

## **ADMINISTRATIVE PANEL DECISION**

**Pestalozzi Attorneys-at-Law Ltd. v. Jakub Jankowski**  
**Case No. DCO2022-0036**

### **1. The Parties**

The Complainant is Pestalozzi Attorneys-at-Law Ltd., Switzerland, internally represented.

The Respondent is Jakub Jankowski, Poland.

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

The disputed domain name <pestalozzilaw.co> is registered with Key-Systems GmbH (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 3, 2022. On May 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 5, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on May 6, 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 May 9, 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 May 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 8, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on June 17, 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 one of the leading law firms in Switzerland, founded over 110 years ago. In addition to that, the Complainant operates its official website under the domain name <pestalozzilaw.com>, and is the owner of the following trademark registrations:

- Swiss trademark registration No. 577391 for PESTALOZZI ATTORNEYS AT LAW, registered on October 1, 2008, in classes 16, 35, 36, 41 and 45;

- Swiss trademark registration No. P-567101 for PESTALOZZI ATTORNEYS AT LAW, registered on January 23, 2008, in classes 16, 35, 36, 41 and 45; and

- Swiss trademark registration No. P-567103 for PESTALOZZI ATTORNEYS AT LAW, registered on January 23, 2008, in classes 16, 35, 36, 41 and 45.

The disputed domain name was registered on October 26, 2021, and presently does not resolve to an active webpage.

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

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

The Complainant asserts to be one of the oldest and, today, major Swiss commercial law firms, having gained extensive recognition in business and legal circles widely beyond Switzerland given its international activities.

Under the Complainant's view, the disputed domain name is confusingly similar to its name (Pestalozzi Attorneys-at-Law Ltd), trademark (PESTALOZZI ATTORNEYS AT LAW) and prior domain name registrations (notably <pestalozzilaw.com>) given that it reproduces the distinctive PESTALOZZI element in conjunction with the term "law" that describes the Complainant's field of activity, only differing from the Complainant's official website in its Top-Level Domain.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name given that:

- (a) the Respondent is not currently and has never been known under the Pestalozzi name;
- (b) the Respondent is not related to the Complainant's business, is not one of its agents and does not have any business with it;
- (c) the Respondent cannot plausibly make a *bona fide* use of the disputed domain name given that, to the best of Complainant's knowledge there is no other law firm in the world who would be active under the Pestalozzi name; and
- (d) there is a high risk that the disputed domain name will be used in an illegal or fraudulent manner.

As to the registration of the disputed domain name in bad faith, the Complainant asserts that the Respondent was evidently targeting the Complainant given the high degree of distinctiveness of the PESTALOZZI brand and its reputation. In addition to that, the Respondent, who seems to be domiciled in Poland, was hiding behind a privacy shield and has provided what appears to be false contact details (Annex 12 to the Amended

Complaint). Lastly, the Complainant argues that there is implausibility of any good faith use to which the disputed domain name may be put, having the Complainant in the past already been the victim of a similar case in which fraudulent emails were sent from another infringing domain name (WIPO Case No. [D2019-1345](#), *Pestalozzi Attorneys-at-Law Ltd. v. Name Redacted*).

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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 Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

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

The Complainant has established rights in the PESTALOZZI ATTORNEYS AT LAW trademark duly registered.

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

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. The first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent's rights to or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice 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, in spite of not having acquired 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.

The Respondent, in choosing not to respond, has failed to invoke any of the circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to and/or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden is still on the Complainant to first make a *prima facie* case against the Respondent (being the overall burden of proof always with the Complainant, but once the 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).

In that sense, the Complainant indeed states that the Respondent is not related to the Complainant's business, is not one of its agents, and does not have any business with it.

Also, the absence of any indication that the Respondent holds rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or a webpage relating to the disputed domain name available at the disputed domain name, corroborate with the Panel's finding of the absence of rights or legitimate interests.

Therefore, the Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name. The second element of the Policy has also been met.

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

This case presents the following circumstances which indicate under the balance of probabilities bad faith registration and use of the disputed domain name:

- a) the Complainant is a prestigious and long-established law firm with an international reach, being its name and registered trademark well known;
- b) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name;
- c) the present inactive use of the disputed domain name indicates the Respondent's bad faith; and
- d) the indication of what appears to be false contact details (Annex 12 to the Amended Complaint).

Further, previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

For the reasons above, the Respondent's conduct has to be considered, in this Panel's view, as bad faith registration and use of 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 <pestalozzilaw.co> be transferred to the Complainant.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: June 30, 2022