

ADMINISTRATIVE PANEL DECISION

Luma Institute, LLC v. Perfect Privacy, LLC / James Redfern/Luma
Case No. D2021-3129

1. The Parties

The Complainant is Luma Institute, LLC, United States of America (“United States”), represented by GTC Law Group LLP & Affiliates, United States.

The Respondent is Perfect Privacy, LLC, United States, / James Redfern/Luma, United States, represented by John Berryhill, Ph.d., Esq., United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 22, 2021. On September 23, 2021, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 24, 2021, 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 September 27, 2021, 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 October 1, 2021.

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 October 8, 2021. In accordance with the Rules, paragraph 5, the due date for Response was October 28, 2021. The Parties filed a joint request for suspending the proceeding on October 28, 2021. The Center suspended the proceeding for settlement discussions on

November 1, 2021. The proceeding was reinstated and the Response was filed with the Center November 21, 2021.

The Complainant submitted an unsolicited supplemental filing on December 3, 2021.

The Center appointed W. Scott Blackmer, Christopher S. Gibson, and Richard G. Lyon as panelists in this matter on December 13, 2021. The Panel finds that it was properly constituted. Each member of 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 limited liability company established under the law of the Commonwealth of Pennsylvania, United States and headquartered in Pittsburgh, Pennsylvania. Since 2009, the Complainant has been offering “design thinking training, workshops, tools, and services” under its LUMA mark. The Complainant operates a website at “www.luma-institute.com” (the “Complainant’s website”), a domain name that it registered in February 2009. The record includes documentation concerning the Complainant’s presentation at the annual conference of the American Society for Training and Development (“ASTD”) in May-June 2009 and a screenshot of the Complainant’s website from November 2009. The Complainant uses its LUMA mark for training and consulting services as advertised online and at conferences and also for “software as a service (SAAS) services featuring a software platform for use in job training and learning about innovation through human-centered product design, development, research, and marketing”. The record includes citations to congressional testimony in 2012 mentioning LUMA and the January-February 2014 edition of the Harvard Business Review, also mentioning LUMA.

The Complainant holds United States Trademark Registration Number 5402594 (registered February 13, 2018) for LUMA as a standard character mark.

The Registrar’s Whois database shows that the Domain Name was created on August 6, 1995. The Domain Name was most recently registered in the name of the Respondent domain privacy service. After receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent “James Redfern/Luma”. The Parties do not dispute that (a) the Respondent Mr. Redfern originally registered the Domain Name in 1995, (b) Mr. Redfern is currently the registrant of record, and (c) although “Luma” is listed as the registrant organization, there is not currently a relevant legal entity with an interest in the Domain Name. Hence, the Panel refers hereafter to Mr. Redfern as the “Respondent”.

At the time of this Decision, the Domain Name resolves to a landing page headed with the Domain Name and the Registrar’s logo, and the message, “This Page Is under Construction – Coming Soon!” The bulk of the page displays a list of “Related Links”, which appear to be pay-per-click (“PPC”) links to third-party advertisers for a variety of products and services.

The Response outlines the 26-year history of the Domain Name through the Declaration of the Respondent Mr. Redfern and supporting documents. Mr. Redfern and Professor William Cook, with other computer industry colleagues, formed Luma, Inc. in June 1995, with Professor Cook as the principal officer. Domain Names were new for small enterprises on the commercial Internet at that time, but Mr. Redfern thought it might be useful for the company to have one. According to his Declaration, Mr. Redfern registered the Domain Name and “maintained ownership of the Luma.com domain name in his account, and effectively licensed it for use by Luma Inc. as the organization he chose to be associated with in the registration data.” Months later, Mr. Redfern and the other principals changed the name of Luma, Inc. to “Net-it Software Corporation”, but Mr. Redfern maintained the Domain Name. In 1998, the company changed to “Allegis Corporation”, which adopted <allegis.com> as its principal domain name. According to the Redfern Declaration, “[t]he Respondent discontinued use of the obsoleted luma.com for company purposes, and the name remained where it had always been - with Mr. Redfern personally.” The record includes copies of emails to the Registrar from Mr. Redfern’s personal email address updating the Domain Name registration

over the years, in 2006, 2007, 2010.

“After 2006,” the Declaration continues, “Mr. Redfern continued to use the luma.com domain name for email purposes and has engaged in a mix of contract consulting and employment engagements, eventually formalizing his business name as ‘Luma Exact’, a California corporation, as the contracting vehicle for consulting agreements in 2014 (Exhibit H), appointing his wife, Regina Fagan as the administrator thereof.” The record includes a copy of the 2015 federal tax return for the Luma Exact company, showing revenues exceeding USD 162,000. Since that business lapsed, the Declaration recounts, Mr. Redfern has “continued to refer to his business as ‘Luma’ and to use the domain name luma.com for communicating with clients among other purposes.”

5. Parties’ Contentions

A. Complainant

The Complainant claims common law rights and registered trademark rights in the mark LUMA. The Complainant asserts that the Domain Name is identical to that mark.

The Complaint attaches a DomainTools search of historical Whois records, which show that the registration details for the Domain Name have changed since 1995, naming the registrant organization variously as “Luma,” “Luma, Inc.,” and “Luma Exact”, before the change of registrant to a domain privacy service in November 2016. The Complainant argues that this last date should be considered as the date of registration for this Policy proceeding.

The Complainant states that the Respondent has no permission to use the Complainant’s mark and otherwise lacks rights or legitimate interests in the Domain Name. The Complainant observes that the Respondent claims authorization to register the Domain Name on behalf of Luma Exact, a company formed in November 2014 and now suspended, but changed the registration to a domain privacy service in November 2016. By this time, the Complainant claims acquired distinctiveness in LUMA as a common law mark. The Complainant contends that there is no evidence that the Respondent has used the Domain Name other than for PPC advertising links, which the Complainant contends is not a *bona fide* commercial offering. There is also no evidence that the Respondent is commonly known as “Luma”.

The Complainant accuses the Respondent of bad faith, contending that the Respondent registered the Domain Name after the Complainant’s mark was established and employed a domain privacy service “to make it difficult for Complainant to enforce its trademark rights”. The Respondent then used the Domain Name over the next five years for nothing more than error messages and, currently, PPC advertising, reflecting bad faith in the form of “passive holding” and the misdirection of Internet users for commercial gain.

In its supplemental filing, the Complainant argues that the Respondent may have “*thought* the domain was his personal property and acted accordingly, eventually changing/transferring the registrant of the domain in 2010 from Luma, Inc. to ‘Luma’ and again in 2014 to Luma Exact, a corporation in which Regina Fagan, who Respondent identified as his wife, was the CEO”, but Mr. Redfern only acted on behalf of the corporations he worked for. The Complainant argues that the Domain Name was likely an asset that remained with the merged company when Luma, Inc. (which later became Net-It Software Corporation and then Allegis Corporation) was acquired by Click Commerce, Inc. in 2003. Thus, the Complainant argues that the Respondent could not have transferred the Domain Name “in good faith” to “Luma” in 2010 or to “Luma Exact” in 2014 or to a domain privacy service in 2016, because the Respondent did not have the right to control the Domain Name. The Complainant’s conclusion is that “the domain must therefore be transferred to Complainant.”

B. Respondent

The Respondent contends that Mr. Redfern has since 1995 registered and maintained the Domain Name in

his “personal account,” using it or allowing it to be used intermittently for the various businesses in which he has been involved. The Domain Name has continued to remain with Mr. Redfern, “who has also maintained ‘Luma’ as the organization name under which it was originally registered and under which name Mr. Redfern has continued to conduct business either as a d/b/a or as ‘Luma Exact’”.

The Response observes that Mr. Redfern has never allowed the registration to lapse, through all the changes in business and formalities, over more than 26 years, because he likes the name. It was the name of one of his first business enterprises and a later enterprise with his wife, both genuine commercial ventures launched before this dispute. Moreover, the Domain Name has intrinsic value as a short, pronounceable generic Top-Level Domain (“gTLD”) “.com” domain name.

The Respondent does not dispute that the Complainant has established a reputation since 2009 in its particular field but observes that there are many other companies using “Luma” as a company or brand name and denies ever hearing of the Complainant before this proceeding. The Respondent points to more than 26 million Google search results for “luma” and 160 pending and registered LUMA or LUMA-formative trademarks in the United States alone. The owner of one of these trademarks, LUMA PICTURES, filed (and then withdrew) a UDRP complaint in 2016 in an effort to seize the Domain Name from the Respondent. The Response includes evidence showing that the Respondent has had unsolicited and persistent offers to purchase the Domain Name for as much as USD 250,000, which the Respondent has declined. The Respondent cites these frequent contacts (involving, in one case, an uninvited visit to his home) as a reason for changing the Domain Name registration to a domain privacy service.

The Respondent has not built a website for the Respondent’s consulting business, but he explains that he continues to use the Domain Name for email with clients:

“Because Mr. Redfern’s consulting business arises through professional contacts and referrals, he has no need to advertise through a webpage, and has not maintained one. Instead, his principal use of the domain name has been for email and client file access purposes, and he has never been concerned with what has or has not been going on with the registrar parking page.”

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; and
- (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”.

6.1 Preliminary Matter: Supplemental Filing

The Complainant submitted a supplemental filing, largely replying to the Respondent’s account of the Domain Name history. Neither the Rules nor the Supplemental Rules make provision for supplemental filings, except at the request of the panel (see Rules, paragraph 12). Paragraph 10 of the Rules enjoins the panel to conduct the proceeding “with due expedition”. Therefore, UDRP panels are typically reluctant to countenance delay through additional rounds of pleading and normally accept supplemental filings only to consider material new evidence or provide a fair opportunity to respond to arguments that could not

reasonably have been anticipated. See WIPO Overview 3.0, section 4.6.

The Panel concludes that it is fair and efficient to consider the Complainant's reply to the Respondent's information and argumentation concerning the registration and use of the Domain Name since 1995. The Panel takes the supplemental filing into account to the extent that it addresses those issues.¹

6.2 Substantive Issues

A. Identical or Confusingly Similar

The first element of a UDRP complaint "functions primarily as a standing requirement" and entails "a straightforward comparison between the complainant's trademark and the domain name". See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.7.

The Complainant has a United States trademark registration for LUMA, and the Domain Name is identical.

The Panel does not find in the record sufficient evidence to establish the Complainant's asserted common law rights in LUMA as an unregistered mark; this requires substantial evidence on a range of factors such as historical sales, advertising, and media recognition (see *id.*, section 1.3).

As usual, the gTLD ".com" is disregarded as a standard registration requirement. See *id.* section 1.11.2.

Given the Complainant's trademark registration of the LUMA mark, the Panel finds 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 current use of the Domain Name for a PPC advertising portal rather than an active website operated by a "Luma" business enterprise. This shifts the burden of production to the Respondent, while the ultimate burden of proof remains with the Complainant.

The Respondent demonstrates his original and continuous involvement in the registration of the Domain Name since 1995, attested in the Redfern Declaration with supporting documentation such as transaction

¹ As the Panel denies the Complaint on the current pleadings there is no need to allow Respondent the opportunity to reply to the Supplemental filing.

correspondence with the Registrar. The Declaration states that the Domain Name was always in the Respondent's "personal account", and that the Respondent allowed a succession of companies in which he was involved to use it for their business, while he typically served as a "technical officer". The Respondent declares that he managed and paid for all registration renewals since 1995. There is no evidence to the contrary, despite the Complainant's speculation about how the Domain Name might have become an asset of the companies that succeeded the original Luma, Inc. The Respondent points out that these companies have acceded to his ownership and control of the Domain Name from 1995 to the present.

The Respondent refers to continuous registration of the Domain Name and intermittent use of the Domain Name for websites or email, all before notice of the dispute, and argues that this establishes his rights or legitimate interests:

"The record shows that the Respondent has longstanding senior and legitimate rights and interests in the domain name by which his business has been commonly known, and which Respondent has used for *bona fide* purposes prior to this dispute."

There is actually little evidence of the Domain Name's use at any time for a website associated with a business under a corresponding name. Archived pages for the Domain Name found on the Internet Archive's Wayback Machine begin with an August 1997 screenshot of a minimal "Luma Web Page" with links to information about several persons (not including the Respondent). Early 1998 screen captures are similar but headed instead "Net-It Software Public Employee Web site". The website was then developed into a fuller Net-It Software and Allegis Corporation website, again with no mention of "Luma". The website included a notice about the Click Commerce acquisition of Allegis in March 2003. By 2004, the archived results all displayed error messages, with occasional PPC landing pages displaying the Registrar's logo. It does not appear that the Respondent's Luma Exact company, established in California in 2014, ever operated a website using the Domain Name. As the Complainant observes, that company is now listed as "Suspended" in the online database of the California Secretary of State; its last annual filing was in 2018.

The Respondent says that he has used the Domain Name for email correspondence and file access in his consulting business, without specifying the time periods or furnishing examples. The Respondent's current LinkedIn profile (cited by the Respondent) shows him as a "consultant" but does not list an email address associated with the Domain Name in his contact details, nor does it list Luma Exact or Luma, Inc. in his record of "Experience". Thus, the record does little to support the Respondent's statement that his "business" has been "commonly known" by the "Luma" name or the suggestion that he is continuing to conduct business under that name or use the Domain Name for communicating with clients or prospective clients.

As summarized in the WIPO Overview 3.0, section 2.11, "Panels tend to assess claimed respondent rights or legitimate interests in the present, *i.e.*, with a view to the circumstances prevailing at the time of the filing of the complaint." The Complainant observes that previous UDRP panels have rejected the notion that allowing the Registrar to park a domain name for unrelated PPC advertising serves to establish a legitimate interest (see WIPO Overview 3.0, section 2.9), and the Respondent does not make such a claim here. Instead, the Respondent relies on the facts that he has clearly done business under a corresponding name in the past, Luma, Inc. or Luma Exact, although those businesses are no longer in operation. Otherwise, the record reflects that the Respondent has maintained the Domain Name registration for 26 years in the name of a "Luma" organization or alter ego, and the Respondent declares that he continues to use the Domain Name for emails in his consulting business.

While the evidence of the Respondent's current legitimate interests or commercial use of the Domain Name may be challenged on this record, it is persuasive in earlier periods, for example from 2014 to 2018 when Luma Exact was a live corporation. As noted in WIPO Overview 3.0, section 2.11, "Panels will often also consider any evidence of previous legitimate use under the third UDRP element." In the interest of judicial economy, the Panel chooses to ground the Decision on the third element, bad faith, rather than reaching a conclusion on the issue of the Respondent's current rights or legitimate interests under the Policy, paragraph 4(c)(i) or (ii),

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 (in which “you” refers to the registrant of the domain name):

“(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.”

The Complainant argues from the Domain Name history that the Respondent must be viewed as having registered the Domain Name in November 2016, “long after Complainant acquired rights to LUMA mark through use and registration of such mark.” The Complainant suggests that the Respondent registered the Domain Name in 2016 to take advantage of the Complainant's mark, using a domain privacy service to hide his identity, and then monetized the Domain Name with PPC advertising.

As detailed above, the Complainant has not furnished sufficient evidence to establish if and when the LUMA mark acquired distinctiveness as a protectable common law mark, and the Complainant obtained trademark registration only in February 2018. The Respondent credibly denies prior knowledge of the Complainant until this proceeding and observes that “luma” formative names and marks are common. In any event, the Respondent was the original registrant of the Domain Name in 1995 and attests that he managed and paid for every renewal of the registration for his own personal account. The Respondent at all times named some form of “Luma” as the organization, even when allowing another business entity to use the Domain Name and even when there was no legal entity named “Luma” in existence. None of these organizations has attempted to claim the Domain Name as its own property. The Panel accepts, therefore, the Respondent's attested claim to own the Domain Name since 1995 and considers the chain of registration unbroken since August 1995. See WIPO Overview 3.0, section 3.9 and decisions cited therein (formal changes are not normally treated as new registrations; transfer to a domain privacy service is not deemed a new registration absent other factors such as evidence of an attempt to avoid enforcement). There is no indication, of course, that the Respondent could have known in 1995 about the Complainant, which was not established until 2009 and did not apply for a trademark registration until August 2016.

The Panel did not find under the second element that the Respondent established commercial use of the Domain Name at the time of this proceeding. But the Respondent's evidence of prior legitimate interests is relevant on the issue of bad faith registration. The Response establishes that in earlier periods, in the early 1990s and the period 2014-2018, the Respondent was involved in companies with “Luma” names and used the Domain Name briefly for a website and also for business email, and then for email in the Respondent's consulting business. Thus, the Respondent unquestionably had legitimate reasons to register and use the Domain Name that had nothing to do with the Complainant or its unregistered mark, in 1995 and even if the Panel were to consider a later date such as November 2016 as the relevant registration date, as the Complainant urges.

The Complainant, pointing to long periods of inactivity with the Domain Name, cites the “passive holding” doctrine articulated in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 and similar decisions. But the facts in this case lack the hallmarks of those decisions, as summarized in WIPO Overview 3.0, section 3.3:

“(i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

“Luma” is demonstrably a rather common name and brand, not peculiar to the Complainant. The

Respondent has used “Luma” in the names of two corporations over the years and has used the Domain Name for websites and emails, before the Complainant had a trademark. The Respondent only more recently used a domain privacy service, provided accurate underlying registrant contact details, and responded to correspondence and to the UDRP Complaint. The Domain Name has been used in good faith over the past 26 years and may be so used in the future, even if only for email. In short, this is not a “passive holding” case.

The Complainant infers bad faith from the Respondent’s use of a domain privacy service, but the Respondent cites good reasons for doing so, to avoid intrusions and unwanted solicitations. The Respondent has not avoided contact to address the UDRP Complaint, and the Panel does not find the inference of bad faith warranted in this case. See WIPO Overview 3.0, section 3.6: “Where it appears that a respondent employs a privacy or proxy service merely to avoid being notified of a UDRP proceeding filed against it, panels tend to find that this supports an inference of bad faith; a respondent filing a response may refute such inference.”

As the Complainant is not able to demonstrate bad faith in the registration of the Domain Name, it is not material that the Respondent has allowed the Registrar to park the Domain Name for periods at a landing page with PPC advertising. The Policy requires a showing of bad faith both in the registration and use of a domain name to obtain an order to cancel or transfer the domain name.

The Panel finds, critically, that the Respondent has held the Domain Name since 1995, before the Complainant’s mark existed, and even in 2016 likely retained the Domain Name for reasons other than an attack on the Complainant’s mark.

The Panel concludes that the Complainant has not established the third element of the Complaint, bad faith.

7. Decision

For the foregoing reasons, the Complaint is denied.

/W. Scott Blackmer/
W. Scott Blackmer
Presiding Panelist

/Christopher S. Gibson/
Christopher S. Gibson
Panelist

/Richard G. Lyon/
Richard G. Lyon
Panelist
Date: December 29, 2021