

## **ADMINISTRATIVE PANEL DECISION**

Shulem Deen v. Anna Sakidon  
Case No. D2022-3986

### **1. The Parties**

The Complainant is Shulem Deen, United States of America (“United States”), represented by Kaufman & Kahn, LLP, United States.

The Respondent is Anna Sakidon, Georgia.

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

The disputed domain name <shulemdeen.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 24, 2022. On October 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 25, 2022, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 31, 2022, 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 November 1, 2022.

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 November 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 28, 2022.

The Center appointed John Swinson as the sole panelist in this matter on December 7, 2022. 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 an author, writer, coach, and speaker from Brooklyn, New York. He serves as a board member at Footsteps, a New York City-based organization that offers assistance and support to former members of the ultra-Orthodox Jewish community.

The Complainant originally owned the disputed domain name. The Complainant registered the disputed domain name in 2014 and used it from that date.

According to the Complaint, the Complainant also owned around twenty other domain names and sometime in 2019, he uploaded them to AfterNIC.com for sale. The disputed domain name was included in that list, but the Complainant choose a checkbox option that AfterNIC provided for "Do Not List For Sale." The Complainant reasonably understood that to mean that AfterNIC would not sell the disputed domain name. Despite the "Do Not List For Sale" designation, ICANN Whois records show that on or about October 25, 2021, the Respondent purchased the disputed domain name. AfterNIC reported the sale was for USD 500. Despite Complainant's request to rescind the transaction, AfterNIC refused to do so.

The website at the disputed domain name has the same content that was on the Complainant's website. It looks like a website created by the Complainant and has biographical and other information about the Complainant. Unlike the Complainant's original website, it also includes third party advertisements.

The Respondent did not file a Response, so little is known of the Respondent. The Registrar's records give an address for the Respondent in Tbilisi, Georgia. The email contact for the Respondent is a Gmail address with the name of a Mr. Effinger.

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

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

In summary, the Complainant makes the following submissions:

The Complainant has common law trademark rights in his personal name. The Complainant started writing and publishing in 2003 under a pseudonym, and started to publish under his own name and establish rights in the SHULEM DEEN trademark starting in 2010, eleven years before the Respondent without authorization purchased and took control of the disputed domain name in 2021.

The Complainant is a renowned author whose work, in connection with the SHULEM DEEN trademark, has been published in prominent publications including the New York Times, Forward, The New Republic, and many others.

The Complainant registered the disputed domain name on February 27, 2014, and it was accidentally sold to the Respondent for USD 500.

The disputed domain name is virtually identical to the Complainant's SHULEM DEEN trademark.

There is no evidence of the Respondent's 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 because the website at the disputed domain name infringes the Complainant's copyright. The Respondent

has not been commonly known by the disputed domain name. The Respondent has acquired no relevant trademark or service mark rights.

The disputed domain name is used in connection with a website that is virtually identical to the website that the Complainant used before the disputed domain name was “hijacked” by the Respondent – including a photograph of the Complainant and links to articles he wrote.

## **B. Respondent**

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

## **6. Discussion and Findings**

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

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

The *onus* of proving these elements is on the Complainant even though the Respondent failed to submit a Response.

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

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

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant does not own any relevant registered trademarks. The Complainant relies upon common law trademark rights and the Complainant is entitled to so under the Policy. The Complainant has provided evidence that the Complainant has been using SHULEM DEEN as a trademark since at least 2015 and that this trademark is known in publishing circles. For example, the Complainant’s book *All Who Go Do Not Return* was reviewed or referred to in New York Times, The New Yorker, Wall Street Journal, The Washington Post, The New Republic, Chicago Tribune, Minneapolis Star Tribune, The Boston Globe, Maclean’s Magazine, Ha’aretz, The Jerusalem Post, The Jewish Week, and many others. The Panel finds that the Complainant has established common law trademark rights for purposes of the UDRP. See *Marian Keyes v. Old Barn Studios Ltd*, WIPO Case No. [D2002-0687](#).

The disputed domain name includes the Complainant’s SHULEM DEEN trademark in its entirety.

The Panel accordingly concludes that the disputed domain name is confusingly similar to the Complainant’s SHULEM DEEN trademark, disregarding the Top-Level Domain “.com”.

The fact that the Respondent is targeting the Complainant’s trademark (as discussed below) supports the Complainant’s position, in that this assists in demonstrating that its trademark has achieved significance as a source identifier.

The Complainant succeeds on the first element of the Policy in relation to the disputed domain name.

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

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The *onus* of proving this requirement, like each element, falls on the Complainant. Previous UDRP panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden of production will shift to the respondent to rebut that *prima facie* case.

The Complainant asserts that there is no evidence of the Respondent's 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 because the website at the disputed domain name infringes the Complainant's copyright, that the Respondent has not been commonly known by the disputed domain name, and the Respondent has acquired no relevant trademark or service mark rights.

The Complainant has established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the disputed domain name and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the disputed domain name.

The Respondent has failed to produce any evidence to establish her rights or legitimate interests in the disputed domain name. Accordingly, the Panel finds that none of the circumstances listed in paragraph 4(c) of the Policy apply in the present circumstances, and that the Respondent has no rights or any legitimate interests in the disputed domain name.

The Complainant succeeds on the second element of the Policy in relation to the disputed domain name.

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

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain name in bad faith.

The Respondent's conduct demonstrates the Respondent's knowledge of the Complainant and his trademark. *Legislator 1357 Limited, Legislator 1358 Limited, Ian Fleming Limited v. Alberta Hot Rods*, WIPO Case No. [D2008-0832](#); *The Tolkien Estate Limited v. Domain Investments / Matthew Jensen*, WIPO Case No. [D2021-2571](#).

The Respondent did not file a Response. Possibly, the Respondent could have argued that because the Respondent purchased the disputed domain name when it was (accidentally) listed for sale by the Complainant, the Respondent could not have registered the disputed domain name in bad faith. However, the Respondent's conduct after registering the disputed domain name strongly suggests that the Respondent did not have good motives when purchasing the disputed domain name.

The Respondent is using the Complainant's SHULEM DEEN trademark, name and writings to attract traffic to the website at the disputed domain name where unlike the Complainant's original website there is also third party advertisements. The Respondent's conduct is a probable attempt to create a likelihood of confusion with the Complainant for commercial purposes.

It is also relevant that the website at the disputed domain name includes copies of the Complainant's writings and his photograph, which very well could be copyright infringements. Compare *Mr. Gordon Ramsay v. Kushnarenko Oleksij*, WIPO Case No. [D2021-0145](#).

The Panel concludes that the Respondent specifically knew of and targeted the Complainant and that the Respondent is attempting to trick the public into believing that the website at the disputed domain name is associated with the Complainant. In short, the Panel concludes that the Respondent registered and is using the disputed domain name to take advantage of the Complainant's reputation and SHULEM DEEN trademark. *Block.one v. See PrivacyGuardian.org / Burstein-Applebee, Jerry K. Chasteen*, WIPO Case No. [D2021-1516](#).

The Complainant succeeds on the third element of the Policy in relation to the disputed domain name.

## 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 <shulemdeen.com> be transferred to the Complainant.

*/John Swinson/*

**John Swinson**

Sole Panelist

Date: December 21, 2022