these could arise in circumstances where the mark had already acquired distinctiveness in common law while owned by a predecessor in interest. The Complainant offered no evidence of this, however. Instead, the Complainant made conclusory assertions “on information and belief” that the Respondent registered the Domain Name in bad faith, to demand an exorbitant purchase price from the (subsequent) trademark holder, prevent it from acquiring a corresponding domain name, or misdirect Internet users for commercial gain. A UDRP complaint is not notice pleading “on information and belief” that serves as a prelude to discovery and trial. The parties have a single opportunity to present evidence and argument, and in this instance the Complainant singularly failed to do so.

The Panel finds that the Complaint represents an attempt at Reverse Domain Name Hijacking as defined in Rule 15(e).

*/W. Scott Blackmer/*  
**W. Scott Blackmer**  
Sole Panelist  
Date: August 9, 2022