

ADMINISTRATIVE PANEL DECISION

The Society of Trust and Estate Practitioners Limited v. Adam Robert
Case No. D2024-0089

1. The Parties

The Complainant is The Society of Trust and Estate Practitioners Limited, represented by Shakespeare Martineau LLP., United Kingdom.

The Respondent is Adam Robert, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <stepjournal.org> (the “Disputed Domain Name”) is registered with Porkbun LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 10, 2024. On January 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On January 11, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 15, 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 January 16, 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 January 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 6, 2024. Due to an apparent issue with the notification, the Center granted the Respondent an extra ten-day period (e.g. through February 23, 2024) to indicate whether it wishes to participate to the proceeding. The Respondent did not submit any response.

The Center appointed Nick J. Gardner as the sole panelist in this matter on March 1, 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

In the absence of a Response the Panel accepts the following as the relevant factual background given it has been supported by evidence annexed to the Complaint.

The Complainant is an English company. It was incorporated on July 25, 1991 and is a global professional body that principally provides education programmes and support services to trust and estate practitioners. It has been trading under the name “STEP” since its incorporation in July 1991.

The Complainant is the registered owner of the following trademarks in the United Kingdom:

1. UK0002389972A for the series word mark STEP filed on April 20, 2005, and registered on January 2, 2009.
2. UK00801267352 for the word mark STEP filed on July 2, 2015 and registered on August 10, 2016.

These trademarks are referred to as the “STEP trademark” in this decision.

The Complainant publishes on its website which is linked to the domain name <step.org> a range of materials including articles and testimonials. These include its STEP journal, available by subscription and online at “<https://www.step.org/step-journal>” for all members, published six times a year, offering news, reviews, opinion and technical analysis on issues facing trust and estate practitioners internationally. The Complainant has on average 60,000 unique visitors per month to its website.

The Complainant originally held the Disputed Domain Name and used the Disputed Domain Name to point to a website on which the STEP Journal was made available (“Former STEP Journal Website”). In 2013, the Complainant migrated to a new platform, and in doing so, brought STEP Journal and the content from the Former STEP Journal Website onto the Complainant’s principal website which can be found at “<https://www.step.org/>”. Due to a change in personnel at the Complainant’s business, the Complainant understands the contents contained within the Former STEP Journal Website were not taken down and continued to be accessed using the Disputed Domain Name. A search of the WayBack Machine, the web archive search database, shows the Former STEP Journal website could be accessed from the Disputed Domain Name up to May 20, 2013. Following this, the Disputed Domain Name diverted all traffic to the Complainant’s dedicated journal page at “<http://www.step.org/journal>”. This appeared to have remained the case until November 2020, where the WayBack Machine shows the Disputed Domain Name started to point to a website which displayed the Complainant’s historic content, dating back to 2012 (the “Respondent’s Website”). It is to be inferred that at some point in this chronology prior to November 2020 the Complainant inadvertently allowed the Disputed Domain name to lapse and it was acquired by the Respondent. From at least January 2022, the Respondent’s Website included in its header bar a link to a Japanese gambling/betting website. The Complainant has verified the content on the Respondent’s Website is derived from their material but the links to a gambling website has been added and is not associated with the Complainant. The Disputed Domain Name now no longer resolves to an active website.

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 fact the Respondent is using the Disputed Domain Name to resolve to the Respondent's Website which includes material derived from the Complainant, and also a link to gambling websites, cannot amount to a legitimate interest and is evidence of registration and use in bad faith.

B. Respondent

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

6. Discussion and Findings

Preliminary Matters

The Panel notes that no communication has been received from the Respondent. However, given the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel considers that this satisfies the requirement in paragraph 2(a) of the UDRP Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent's failure to file any Response. While the Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant, the Panel may draw appropriate inferences from the Respondent's default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

- (i) the Disputed Domain Name is identical with 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;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

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 rights in the STEP trademark. The Panel finds the Disputed Domain Name is confusingly similar to this trademark. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy "when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name" (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). It is established that, where a mark is recognizable within a disputed domain name, the disputed domain name is considered to be confusingly similar to the registered mark.

It is also established that the addition of a term (such as here "journal") to a disputed domain name does not prevent a finding of confusing similarity under the first element (*PRL USA Holdings, Inc. v. Spiral Matrix*, WIPO Case No. [D2006-0189](#)).

It is also well established that the generic Top-Level Domain ("gTLD"), in this case ".org", does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar to the Complainant's trademark. See, for example, *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#).

Accordingly the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

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.

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

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

- (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 web site 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 your web site or location or of a product or service on your web site or location.

The Panel is not entirely sure which if any of these factors applies. The Respondent's Website comprised a mix of historical content taken without authorization from the Complainant together with an added link to a Japanese gambling website. It seems unlikely that Internet users who are looking for the Complainant or its journal are going to be interested in the Japanese gambling link. It may be that the Respondent is engaged in deriving some sort of search optimisation benefit by linking the Respondent's Website to another website but the Panel cannot be certain that is the case. However the Panel notes that in any event the list paragraph 4(b) of the Policy is non exhaustive and takes the view that the registration of the Disputed Domain Name with knowledge of the Complainant's trademark (which the Respondent must have had given he has replicated material derived from the Complainant within the Respondent's Website) is itself evidence of bad faith - see *The Channel Tunnel Group Ltd. v. John Powell*, WIPO Case No. [D2000-0038](#). This is particularly so given that the Respondent has not provided any explanation for his conduct in acquiring the Disputed Domain Name and including the Complainant's material within the Respondent's Website.

Accordingly the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith. Accordingly the third condition of paragraph 4(a) of the Policy has been fulfilled.

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 <stepjournal.org> be transferred to the Complainant.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: March 15, 2024