

## **ADMINISTRATIVE PANEL DECISION**

Shinnecock Indian Nation v. Jose Benjamin Gio Yah  
Case No. D2022-4947

### **1. The Parties**

The Complainant is Shinnecock Indian Nation, United States of America, represented by Debevoise & Plimpton, United States of America.

The Respondent is Jose Benjamin Gio Yah, Mexico.

### **2. The Domain Name and Registrar**

The disputed domain name <shinnecocknation.com> is registered with Soluciones Corporativas IP, LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 22, 2022. On December 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 23, 2022, the Registrar transmitted by email to the Center its verification response with the 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 December 27, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Center sent a communication related to the language of the proceeding. The Complainant filed an amended Complaint on December 30, 2022, and requested the proceeding to be held in English.

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 January 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 27, 2023.

On January 28, 2023, the Respondent sent informal communications in Spanish in which it stated that the disputed domain name was not for sale and that it legally registered the disputed domain name.

#### **4. Factual Background**

The Complainant is Shinnecock Indian Nation, a federally recognized self-governing tribe in the State of New York, United States of America, comprised of over 1,500 enrolled tribal members, about half of whom live on the tribal Reservation in Southampton, New York.

The Complainant has been using the signs SHINNECOCK, SHINNECOK NATION, SHINNECOCK INDIAN NATION, SHINNECOCK POWWOW and SHINNECOCK INDIAN POWWOW (hereinafter, the “SHINNECOCK Marks”) to identify its cultural and entertainment services, as evidenced by the documents submitted by the Complainant as annexes to the Complaint.

In details, the Complainant held its first “Shinnecock Powwow”, a festival celebrating the Shinnecock Indian Nation’s culture, in 1946. Since then, the annual event has been held every Labor Day weekend under the SHINNECOCK Marks. The “Shinnecock Powwow” includes competitive dancing for over USD 50,000 in prize money, guest entertainment, prayers, ceremonial dances, and many vendors selling Native American arts, crafts, and food, attracting tens of thousands of attendees each year.

In addition to using its SHINNECOCK Marks in marketing the powwow and selling admission tickets to the powwow, the Complainant also uses its trademarks in connection with the publication, sale and display of its annual Shinnecock Powwow programs.

The Shinnecock Powwow has also been featured in numerous media publications, which make prominent mention of the SHINNECOCK Marks, and in “Conscience Point”, a documentary that details the Complainant’s fraught relationship with its wealthy Hamptons neighbors. The film has been aired on the Public Broadcasting Service (“PBS”) and has been shown at several international film festivals including the Hamptons International Film Festival and the Red Nation International Film festival.

The Complainant also maintains and advertises the “Shinnecock Powwow” on a government website at “[www.shinnecock-nsn.gov](http://www.shinnecock-nsn.gov)”.

The disputed domain name <[shinnecocknation.com](http://shinnecocknation.com)> was registered by the Respondent on August 15, 2020 and is currently pointed to a website publishing information on the Shinnecock Nation taken from the Wikipedia website, along with information about Asian Indians, and also containing links throughout the text that lead directly to adult content websites.

Prior to the Respondent’s registration of the disputed domain name however, the latter belonged to the Complainant, which used it in connection with its official website until 2015, when it allowed the registration to expire.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant contends that, by reason of the over 75 years of use, media attention, and advertising of its cultural and entertainment services, the SHINNECOCK Marks have come to be recognized and relied upon by the public as identifying the Complainant and its cultural and entertainment services.

The Complainant submits that the disputed domain name is identical to the trademark SHINNECOCK NATION as it reproduces the trademark in its entirety whilst it uses the dominant portion of the SHINNECOCK INDIAN NATION, SHINNECOCK POWWOW and SHINNECOCK INDIAN POWWOW

trademarks with the mere addition of the generic Top-Level Domain (“gTLD”) “.com”. The Complainant underlines that the addition in the disputed domain name of the generic descriptor “nation” and the gTLD “.com” to the trademark SHINNECOCK does not distinguish the disputed domain name from the above-mentioned trademarks.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant contends that the Respondent has made no preparations to use the disputed domain name in connection with any *bona fide* offering of goods or services and submits that the Respondent has in no way been licensed or otherwise permitted by the Complainant to use the disputed domain name, nor is there any actual relationship between the Complainant and the Respondent.

Moreover, the Complainant highlights that the Respondent is not commonly known by the disputed domain name and is making an improper use of the same, by publishing hardcore pornography contents which are an anathema to the Complainant’s marks, considering the Complainant offers family friendly cultural celebrations and includes sacred religious ceremonies. The Complainant states that, in doing so, the Respondent is tarnishing the Complainant’s trademarks eroding their acquired goodwill.

The Complainant also underlines that the website to which the disputed domain name resolves, not only tracks very closely to the Wikipedia entry for “Shinnecock Indian Nation”, which would constitute plagiarism, but also contains inaccurate information, since three of the four posts, contain information about Asian Indians, who are completely unrelated to the Shinnecock Indian Nation.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, given the links to pornographic contents, the Respondent was undoubtedly acting in bad faith with the aim of tarnishing the Complainant’s trademarks.

The Complainant emphasizes that even the use of irrelevant information about Asian Indians and the plagiarism of the Wikipedia entry regarding the Complainant is further proof of bad faith use.

The Complainant also submits that the Respondent has engaged in a pattern of registering domain names corresponding to marks held by the Complainant and third parties since, in addition to the disputed domain name, the Respondent has registered <bancamerica.com.do>, corresponding to the trademark BANK OF AMERICA mark, and <formula3.co>, corresponding to the trademark FORMULA 3.

## **B. Respondent**

The Respondent did not submit a timely Response but only sent informal communications to the Center, after the lapse of the due date for the Response, in which it stated that the disputed domain name was not for sale and asserted that it legally registered the disputed domain name.

## **6. Discussion and Findings**

According to 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.” Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

## **6.1. Preliminary procedural issue: language of the proceeding**

Pursuant to paragraph 11(a) of the Rules, “unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”.

In the case at hand, the language of the Registration Agreement of the disputed domain name is Spanish. The Complaint was filed in English. Upon completing the Registrar’s verifications, the Center sent an email communication to the parties about the language of the proceeding requesting them to comment on the issue.

The Complainant submitted a request for English to be the language of the proceeding, stating that the Respondent is able to understand and communicate in English in view of the registration of the disputed domain name encompassing the English term nation and its redirection to a website drafted entirely in English. The Complainant also underlines that the Respondent registered the additional domain name <formula3.co>, which is likewise pointed to a website in English.

The Respondent did not submit any comment about the language of the proceeding, but sent email communications to the Center in Spanish after the response due date.

In view of the circumstances of the case, the Panel finds that English is the appropriate language of this proceeding and will thus proceed to render the Decision in English.

## **6.2. Substantive issues.**

### **A. Identical or Confusingly Similar**

The Complainant in this case relies on common law rights on the SHINNECOCK Marks.

As stated in section 1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), “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. [...] 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.”

The Panel has reviewed the documents and statements submitted by the Complainant and finds that they are sufficient to establish common law rights on the SHINNECOCK Marks for the purpose of standing in this proceeding. Indeed, the Complainant’s SHINNECOCK Marks have been used to identify the Complainant and its cultural and entertainment services for over 75 years.

As highlighted in section 1.7 of the [WIPO Overview 3.0](#), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. Moreover, as stated in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element.

The Panel notes that the core of the SHINNECOCK Marks, consisting of the term “Shinnecock”, is entirely reproduced in the disputed domain name, with the mere addition of the dictionary term “nation” and the gTLD

“.com”, which is commonly disregarded under the first element confusing similarity test (section 1.11 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the disputed domain name is confusingly similar to trademarks in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

“(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 Panel finds that the Complainant has made a *prima facie* case and that the Respondent, by not having submitted a Response, has failed to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy for the following reasons.

According to the evidence on record, there is no relationship between the Complainant and the Respondent and the Complainant has not authorized the Respondent to register or use its trademark or the disputed domain name.

Furthermore, there is no indication before the Panel that the Respondent might be commonly known by the disputed domain name.

As mentioned above, the disputed domain name has been pointed to a website publishing information on the SHINNECOCK NATION taken from the Wikipedia website along with other non-pertinent information related to Asian Indians and links throughout the text that lead directly to adult content websites. The Panel finds that the Respondent’s use does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant and its trademarks.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(a)(iii) of the Policy requires that the Complainant proves that the disputed domain name was registered and is being used by the Respondent in bad faith.

As to bad faith at the time of the registration, the Panel notes that, in light of use of the SHINNECOCK Marks over the last 75 years to identify the Complainant and its cultural and entertainment services, the Respondent, was likely aware of the Complainant’s SHINNECOCK Marks when registering the disputed domain name. Noting the nature of the disputed domain name, which comprises the Complainant’s mark, the Panel also finds that the Respondent would have been aware that its composition is solely connected with the Complainant, and consequently that the disputed domain name itself is inherently misleading.

Moreover, in light of the information published on the website to which the disputed domain name resolves, the Respondent was clearly aware of the Complainant and, in all likelihood, also of the Complainant's cultural and entertainment services provided under the SHINNECOCK Marks.

As mentioned above, the Respondent has pointed the disputed domain name to a website providing information about the Complainant along with unrelated information regarding Asian Indians. The Panel notes that the Respondent embedded throughout the text links to pornographic websites where also sponsored advertisements are displayed. The Panel finds that such use of the disputed domain name amounts to bad faith under paragraph 4(b)(iv) of the Policy, since the Respondent intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website and the websites linked thereto.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to 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, <shinnecocknation.com> be transferred to the Complainant.

*/Luca Barbero/*

**Luca Barbero**

Sole Panelist

Date: February 23, 2023