

## **ADMINISTRATIVE PANEL DECISION**

Budage Pty Ltd v. Barrie Shaw  
Case No. D2025-1029

### **1. The Parties**

The Complainant is Budage Pty Ltd, Australia, represented by Clayton Utz Solicitors, Australia.

The Respondent is Barrie Shaw, Tuvalu.

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

The disputed domain name <claytonutzlaw.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 13, 2025. On March 13, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Registration Private, Privacy service provided by Domains by Proxy LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 14, 2025, 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 March 18, 2025.

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 April 1, 2025. In accordance with the Rules, paragraph 5, the due date for Response was April 21, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 23, 2025.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on May 1, 2025. 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 special purpose vehicle established by the Australian law firm partnership that trades under the name Clayton Utz. The Complainant is wholly owned in equal share by the Chief Executive Partner and Deputy Chief Executive Partner of Clayton Utz and provides, amongst others, marketing, promotional and business development services to Clayton Utz pursuant to a service agreement.

The Complainant is the owner of the following marks:

- CLAYTON UTZ (word), Australian registration No. 1348381, registered on March 3, 2010, for goods and services in classes 9, 35, 36, 41 and 45;
- CLAYTON UTZ (figurative), Australian registration No. 826782, registered on March 8, 2000, for goods and services in classes 9, 35, 41 and 42.

The CLAYTON UTZ trademarks are used to distinguish legal and related services by the Australian law firm Clayton Utz, pursuant to a license agreement with the Complainant.

The Complainant is also the administrative and technical contact for the domain name <claytonutz.com>, registered on September 22, 1997 and used as the official website of the Clayton Utz law firm.

The Respondent is an individual, allegedly located in Tuvalu. The disputed domain name was registered on May 11, 2022 and resolves to a website advertising the provision of legal services under the trademark CLAYTON UTZ.

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

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

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the Complainant's CLAYTON UTZ mark as it incorporates it entirely and the addition of the term "law" adds to the confusion of the disputed domain name with the Complainant's mark.

The Complainant further contends that the Respondent lacks rights or legitimate interests in the disputed domain name. The Complainant did not authorize the Respondent to register and use a domain name incorporating its CLAYTON UTZ mark. Moreover, to the best of the Complainant's knowledge, the Respondent does not appear to have been commonly known by the disputed domain name. According to the Complainant, the Respondent is using the disputed domain name to impersonate the Complainant to misleadingly divert consumers for commercial gain and tarnish the Complainant's mark.

Finally, the Complainant maintains that the CLAYTON UTZ mark is distinctive and unique. The law firm Clayton Utz has used this mark since at least 1924. The Respondent must have had the Complainant's mark in mind when registering the disputed domain name. At the time of the filing of the Complaint, the disputed domain name resolved to a webpage advertising the provision of legal services by an entity called "Clayton Utz Lawyers". The physical address on the website is the same address of the genuine Clayton Utz law office in Darwin, Australia, while the email address, which includes the disputed domain name, does not

belong to the Complainant. The website also includes an “enquiries” function. It is unclear where the enquires are directed. According to the Complainant, it is not a mail box affiliated with the Complainant or with the Clayton Utz law firm. The use of the disputed domain name to create deceptive email addresses and solicit business fraudulently from the Complainant’s potential clients is clearly an act of bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **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 Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, “law”, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

In particular, the Complainant did not authorize the Respondent to register and make use of its CLAYTON UTZ mark within the disputed domain name. The Respondent is neither an affiliate, nor a licensee of the

Complainant, nor has any other kind of relationship with the Complainant. Nothing in the case file indicates that the Respondent might have been commonly known by the disputed domain name.

The Respondent does not appear to use the disputed domain name in connection with a bona fide offering of goods or services, or for a legitimate noncommercial or fair use. The disputed domain name leads to a website displaying the title “Clayton Utz Lawyers” and a logo on the upper left side of the home page. At the top of the page, clearly visible, is once again the wording “Clayton Utz Lawyers” in capital letters below the much smaller wording, “Darwin Law Firm”, where “Darwin” is probably perceived as the name of the city where the “Clayton Utz Lawyers” are based (see below). The webpage promotes family law services stating that the law firm has over 30 years of experience. The address appearing at the bottom of the page is the same address of the law firm Clayton Utz in Darwin. The telephone number is also the same. Only the email address displayed on the webpage, which includes the disputed domain name, is not an email address of the Complainant. As the website is accessible through the disputed domain name, which reproduces the Complainant’s mark and includes the term “law”, which refers to the Complainant’s business, displays the words “Clayton Utz Lawyers” prominently, and promotes legal services, i.e., the same services provided by the Clayton Utz law firm associated with the Complainant, the disputed domain name and relevant website are clearly highly deceptive. The Respondent, whose name is different from Clayton Utz and who has not claimed connections with this name, is evidently impersonating the Complainant presumably to attract users to its website and promote family law services, which the Complainant does not offer to its clientele, or for some other non-legitimate use.

Panels have held that the use of a domain name for illegitimate activity, such as impersonation/passing off, or other types of fraud can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Accordingly, 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 Complainant’s mark is distinctive and exclusively associated with the Complainant and the associated law firm Clayton Utz. The Panel, in compliance with the general powers conferred to the Panel in paragraph 10 of the Rules, has performed some independent online research using the keyword “clayton utz”. It appears that the Australian law firm Clayton Utz is one of the six big Australian law firms, and the research has disclosed hits linked to the Complainant only.

Moreover, the disputed domain name includes the term “law”, which refers to the Complainant’s services. The disputed domain name resolves to a website displaying the Complainant’s trademark CLAYTON UTZ. The Respondent’s website promotes legal services. The address and telephone number appearing on the Respondent’s website are the same as those of the Clayton Utz law firm’s office in Darwin. All these circumstances are not coincidental and it is more than clear that the Respondent was aware of the Complainant and of its CLAYTON UTZ mark when it registered the disputed domain name.

The registration of a domain name identical to a third party’s distinctive trademark being aware of such trademark and without rights or legitimate interests amounts to registration in bad faith.

With respect to use in bad faith, as mentioned before, the Respondent is impersonating the Complainant through a misleading website, purportedly offering family legal services, which the Complainant does not provide, under the name of an unrelated Australian law firm operating since 1924. Accordingly, the Panel finds that, through the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s mark.

Panels have held that the use of a domain name for illegitimate activity, such as the one described above constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

Accordingly, 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 <claytonutzlaw.com> be transferred to the Complainant.

*/Angelica Lodigiani/*

**Angelica Lodigiani**

Sole Panelist

Date: May 15, 2024