

## **ADMINISTRATIVE PANEL DECISION**

Staten Island Oral and Maxillofacial Surgery, PC v. Jamie Licznanski  
Case No. D2024-0961

### **1. The Parties**

Complainant is Staten Island Oral and Maxillofacial Surgery, PC, United States of America (“United States”), represented by Sisun Law, United States.

Respondent is Jamie Licznanski, United States, represented by Brian J. Cali & Associates, United States.

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

The disputed domain name <statenilandoralsurgery.com> (hereinafter the “Disputed Domain Name”) is registered with GoDaddy Online Services Cayman Islands Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 4, 2024. On March 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 7, 2024, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 Respondent of the Complaint, and the proceedings commenced on March 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 10, 2024. The Response was filed with the Center on April 10, 2024.

The Center appointed Lawrence K. Nodine, Lorelei Ritchie, and Evan D. Brown, as panelists in this matter on May 6, 2024. The Panel finds that it was properly constituted. Each member of 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.

## **Preliminary Question-Regarding Arbitration Clause in the Parties' Contract**

Respondent states in its response that the 2014 contract between the Parties, which governed their relationship until it was terminated in June 2023, includes a provision requiring that “[a]ny controversy or claim arising out of, or relating to this Agreement, or breach thereof, shall be settled by common law arbitration, which shall be conducted exclusively in Stroudsburg, Monroe County, Pennsylvania.” Neither Party here has commenced an arbitration proceeding pursuant to this clause and Respondent has not asked the Panel to stay these UDRP proceedings pursuant to this clause. Respondent expressly elected to have the dispute decided by a three-member panel and paid the extra fee required to do so.

Respondent has not requested a stay of these proceedings or commenced an arbitration proceeding. The Panel finds that it has authority to decide this case under the Policy without regard to the arbitration clause.

## **4. Factual Background**

Complainant Staten Island Oral and Maxillofacial Surgery, PC, a professional corporation registered in the state of New York, provides oral and maxillofacial services to clients in the New York region under the trademarks STATEN ISLAND ORAL & MAXILLOFACIAL SURGERY and STATEN ISLAND ORAL SURGERY (the latter is hereinafter referred to as the “Mark”). The record does not reflect the date Complainant began using Mark, but Complainant alleges with supporting evidence that it registered the Disputed Domain Name on August 21, 2003, and launched an associated website in 2004.

In August 2012, Complainant engaged Respondent to manage its website, taking over responsibility from a prior website management company — PBHS, Inc. During the transition from PBHS to Respondent, Respondent’s representatives asked Complainant for “GoDaddy login credentials.” (Complainant’s Annex 6) The record does not reflect delivery of the requested instructions, but the transfer was accomplished.<sup>1</sup>

The record also reflects an exchange of emails between PBHS and Complainant. The record is unclear, but it appears that Complainant had previously transferred ownership of the Disputed Domain Name to PBHS. PBHS asked Complainant to confirm its instructions “to transfer the domain out of your account” and advised that “we will send the transfer authorization (EPP) code to” Respondent. The record also reflects an email from GoDaddy to Respondent advising that “[t]he registrant of the [Disputed Domain Name] has initiated a process by which you [Respondent] will become the registrant.” (Complainant’s Annex 5)

Although the Disputed Domain Name was transferred to Respondent in 2012 pursuant to the apparent instructions, one of Complainant’s former employee doctors who was mentioned in the 2012 communications regarding the transfer of the Disputed Domain Name submitted a declaration attesting that he did not authorize Respondent to transfer the Disputed Domain Name to Respondent and that he did not receive an email from PBHS or Respondent requesting permission to transfer Disputed Domain Name. Complainant’s Annex 15.

Respondent managed Complainant’s website from 2012 until June 2023. Respondent sent Complainant invoices for its services. These invoices included a USD 25 charge for “1 year Domain lease”- for the Disputed Domain Name. (Complainant’s Annex 7) Complainant paid these invoices without objection.

In June 2023, Complainant terminated its website maintenance agreement with Respondent and then learned that it did not own the Disputed Domain Name. When Complainant requested a transfer of the

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<sup>1</sup>The GoDaddy agreement, provides: “When we receive a transfer request, we will call You to verify the transfer request. If we cannot reach You with seventy-two (72) hours of receipt of the transfer request, the transfer will be denied. If You do not provide the proper PIN, the transfer will be denied. When we receive a change of account request, we will call You to verify the change request. If we cannot reach You with seventy-two (72) hours of receipt of the change request, the change will be denied. If You do not provide the proper PIN, the change will be denied.” Complainant’s Annex 2, at p. 20.

Disputed Domain Name, Respondent requested a payment of USD 100,000 as consideration for the transfer. The Parties thereafter engaged in negotiations, and Respondent alleges that a compromise price of USD 35,000 was reached. Complainant did not pay the compromise price, however, but instead commenced these proceedings.

## **5. Parties' Contentions**

### **A. Complainant**

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name. Notably, Complainant contends that it never consented to transfer the Disputed Domain Name to Respondent and that Respondent fraudulently induced the transfer.

### **B. Respondent**

Respondent denies the allegation that it fraudulently induced Complainant to transfer the Disputed Domain Name. Respondent also contends that this is a contractual dispute that is outside the scope of the Policy.

## **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 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.

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.

Complainant has applied for a federal trademark registration, but the application has not been allowed and, therefore, has no legal significance at this time has no legal significance. However, the Panel finds Complainant has established unregistered trademark or service mark rights for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.3. Respondent does not contest Complainant's rights in the Mark. The Panel in particular finds that Complainant has used the Mark since at least 2003 and offers evidence that between January 2017 and August 2023, there were approximately 146,000 visitors to Complainant's website.

The entirety of the mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

### **B. Rights or Legitimate Interests; Registered and Used in Bad Faith**

In this case, it is appropriate to integrate discussion of Policy elements 4(a)(i) and 4(a)(iii). Since it acquired ownership of the Disputed Domain Name by transfer from Complainant 13 years ago, Respondent has permitted Complainant to use the Disputed Domain Name in exchange for an annual lease payment. There is nothing inherently illegitimate about owning a domain name that corresponds to the trademark of another and then leasing the domain name to the trademark owner, provided the trademark owner agrees to the arrangement. Here, the Parties dispute whether there was any such agreement. Consequently, the outcome of the second and third elements of the Policy both depend on the same question of fact. Did Complainant agree that Respondent would own the Disputed Domain Name?

Complainant alleges that it did not knowingly consent to transfer the Disputed Domain Name to Respondent and, further, that it did not understand that for 13 years thereafter it did not own the Disputed Domain Name but was instead only renting it. Complainant states that:

“Per GoDaddy requirements, only the domain name owner can transfer a domain to a third-party. To transfer a domain, the password and login information is required. Respondent had the requisite information to complete the transfer. On August 3, 2012, Respondent requested Complainant's GoDaddy password and web-host login information to allegedly perform authorized services including making edits to Complainant's website - at no point did Respondent inform Complainant that it would be transferring the domain name out of Complainant's account.” Complainant's Annex 6 and page 10 of the Complaint.

Respondent contests these allegations, asserting instead that “Complainant consented to the transfer of the Disputed Domain to Respondent.” Complainant's Annex 5 includes a 2012 email from GoDaddy to Respondent requesting consent to receive the Disputed Domain Name. The email states that “the registrant of the [following domain name(s) [listing the Disputed Domain Name] has initiated a process by which you [Respondent] will become the registrant of the [Disputed Domain Name].” (emphasis added). Respondent also notes that for 13 years Complainant paid invoices reciting an annual charge for a “lease” to the Disputed Domain Name.

Boiled down, Complainant alleges that Respondent fraudulently induced Complainant to consent to and facilitate the transfer of the Disputed Domain Name to Respondent. Respondent denies any such fraudulent conduct and emphasizes that Complainant paid invoices for the “lease” of the Disputed Domain Name.

The evidence is insufficient for the Panel to find by a preponderance of the evidence that Respondent fraudulently induced the transfer of the Disputed Domain Name. For this reason, the Panel finds that Complainant has not established the second and third element of the Policy, paragraphs 4(a)(ii) and 4(a)(iii).

Moreover, [WIPO Overview 3.0](#), section 4.14.6, provides that “in some instances (e.g., complex business or contractual disputes) panels have tended to deny the case not on the UDRP merits but on the narrow grounds that the dispute between the parties exceeds the relatively limited ‘cybersquatting’ scope of the UDRP, and would be more appropriately addressed by a court of competent jurisdiction.” The Panel finds this case fits in that category and provides an additional basis for the denial of the Complaint.

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Lawrence K. Nodine/*

**Lawrence K. Nodine**

Presiding Panelist

*/Lorelei Ritchie/*

**Lorelei Ritchie**

Panelist

*/Evan D. Brown/*

**Evan D. Brown**

Panelist

Date: May 20, 2024