

ADMINISTRATIVE PANEL DECISION

Bartko Zankel Bunzel & Miller v. Perfect Privacy, LLC / Jan Bartko
Case No. D2022-0043

1. The Parties

The Complainant is Bartko Zankel Bunzel & Miller, United States of America (“United States”), internally represented.

The Respondent is Perfect Privacy, LLC / Jan Bartko, United States.

2. The Domain Name and Registrar

The disputed domain name <bartko.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 January 6, 2022. On January 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 7, 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 January 14, 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 January 14, 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 February 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 23, 2022.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on March 3, 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 professional corporation organized under the law of the State of California (United States) and headquartered in San Francisco, California. The Complainant's website at "www.bzbm.com" describes the Complainant as follows:

"BartkoZankel, established 40 years ago, is a top 20 boutique law firm specializing in national and international complex litigation and investigations, as well as real estate and franchising transactions. We are a 40-lawyer firm dedicated to the strategic cutting-edge representation of our clients in California, nationally and internationally."

According to the Complaint, the firm has used the first element in its official name, BARTKO, as an unregistered mark since December 1994. The Complainant filed an application on December 3, 2021, with the United States Patent and Trademark Office ("USPTO") to register BARTKO as a standard character service mark (Serial Number 97154646), claiming first use in commerce "as early as" December 31, 1994. That application is pending at the time of this Decision. It appears that the Complainant also has a pending application to register BARTKO.COM as a standard character mark (Serial Number 97173628).

The homepage and each succeeding page of the Complainant's website is headed with a BARTKO ZANKEL BUNZEL, the first three names of the Complainant's full name (the full name appears only in the copyright notice at the bottom of each page). Otherwise, two other versions of the firm name appear on the various web pages: BartkoZankel (the first two elements of the Complainant's name, spelled without an intervening space) and the initials BZBM. The website pages do not feature the claimed mark BARTKO appearing alone, much less any appearance of that claimed mark with a "TM" symbol indicating asserted common law rights. Indeed, none of these forms of the name appear with a "TM" symbol, and there is no reference in the legal terms on the website to trademark claims, despite the Complainant's two pending trademark applications. However, the website page labelled "News, Media & Publications" has a few examples of press releases dating from 2019-2022 referring to the "Bartko firm" or "Bartko attorneys". The Panel notes that the Complainant used some of these as its specimens of use in its trademark applications for BARTKO. However, most of the Complainant's press releases use instead the terms "BartkoZankel" or "BZBM".

The Registrar's Whois database showed that the Domain Name was created on April 21, 1998 and listed the registrant as a domain privacy service. After receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent Jan Bartko, an individual in the State of Washington, United States. The Domain Name resolves to a parking page hosted by the Registrar with pay-per-click ("PPC") advertising links for third parties in diverse fields such as cryptocurrency trading, gas card sales, and postcard mailing services. From a review of archived screenshots available through the Internet Archive's Wayback Machine, it appears that the Domain Name has never resolved to anything other than "under construction" or PPC advertising landing pages since it was created in 1998.

5. Parties' Contentions

A. Complainant

The Complainant asserts common law rights in BARTKO, which it says it has used since December 1994 "in a sufficiently open manner such that the relevant public would associate its services with the mark. The Complainant cites one example, the Complainant's website, where "Complainant has continuously displayed or otherwise made known to clients and prospective clients in the ordinary course of business the 'Bartko' service mark in a matter that associates the designation with legal advice, legal consultancy, and legal

services”. The Complainant attaches screenshots of four press releases from its website referring to the Bartko firm or Bartko attorneys.

The Complainant argues that “[t]he registrant’s nonuse of the domain name proves that it has no legitimate commercial or non-commercial use of the domain name.” The Complainant infers bad faith from this non-use: the Respondent must be “intending to squat on this domain name for the purpose of selling, renting or otherwise transferring the domain name registration to the Complainant, the owner of the trademark, for financial gain”. Because of this, the “Complainant has been prohibited from using its registered trademark as a domain name.” “Instead, Complainant has been forced to use the domain name, www.bzbm.com, which has made it more difficult for clients, including potential customers, to access the Complainant’s proper web page, and has unlawfully prohibited the Complainant from using its preferred domain name.”

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

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”.

A. Identical or Confusingly Similar

The Complainant recently applied for United States trademark registration of BARTKO as a standard character mark; that application is pending. The Complainant grounds this UDRP Complaint on its asserted common law rights in BARTKO as an unregistered service mark. (The Complainant also refers to BARTKO as a “trade name” but does not mention any trade name registration. In any event, the Policy, paragraph 4(a) does not provide for standing based on trade names.)

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.3, explains how a UDRP complaint may be based on an unregistered mark:

“To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services.

Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

(Particularly with regard to brands acquiring relatively rapid recognition due to a significant Internet presence, panels have also been considering factors such as the type and scope of market activities and the nature of

the complainant's goods and/or services.)

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In 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.”

In this case, the Complainant is a long-established law firm, which advertises intellectual property as one of its three principal practice areas. Yet the only evidence it offers for the acquired distinctiveness of its claimed service mark is in the form of four press releases reproduced on its website, three from 2020 and one from 2021. The Panel furthermore notes that the single specimen of use submitted in the application to the USPTO – which the Complainant refers the Panel to – shows three news items from 2021 (while a date of first use in commerce of 1994 is claimed). The Complaint includes no evidence of sales, advertising, or media recognition using the BARTKO mark. The Panel notes that most of the Complainant's own press releases, like the other pages on the Complainant's website, use other forms of the Complainant's name. The Complainant's website displays signs of the law firm's recognition in legal industry directories and in media rankings of law firms: Chambers, Super Lawyers, International Franchise Association, Top Rated Lawyers, Global Advocaten, Best Lawyers, US News Best Lawyers, San Francisco Business Times Largest Law Firms. The Panel finds in each case, however, that these publications do not refer to the Complainant using the claimed mark BARTKO but rather use the Complainant's full name or one of the several other shortened forms more commonly given by the Complainant itself: “BZ”, “BZBM”, “BartkoZankel”, or “Bartko Zankel Bunzel”.

On this record, the Panel cannot find that the Complainant has established that it has common law rights in the claimed service mark BARTKO for purposes of establishing standing under the UDRP. The Panel concludes that the Complainant has not established the first element of the Complaint.

Even if the Complainant were able to meet this criteria, either by its trademark application proceeding to registration, or via common law showing, the Panel notes that the Complaint would fail on the second and likely third elements.

B. Rights or Legitimate Interests

Given the Panel's conclusion under the first element of the Complaint, it is not strictly necessary to rule on the second element. The Panel notes, however, that the name of the underlying registrant is “Bartko”, a name corresponding exactly to the Domain Name, which would normally establish the Respondent's rights or legitimate interests in the Domain Name. See [WIPO Overview 3.0](#), section 2.3. Again, even if the Complainant had met the showing under the first element, this would be fatal to the Complainant's case.

C. Registered and Used in Bad Faith

As the Panel concluded that the Complainant lacks standing under the first element of the Complaint, it is not necessary to assess the Complainant's arguments for bad faith. The Panel observes, however, the unlikelihood of establishing that the Respondent acted in bad faith by registering a Domain Name corresponding to his own family name in 1998, purportedly to attack a common law mark of a California law firm that has sought to register such mark decades later.

7. Decision

For the foregoing reasons, the Complaint is denied.

8. Reverse Domain Name Hijacking

This Complaint is unusual in that it was brought both by and on behalf of a law firm that practices in the field of intellectual property law. The Panel calls attention to the fact that the Complaint was filed with this required certification under Rule 3(xiii), signed by counsel:

“Complainant certifies that the information contained in this Complaint is to the best of Complainant’s knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.”

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 Respondent did not submit a Response in this proceeding or request a finding of RDNH, but the Panel finds compelling reasons 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 Reverse Domain Name Hijacking. See [WIPO Overview 3.0](#), section 4.16. A finding of RDNH is warranted, for example, 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.).

Here, the Complaint is plainly deficient. The cursory presentation of “Factual and Legal Grounds” is devoid of references to the Policy or the WIPO Overview and does not begin to address the difficulties faced by a UDRP complainant with a common law mark against a registrant who acquired a domain name by all appearances identical to his family name nearly a quarter of a century ago.

The Complaint offers minimal evidentiary support for its unregistered mark. There is no evidence of sales or advertising under the mark. The public recognition of the law firm evident on the Complainant’s website refers to the Complainant by several other names and abbreviations, not by the claimed mark. Thus, the Complaint could not establish standing under the first element.

The likelihood of the Complainant prevailing on the other two elements was similarly improbable. Once the Registrar identified the underlying registrant as the Respondent Jan Bartko, an individual with a family name corresponding to the Domain Name, the Complainant should have amended the Complaint to address the obvious implications for its arguments concerning the Respondent’s *prima facie* legitimate interests and bad faith. The Complainant amended its Complaint, but only to add Mr. Bartko’s name to the caption. The Amended Complaint continues to say, under the second element, that the registrant’s identity is “unknown” and that the Complainant “is unable to ascertain the true purpose of the registrant’s use in the domain name at issue.” In any event, the Complainant infers that the Respondent must have meant to sell the Domain Name to the Complainant – despite making no attempt to do so in 24 years. The Complainant offers no evidence concerning the notoriety of its business in 1998 (or any later acquisition of the disputed domain name, if there were any), which would be necessary to persuade a panel that the Respondent really chose the Domain Name in the hope of exploiting the Complainant’s reputation rather than because the Domain Name matched his own.

The Complainant makes incongruous arguments and egregious misstatements. Perhaps the most glaring is this:

“Complainant has been prohibited from using its registered trademark as a domain name. Instead, Complainant has been forced to use the domain name, www.bzbm.com, which has made it more difficult for clients, including potential customers, to access the Complainant’s proper web page, and has unlawfully prohibited the Complainant from using its preferred domain name.”

The Complainant does not have a registered trademark. It has only recently applied for two trademark registrations. The Complainant repeatedly uses “BZBM” and other names different from BARTKO on its own website and in its press releases and USPTO specimen. The Whois database and the WayBack Machine show that the Complainant has been using <bzbm.com> since 2004.

The Panel finds that the Complainant brought the Complaint in bad faith, within the meaning of Rule 15(e), in an attempt at Reverse Domain Name Hijacking.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: March 17 2022