

ADMINISTRATIVE PANEL DECISION

Simpson Thacher & Bartlett LLP v. Domains By Proxy, LLC / Name Redacted Case No. D2022-1575

1. The Parties

The Complainant is Simpson Thacher & Bartlett LLP, United States of America, represented internally.

The Respondent is Domains By Proxy, LLC, United States of America / Name Redacted.¹

2. The Domain Name and Registrar

The disputed domain name <lists-stblaw.com> is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 29, 2022. On May 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 3, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 4, 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 May 9, 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

¹ The Respondent appears to have used the name of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

Complaint, and the proceedings commenced on May 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 1, 2022. After the Center's notification, the Respondent sent an email communication to the Center on June 1, 2022.

The Center appointed William R. Towns as the sole panelist in this matter on June 13, 2022. The Panel finds 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 an international law firm founded in 1884 and headquartered in New York City, United States. The Complainant specializes in litigation and corporate practices, including mergers and acquisitions, and employs over 1,000 attorneys in offices in Houston, Los Angeles, Palo Alto, and Washington, generating upwards of USD 2.25 billion in annual revenues.

The Complainant has made extensive use of its unregistered common law STBLAW trademark since as early as 1996. The Complainant registered the domain name <stblaw.com> for itself more than 25 years ago, and continues to claim common law rights in its STBLAW mark, which is considered by the Complainant as an essential part of its business.

The disputed domain name was registered by the Respondent on April 21, 2022, according to the Registrar's Whois records, utilizing a proxy service. Insofar as the record reflects, the Respondent does not appear to have used the disputed domain name in connection with an active website; however, there is some concern as to whether a potential identity theft by person or persons unknown may have been attempted.

5. Parties' Contentions

A. Complainant

The Complainant identifies itself as an international law firm founded in 1884 and headquartered in New York City, specializing in litigation and corporate practices, including mergers and acquisitions, and employing more than 1,000 attorneys in various offices worldwide. The Complainant explains it extensively uses its STBLAW trademark, and asserts extensive common law rights in its STBLAW mark dating back over many years.

The Complainant submits that the disputed domain name is confusingly similar to the Complainant's STBLAW mark, in which the Complainant holds common law rights. The Complainant maintains the Complainant's STBLAW mark has become a distinctive identifier of source that consumers associate with the Complainant's services, and used by the Complainant to market its practice for over 120 years. The Complainant offers examples of other law firms that have successfully protected their marks in the same or similar circumstances.

The Complainant maintains that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant concludes that the Respondent registered and is using the disputed domain name in bad faith. According to the Complainant, UDRP Panels have held that the registration of a disputed domain name confusingly similar to a widely-known trademark by an unaffiliated entity may create a presumption of bad faith. The Complainant reiterates it is a preeminent global law firm generating over USD 2.25 billion in revenues annually and employs more than 1,100 attorneys. The Complainant stresses the Respondent would have known of the Complainant's STBLAW mark when registering the disputed domain name, which of itself would create a likelihood of confusion and take advantage of the goodwill associated with the Complainant's SBTLAW mark. The Complainant also refers to potential fishing scams and bad actors likely to engage in it.

B. Respondent

In its late Response, the Respondent indicated that he has no knowledge how the disputed domain name was created, nor by whom. He further submitted that his business identity was hacked and was then used to create domain names without his knowledge and authorization, along with supporting documents. Lastly, the Respondent expressed that he has no interest in the disputed domain name.

6. Discussion and Findings

A. Scope of the Policy

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. *Milwaukee Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store*, WIPO Case No. [D2002-0774](#). Accordingly, the jurisdiction of this Panel is limited to providing a remedy in cases of “the abusive registration of domain names”, also known as “cybersquatting”. *Weber-Stephen Products Co. v. Armitage Hardware*, WIPO Case No. [D2000-0187](#). See Final Report of the First WIPO Internet Domain Name Process, April 30, 1999, paragraphs 169-177. The term “cybersquatting” is most frequently used to describe the deliberate, bad faith abusive registration of a domain name in violation of rights in trademarks or service marks. *Id.* at paragraph 170. Paragraph 15(a) of the Rules provides that the panel shall decide a complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the panel deems applicable.

Paragraph 4(a) of the Policy requires that the complainant prove each of the following three elements to obtain a decision that a domain name should be either cancelled or transferred:

- (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 with respect to the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

Cancellation or transfer of the domain name is the sole remedy provided to the complainant under the Policy, as set forth in paragraph 4(i).

Paragraph 4(b) of the Policy sets forth four situations under which the registration and use of a domain name is deemed to be in bad faith, but does not limit a finding of bad faith to only these situations.

Paragraph 4(c) of the Policy in turn identifies three means through which a respondent may establish rights or legitimate interests in a domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is primarily, if not exclusively, within the knowledge of the respondent. Thus, the view is that the burden of production shifts to the respondent to come forward with evidence of a right or legitimate interest in the domain name, once the complainant has made a *prima facie* showing. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 2.1. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

B. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s STBLAW mark, in which the Complainant has established rights through extensive use of the mark. In considering identity and

confusing similarity, the first element of the Policy serves essentially as a standing requirement.² The threshold inquiry under the first element of the Policy involves a relatively straightforward comparison between the complainant's trademark and the disputed domain name.

The Complainant's STBLAW mark is clearly recognizable in the disputed domain name.³ The inclusion in the disputed domain name of the term "lists" followed by a hyphen (-) and the letters "stblaw" does not dispel the confusing similarity of the disputed domain name to the Complainant's mark. See, e.g. *Instagram, LLC v. Temp name Temp Last Name, Temp Organization*, WIPO Case No. [D2019-0109](#). See also *Instagram, LLC v. A S*, WIPO Case No. [D2020-1327](#). When the relevant trademark is recognizable in the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not preclude a finding of confusing similarity under paragraph 4(a)(i) of the Policy.⁴ Top Level Domains (TLDs) such as ".com", generally are disregarded when evaluating the identity or confusing similarity of the Complainant's mark to the disputed domain name under paragraph 4(a)(i) of the Policy, irrespective of any ordinary meaning that might be ascribed to the TLD.⁵

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

As noted above, once the complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of rights or legitimate interests in a domain name. The Panel is persuaded from the record of this case that a *prima facie* showing under paragraph 4(a)(ii) of the Policy has been made. It is undisputed that the Respondent has not been authorized to use the Complainant's STBLAW mark. The Respondent notwithstanding has registered and used the disputed domain name, misappropriating the Complainant's STBLAW mark. As previously noted, the disputed domain name does not appear to resolve to any active website and has been passively held by the Respondent.

Pursuant to paragraph 4(c) of the Policy, 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 disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) 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.

The Respondent has not produced any evidence to establish its rights or legitimate interests in the disputed domain name. To the contrary, the Respondent's email of June 1, 2022, suggests that the Respondent has no rights or legitimate interests in the disputed domain name. The Panel has carefully reviewed the record in this case, and finds nothing therein that would bring the Respondent's registration and use of the disputed domain name within any of the "safe harbors" of paragraph 4(c) of the Policy.

The Panel concludes from the record that the Respondent – whoever that real person may be – was aware

² See [WIPO Overview 3.0](#), section 1.7.

³ See [WIPO Overview 3.0](#), section 1.8 and cases cited therein.

⁴ *Id.*

⁵ See [WIPO Overview 3.0](#), section 1.11.

of and had the Complainant's SBT LAW mark firmly in mind when registering the disputed domain name. The Respondent has brought forward no credible evidence of use or of any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. See [WIPO Overview 3.0](#), section 2.2 and cases cited therein. Nor has the Respondent asserted any claim to be making a legitimate noncommercial or fair use of the disputed domain name.⁶

In view of the foregoing, the Panel concludes that the Respondent has neither used nor demonstrated preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, and is not making a legitimate noncommercial or fair use of the disputed domain name. Moreover, there is no indication that the Respondent has been commonly known by the disputed domain name at any time within the meaning of paragraph 4(c)(ii) of the Policy.

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent 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 the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trademark of another. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. [D2004-0230](#).

For the reasons discussed under this and the preceding heading, the Panel concludes that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain name within the meaning of paragraph 4(a)(iii) of the Policy. The Panel finds the Respondent – again whoever that real

⁶ A respondent's use of a domain name cannot be considered "fair" if it falsely suggests affiliation with the trademark owner, and UDRP panels generally have found that a domain name appropriating a complainant's trademark plus an additional term carries a risk of implied affiliation if it effectively suggests sponsorship or endorsement by the trademark owner. See [WIPO Overview 3.0](#), sections 2.5 and 2.5.1. The use of a domain name cannot be "fair" if it suggests a non-existent affiliation with the trademark owner; nor can a use be "fair" if it is pretextual. See *201 Folsom Option JV, L.P. and 201 Folsom Acquisition, L.P. v. John Kirkpatrick*, WIPO Case No. [D2014-1359](#); *Project Management Institute v. CMN.com*, WIPO Case No. [D2013-2035](#).

person may be – was aware of the Complainant and had the Complainant's STBLAW mark in mind when registering the disputed domain name, more likely than not with the intention of exploiting and profiting from the Complainant's trademark rights, or of offering the disputed domain name for sale at an exorbitant price.

What might now appear otherwise to be the Respondent's passive holding of the disputed domain name does not preclude a finding of bad faith in the attendant circumstances of this case. As set forth in *Telstra Corporation Limited v. Nuclear Marshmallows*, *supra*, "the relevant issue is not whether the Respondent is taking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith. [...] [I]t is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith". See also *Red Bull GmbH v. Kevin Franke*, WIPO Case No. [D2012-1531](#). The Panel finds such circumstances to be present in this case.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <lists-stblaw.com> be transferred to the Complainant.

/William R. Towns/

William R. Towns

Sole Panelist

Date: June 27, 2022