

ADMINISTRATIVE PANEL DECISION

Raymond v. Zakari v. Danesco Trading Ltd. / Andrei Nikolskii
Case No. D2022-2273

1. The Parties

The Complainant is Raymond v. Zakari, United States of America (“United States”), represented by Milord & Associates, PC, United States.

The Respondent is Danesco Trading Ltd., Cyprus / Andrei Nikolskii, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <landlord-tenant-lawyers.com> is registered with Danesco Trading Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 22, 2022. On June 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 24, 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 June 27, 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 amendment to the Complaint on July 7, 2022.

The Center verified that the Complaint together with the amendment to the 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 July 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 9, 2022.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on August 16, 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 an established attorney licensed to practice law in the State of California, United States, since 2003. The Complainant operated the disputed domain name from April 2008 to December 2017, and claims unregistered trademark rights in the marks LANDLORD TENANT LAWYER and LANDLORD-TENANT-LAWYERS.COM since April 2008.

A search on the Internet Archive “Wayback Machine” by the Panel for the website associated with the disputed domain name discloses the online presence of the Complainant’s professional website from April 16, 2008 onwards. Likewise, a historic Whois search shows that the disputed domain name was originally registered on September 17, 2007, and ultimately expired on September 17, 2017. Although such search does not disclose the registrant name, the period concerned, broadly speaking, corresponds to the period when the Complainant contends that it operated the disputed domain name and likewise matches the website data on the Internet Archive.¹

According to a recent Whois record, the disputed domain name was registered on December 6, 2017. The website associated with the disputed domain name appears to be the Complainant’s professional website, although it has been altered to include advertisements, which promote third party legal services, including some which appear to be of the pay-per-click variety.

5. Parties’ Contentions

A. Complainant

In summary, the Complainant contends as follows:

Identical or confusingly similar

The exclusive and continuous use of the LANDLORD TENANT LAWYER mark by the Complainant for ten years before its adoption by the Respondent, establishes an association of said mark with the Complainant and to the extent necessary establishes secondary meaning therein. The disputed domain name incorporates in its entirety the well-known unregistered mark of the Complainant and is thereby identical or confusingly similar thereto.

Rights or legitimate interests

The Respondent has no legitimate use for the website at the disputed domain name. The Complainant’s adoption and use of its mark predates the Respondent’s use by ten years. The Respondent is not a licensed attorney and has received no license to use the Complainant’s marks. It is believed that the Respondent adopted the disputed domain name to divert traffic from the Complainant’s business, to collect advertising revenue, and thereafter to sell the disputed domain name at a significant premium.

There is no evidence that the Respondent is making noncommercial or fair use of the disputed domain name. There is no evidence that the Respondent operates a law firm corresponding to the name of the

¹ With regard to the Panel conducting limited factual research into matters of public record, such as consulting relevant publicly available websites, see section 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Complainant's firm. The address and telephone number on the Respondent's website belong to the Complainant. The Respondent is brazenly trading on the Complainant's reputation in the Complainant's field of legal services and is reproducing the Complainant's name, likeness, and content subject to copyright. The Respondent knew of the Complainant's prior rights because of the fact that it has maintained these on its website for years.

Registered and used in bad faith

The Respondent deliberately chose the Complainant's unregistered marks, which are used to identify the Complainant as the source of services and to distinguish these from others. The Respondent's registration of the disputed domain name was intentional, willful, and in bad faith. The use of the disputed domain name incorporating the Complainant's mark creates a likelihood of confusion. The public will be misled as to the origin, sponsorship, or association of the information and services promoted, offered, or sold on the website associated with the disputed domain name. Internet users may believe that the services and information advertised there are those provided by the Complainant because the Respondent has maintained all of the Complainant's information.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The first element analysis under the Policy is usually conducted in two parts. First, the Panel ascertains whether the Complainant possesses UDRP-relevant rights in any relevant claimed trademark, whether registered or unregistered. Secondly, the domain name concerned is compared with such trademark, typically on a straightforward side-by-side basis, in which the Top-Level Domain ("TLD") of said domain name (in the disputed domain name, ".com") is usually disregarded as being only a technical requirement. Confusing similarity may be found if the trademark is recognizable in the disputed domain name, whether or not accompanied by other terms. Identity may be found if the trademark is identical to the disputed domain name (with the exception of the TLD), having disregarded any special characters, punctuation or spaces.

In the present case, the Complainant claims unregistered trademark rights in the mark LANDLORD TENANT LAWYERS, which it has used for at least 14 years. Section 1.3 of the [WIPO Overview 3.0](#) provides examples of what needs to be evidenced by a complainant in order to successfully assert unregistered trademark rights in cases under the Policy, namely (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.

The Complainant provides submissions and evidence regarding aspects (i), (iii) and (v) of these examples. While the Complainant claims to have conducted extensive advertising under said mark, referencing aspect (iii), the evidence produced consisted of three advertisements, namely "local.yahoo.com",

“profiles.superlawyers.com”, and “www.lawyer.com”. Each of these contains a capture date of June 22, 2022, and there is no additional information as to the number of impressions or the periods over which the advertisements were displayed.

Considering aspect (i), the Panel finds that independent evidence is available, as noted in the factual background section above, supporting the notion that the Complainant has used the mark LANDLORD TENANT LAWYERS (including, until September 2017, by way of the disputed domain name itself) from April 2008 to date. In terms of aspect (v), the Complainant produces consumer reviews of the Complainant’s services from 2012 to 2014, and attorney endorsements from 2015. These reinforce the fact that the Complainant’s services were positively reviewed over the period concerned, albeit that they do not mention the alleged unregistered mark itself. In these circumstances, the evidence supporting the Complainant’s claim to unregistered rights in the mark LANDLORD TENANT LAWYERS is less detailed than the Panel typically would have wished to see, particularly as it must not be overlooked that the claimed mark is wholly descriptive of legal services in the field of landlord/tenant law. This suggests to the Panel that in order to establish a secondary meaning in such term, the evidence would need to be of reasonable substance.

It is however clear that the Complainant’s business has been active using this name for many years, and that it operated under the disputed domain name, itself consisting of this term, for a considerable period, during which it received both consumer and attorney endorsements and positive reviews for its services. It has advertised the disputed domain name on multiple Internet platforms, albeit for an indeterminate period. Of greatest significance, however, is the fact that the Respondent itself has reproduced a version of the Complainant’s website in association with the disputed domain name since it registered this in 2017, having apparently added third party advertisements to the code of the Complainant’s site. The Respondent is thereby targeting the Complainant’s mark in a manner which suggests that such mark is indeed a source identifier. Section 1.3 of the [WIPO Overview 3.0](#) notes “The fact that a respondent is shown to have been targeting the complainant’s mark (e.g., based on the manner in which the related website is used) may support the complainant’s assertion that its mark has achieved significance as a source identifier”. Although the issue is finely balanced in this particular case, the Panel finds that the totality of the evidence under aspects (i), (iii) and (v) above, together with the present use of the website associated with the disputed domain name, does tip the balance in the Complainant’s favor. Accordingly, the Panel finds that the Complainant has established that it possesses unregistered trademark rights for purposes of the Policy.

Turning to the comparison exercise, it may be seen that such mark is reproduced in the disputed domain name in its entirety and with no additions apart from the typically disregarded TLD and punctuation. Furthermore, the hyphens in the disputed domain name appear simply to be substitutions for the spaces in the Complainant’s mark, as spaces are not permitted in domain names for technical reasons.

The Panel notes that the Respondent has not engaged with the administrative proceeding and has not challenged the Complainant’s submissions on this topic in any way. In all of these circumstances, the Panel finds that the disputed domain name is identical to a trademark in which the Complainant has rights and therefore that the Complainant has carried its burden in respect of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the disputed domain name:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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 consensus of previous decisions under the Policy is that a complainant may establish this element by making out a *prima facie* case, not rebutted by the respondent, that the respondent has no rights or legitimate interests in a domain name. In the present case, the Panel finds that the Complainant has established the requisite *prima facie* case based on its submissions and related evidence that the Respondent has effectively cloned the Complainant’s site, adding multiple advertisements to it, and is thereby impersonating the Complainant and misleading the public.

In the above circumstances, the burden of production shifts to the Respondent to bring forward evidence of any rights or legitimate interests which it might claim in the disputed domain name. However, the Respondent has not engaged with the administrative proceeding. There is no suggestion before the Panel that the Respondent could avail itself of any of the provisions of paragraph 4(c) of the Policy, or otherwise could establish rights and legitimate interests in the disputed domain name. The Respondent appears to have reproduced the Complainant’s copyright materials at the website associated with the disputed domain name and to have combined these with advertising which promotes the goods or services of third parties. The Panel cannot conceive of any legitimate reason whereby the Respondent might have done this, and has been unable to determine any potential rights or legitimate interests which the Respondent might have claimed had it chosen to participate in this case.

In all of these circumstances, the Panel finds that the Respondent has failed to rebut the Complainant’s *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, and therefore that the Complainant has carried its burden in terms of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- “(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
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.”

In the present case, the Complainant focuses upon the fact that the Respondent has registered the disputed domain name following its expiration in the hands of the Complainant, yet it has cloned the Complainant’s website with the addition of third party advertising with intent for commercial gain. These submissions are supported by a contemporaneous screenshot of the website associated with the disputed domain name. The Respondent’s actions could not have been carried out in ignorance of the Complainant or its rights,

given the fact that it has reproduced the website, which was formerly displayed by the Complainant and merely added advertisements to this. As the disputed domain name appears to have been registered previously and to have expired, and as it was then newly registered by the Respondent, the cloning of such content must have been a purposeful act on the Respondent's part. In other words, the use of content belonging to the previous registrant of the disputed domain name on the website associated with the disputed domain name, in the present circumstances, cannot be a coincidence and could not have resulted from the Respondent's mere passive inaction and/or lack of awareness of the Complainant's rights.

As noted in the preceding section, the Respondent has not engaged with the administrative proceeding. In the absence of any submissions or evidence from the Respondent which might have presented a challenge to the Complainant's allegations, the Panel can conceive of no good faith reason whereby the Respondent registered and used the disputed domain name in the manner disclosed by the record.

The Panel finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of such website. In all of these circumstances, the Panel finds that the disputed domain name has been registered and is being used in bad faith, and therefore that the Complainant has carried its burden in terms of paragraph 4(a)(iv) 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 <landlord-tenant-lawyers.com> be transferred to the Complainant.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: August 30, 2022