

ADMINISTRATIVE PANEL DECISION

Sidley Austin LLP v. Antonella Biaggiotti, Biaggiotti Co
Case No. DCO2023-0061

1. The Parties

The Complainant is Sidley Austin LLP, United States of America ("United States"), represented internally.

The Respondent is Antonella Biaggiotti, Biaggiotti Co, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <sidleyllp.co> is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 9, 2023. On July 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 11, 2023, 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 Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 25, 2023, 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 July 30, 2023.

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 August 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 22, 2023.

The Center appointed Alistair Payne as the sole panelist in this matter on August 30, 2023. 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 long established law firm based in the United States and one of the largest law firms in that country. The Complainant was known as Sidley & Austin from 1967 onwards and then Sidley Austin Brown & Wood from 2001. Since 2006, the firm has been known as Sidley Austin LLP and has been commonly known as Sidley and Sidley Austin. The names “Sidley” and “Sidley Austin” are used by a number of affiliated partnerships, including the Complainant, each of which is affiliated with Sidley Austin Holding LLP, which owns the mark SIDLEY and registered it with the United States Patent and Trademark Office under registration number 3,328,229 on November 6, 2007. The Complainant first registered its domain name <sidley.com> on April 26, 1995. It also owns the domain name <sidleyllp.com> which it registered on December 14, 2017.

The disputed domain name was registered on June 29, 2023 and resolves to a website which has links to other legal websites unaffiliated with the Complainant, including various law firm sites.

5. Parties’ Contentions

A. Complainant

The Complainant submits that it owns registered trade mark rights as set out above and that the disputed domain name is confusingly similar to its SIDLEY trade mark and is confusingly similar as a result. It says that the addition of “llp”, being the common abbreviation for a limited liability partnership does not prevent a finding of confusing similarity.

The Complainant submits that there is no evidence that the Respondent uses the disputed domain name, or that it uses, or has ever used, a name or trade mark corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. The Complainant also says that it does not employ and has never employed the Respondent and has not authorised the Respondent to make use of the SIDLEY trade mark. In addition, says the Complainant, the Respondent is not making any legitimate noncommercial or fair use of the disputed domain name. On the contrary, the disputed domain name contains no content other than generic links to third-party websites relating to, among other items “Law Office,” “Lawyer,” and “Legal Attorneys.” This it says does not give rise to any rights or legitimate interests in the disputed domain name.

As far as bad faith is concerned the Complainant says that the disputed domain name is identical to the Complainant’s widely known mark and that as the Respondent is not affiliated with the Complainant, then bad faith registration can and should be presumed.

The Complainant notes that the Respondent appears to have provided a fake address and company to the Registrar upon registration of the disputed domain name. It submits that based on its search results neither “Biaggiotti” nor “Biaggiotti Co” return any results in a search of the Companies House and that the address, the Respondent listed is an incomplete address and that no such entity exists at the listed address. It says that the use of a fake address in combination with the use of a privacy service, supports a finding of registration in bad faith.

Further, submits the Complainant, the Respondent’s bad faith is further demonstrated by the fact that the links maintained at the disputed domain name divert visitors to other legal websites unaffiliated with the Complainant, including various law firm sites. This says the Complainant amounts to evidence of bad faith registration and use of the disputed domain name under the Policy.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns registered trade mark rights for its SIDLEY trade mark as set out above. The disputed domain name wholly incorporates the SIDLEY mark and is therefore confusingly similar to it. The addition of the letters “llp”, which is an abbreviation for limited liability partnership, does not prevent a finding of confusing similarity. As a result, the Panel finds that the Complaint succeeds under this element of the Policy.

B. Rights or Legitimate Interests

The Complainant has submitted that there is no evidence that the Respondent uses the disputed domain name, or that it uses or has ever used a name or trade mark corresponding to the disputed domain name, in connection with a *bona fide* offering of goods or services. The Complainant has also said that it does not employ and has never employed the Respondent and has not authorised the Respondent to make use of the SIDLEY trade mark. In addition, the Complainant has asserted that the Respondent is not making any legitimate noncommercial or fair use of the disputed domain name. Rather, the Complainant has asserted that the website at the disputed domain name contains no content other than generic links to third-party websites relating to, among other items “Law Office,” “Lawyer,” and “Legal Attorneys.” The Respondent has failed to respond to, or to rebut the Complainant’s case, or to respond to the Complainant’s cease and desist letter to explain its registration of the disputed domain name.

The Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Panel therefore finds that the Complaint also succeeds under this element of the Policy.

C. Registered and Used in Bad Faith

The disputed domain name was registered in mid 2023, many years after the Complainant registered its SIDLEY mark and registered its own domain name <sidley.com> in 1995. The SIDLEY mark is highly distinctive and the Complainant’s legal firm is a very large firm with an international reputation. As a result, the Panel finds it more likely than not that the Respondent was well aware of the Complainant’s SIDLEY mark when it registered the disputed domain name.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of the disputed domain name in bad faith where a Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s trademarks as to the source, sponsorship, affiliation or endorsement of the website.

The disputed domain name diverts Internet users searching for the Complainant’s name to a website that features links to legal websites unaffiliated with the Complainant, including to various law firm’s sites. In this regard Internet users seeking the Complainant’s site are potentially confused when they reach site at the Respondent’s website which features links to other law firms and legal entities and it is most likely that the Respondent benefits commercially as a result, all of which fulfills the requirements of paragraph 4(b)(iv) of the Policy and amounts to evidence of registration and use in bad faith. The Panel’s view of the Respondent’s bad faith is further reinforced by the Respondent’s apparent use of a fake address and company details for the purposes of registration of the disputed domain name.

Accordingly, the Panel finds that the disputed domain name has been registered and used in bad faith and that the Complaint also succeeds under this 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, <sidleylp.co>, be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: September 13, 2023