

## **ADMINISTRATIVE PANEL DECISION**

J A KEMP LLP v. Frank Tanner

Case No. D2024-2743

### **1. The Parties**

The Complainant is J A KEMP LLP, United Kingdom, represented by Aaron Newell, United Kingdom.

The Respondent is Frank Tanner, United Kingdom.

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

The disputed domain name <jakemp.org> is registered with IONOS SE (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 4, 2024. On July 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 8, 2024, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 9, 2024, 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 September 27, 2024. The proceeding was suspended on July 11, 2024, upon the Complainant’s request and then reinstated on October 7, 2024.

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, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 29, 2024.

The Center appointed Jane Lambert as the sole panelist in this matter on November 4, 2024. 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 well-known firm of patent and trade mark attorneys founded in 1947 and practicing from offices in London, Oxford, Cambridge, Paris and Munich. It registered J A KEMP with the United Kingdom Intellectual Property Office under trade mark number UK00916621559 for services in classes 35 and 45 on September 20, 2017, with effect from April 20, 2017. It has also registered that mark in other jurisdictions. Particulars of the Complainant's registrations are appended to the Amended Complaint in Annex 4. The Complainant has a website at "www.jakemp.com".

The disputed domain name was registered on January 9, 2023. At the time of filing the Complaint, the disputed domain name redirected to the Complainant's above-mentioned website.

#### **5. Parties' Contentions**

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

The Complainant requests the transfer of the disputed domain name in these proceedings on the grounds that it has satisfied each of the elements required under the Policy for such a transfer.

Notably, the Complainant contends that:

- The disputed domain name is identical or at least confusingly similar to a trade mark in which the Complainant has rights;
- The Respondent has no rights or legitimate interests in the disputed domain name; and
- The disputed domain name has been registered and is being used in bad faith.

As for the first element, the Complainant submits that the disputed domain name contains the trade mark J A KEMP in its entirety with no other distinctive matter if the Top-Level domain name (the ".org" suffix) is disregarded.

Turning to the second element, the Complainant alleges that the following are strong indications of the Respondent's lack of rights or legitimate interests in the disputed domain name:

- a) the Respondent is not commonly known by the disputed domain name and has not acquired any trade mark or service mark rights corresponding to the disputed domain name; and
- b) the Respondent is not making legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to divert misleadingly consumers or to tarnish the trade mark at issue; and
- c) the Respondent is not authorized, licensed or otherwise permitted to use the Complainant's trade mark rights in any way.

Having raised a reasonable presumption that the Respondent has no rights and/or legitimate interests in the disputed domain name, the Complainant submits that it is for the Respondent to rebut that presumption.

Regarding the third element, the Complainant argues that the disputed domain name should be considered as having been registered and used in bad faith by the Respondent for any or all of the following reasons:

- a) By registering and using the disputed domain name, the Respondent has taken unfair advantage of, abused, or otherwise engaged in behavior detrimental to the Complainant's trade mark;
- b) The disputed domain name was registered and used for the purposes of promoting a business that offers products and/or services that compete with those of the Complainant;
- c) The disputed domain name was registered in full knowledge of the Complainant's rights and knowingly registered without authorization of the Complainant in order to be exploited for the commercial purposes of the Respondent and to the detriment of the Complainant; and
- d) By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 the respondent's website or location or of a product or service on the respondent's website or location.

## **B. Respondent**

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

## **6. Discussion and Findings**

The agreement by which the Respondent registered the disputed domain name (a copy of which is appended to the Complaint as Annex 2) incorporates paragraph 4(a) of the Policy:

"Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

- (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
  - (ii) you have no rights or legitimate interests in respect of the domain name; and
  - (iii) your domain name has been registered and is being used in bad faith.
- In the administrative proceeding, the complainant must prove that each of these three elements are present."

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4 (a) (iii) of the Policy, paragraph 4 (b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has given to its Registrar a postal address in the same street as the Complainant’s London office and that the disputed domain name has been redirecting traffic to the Complainant’s site since at least August 23, 2023. The redirection of traffic and the choice of that postal address indicates that the Respondent is aware of the Complainant’s identity and business. There is also an implied warning that traffic that had been directed to the Complainant’s site can just as easily be diverted elsewhere.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Complainant submits inter alia that Paragraph 4(b)(iv) applies. The Panel has already found that the disputed domain name is identical to the Complainant’s trade mark. It follows that the Respondent has thereby created a likelihood of confusion with the Complainant’s mark as to the source, sponsorship or affiliation of the online location to which it has intentionally attempted to attract Internet users. Although there is no express commercial gain it may reasonably be inferred that the Respondent selected the disputed domain name with a deliberate intent to create confusion with the Complainant. The Panel therefore accepts the Complainant’s submission.

The disputed domain name currently doesn’t resolve to an active website. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant’s trade mark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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 <jakemp.org> be transferred to the Complainant.

*/Jane Lambert/*

**Jane Lambert**

Sole Panelist

Date: November 14, 2024