

## **ADMINISTRATIVE PANEL DECISION**

Nativ Winiarsky v. Todd Bank  
Case No. D2025-0047

### **1. The Parties**

The Complainant is Nativ Winiarsky, United States of America (“United States”), represented by Kane Kessler, PC, United States.

The Respondent is Todd Bank, United States, self-represented.

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

The disputed domain name <nativwiniarsky.com> is registered with Wix.com Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 7, 2025. On January 8, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 14, 2025, 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 / Wix.com Ltd.) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 14, 2025, 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 18, 2025.

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 21, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 10, 2025. The Response was filed with the Center on February 1, 2025.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on February 7, 2025. 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.

On February 19, 2025, the Complainant submitted a Supplemental Filing, and on February 23, 2025, the Respondent replied with a Supplemental Filing.

#### 4. Factual Background

The Complainant is an attorney in New York City, New York, United States, practicing law since 1996, currently as a named partner in the law firm of Kucker Marino Winiarsky & Bittens, LLP. The firm operates a website at “www.kuckermarino.com”. According to his page on the law firm’s website, the Complainant typically represents landlords in commercial landlord-tenant litigation. The Complainant has no registered trademark but claims common law rights in his personal name as a “Trademark” associated with his professional services in the field of real estate law. The Complainant cites his authorship of legal articles and mentions in news articles and podcasts, which are documented in the record.

The Registrar reports that the disputed domain name was created on September 7, 2023, and is registered to the Respondent Todd Bank, an individual residing in the State of New York, United States, giving a contact email address with the domain name <toddbanklaw.com>. That domain name is associated with the Respondent’s website at “www.toddbanklaw.com” (the “Respondent’s professional website”) advertising the Respondent’s services as a New York lawyer representing plaintiffs in class actions concerning robocalls, unpaid rebates, email spam, and other consumer “annoyance” issues.

The disputed domain name resolves to a single-page website concerning the Complainant (the “Respondent’s criticism website”) headed with this sentence:

“Nativ Winiarsky is a Sleazy Lawyer Who Gets Disciplined and Sanctioned and Loses Cases.”

This is followed by a photo of the Complainant and a description of the website beginning with this sentence:

“Welcome to this non-defamatory website! It is a mix of opinion and truth, each of which is fully protected under the First Amendment to the United States Constitution.”

The Respondent’s criticism website then reproduces texts of published judicial decisions from 2012 and 2009 concerning the Complainant’s conduct in two housing court cases, as well as the texts of four more recent appellate decisions in which it appears that the Complainant’s clients did not prevail. These are accompanied by the Respondent’s disparaging comments such as, “Mr. Winiarsky claims, on his law firm’s web site, to have ‘an established reputation as an extremely competent ... litigator,’ but as you can see below, this insecure fool doesn’t win them all”.

The Respondent does not identify himself as the website operator on the Respondent’s criticism website. There is no copyright notice, “About” page, or “Contact” feature.

The Respondent’s criticism website also charges that someone (“say, Mr. Winiarsky”) bringing an “obviously frivolous lawsuit” for defamation against the operator of the criticism website “could result in sanctions and disciplinary action”. This is apparently a swipe against the Complainant for filing a defamation lawsuit in New York concerning the Respondent’s criticism website, before the Respondent’s identity was made known in the current UDRP proceeding. *Nativ Winiarsky v. John Doe aka Wix.com User*, No. 150080/2025 (NY Supreme Court, County of New York, Complaint, January 2, 2025).

## 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 disputed domain name is "nearly identical" to his claimed common law mark NATIV WINIARSKY and asserts that the Respondent has no rights or legitimate interests in the mark, as the Respondent has no connection with the Complainant, and there is no evidence that the Respondent is commonly known by a corresponding name or has used it in connection with a bona fide offering of goods or services.

The Complainant argues "on information and belief" that the Respondent registered the disputed domain name in bad faith to disrupt the business of the Complainant. The Complainant also attaches the civil complaint for defamation mentioned on the Respondent's criticism website. That complaint seeks an injunction to remove defamatory statements from the Respondent's criticism website and from any other online sites, as well as from search engines. The New York judicial proceeding evidently is pending at the time of this Decision.

### B. Respondent

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name. The Respondent contends that the Complainant has not established common law trademark rights in his personal name, as he does not provide his services independently of the law firm Kucker Marino Winiarsky & Bittens, LLP. The Respondent observes that the Complainant advertises his services only on his law firm website, and there is no evidence that the Complainant enters into contracts or receives payments for legal services in the name of "Nativ Winiarsky" rather than in the name of his law firm. The Respondent cites *Joseph Leccese v. Crystal Cox*, WIPO Case No. [D2011-0679](#) ("Joseph Leccese"), where the panel found that a lawyer who practiced as a partner in a New York law firm and was frequently mentioned in media articles as well as in billings to clients nevertheless failed to establish common law trademark rights in his personal name:

"The record before the Panel suggests that Complainant is a highly respected, prominent lawyer who is a partner with a major law firm. There is insufficient evidence here that Complainant markets or provides services independently of the Proskauer law firm. Rather, it appears that the Proskauer firm is the platform on which Complainant provides his legal services.

Nor is there any evidence of record that Complainant has spent money advertising his name apart from the Proskauer firm, or billed clients in his own name. Further, there is insufficient evidence in the record that the legal community regards Complainant as the driving force behind, or alter ego of, the Proskauer firm."

The Respondent contends that the Complainant here is in a similar position and cannot successfully assert common law rights in his personal name.

The Respondent argues that in any event he has rights or legitimate interests in using the disputed domain name for a genuine criticism site. The Respondent recognizes that this nominative fair use is often found not to extend to a disputed domain name that is identical to the Complainant's claimed mark, as is the case here, because of the risk of impersonation. However, the Respondent points to decisions where panels have found fair use in proceedings involving parties exclusively located in the United States, where critical free expression is protected by the First Amendment of the United States Constitution. The Respondent cites in support the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 2.6.2. The Respondent urges a finding of fair use in the overall facts and circumstances of this case, given that the associated website is a bona fide criticism website and not a pretext for commercial benefit, there is no proof that the content is anything but truthful and well-founded, it is

clear to site visitors that the website is not operated by the Complainant, there is no indication that the Respondent has engaged in a pattern of registering domain names corresponding to marks held by third parties, there is no indication of actual confusion by users, and there is no link to a competitor's site.

In the Respondent's view, the Complainant has not made a case for bad faith under the Policy. The record does not show that the Respondent is a competitor of the Complainant even under a broad reading of the term "competitor" nor that the Respondent has acted for reasons of commercial gain in publishing the Respondent's criticism website. The Respondent argues further that an evaluation of the tort of defamation is beyond the scope of this UDRP proceeding.

The Respondent requests a finding that the Complainant was brought in bad faith and constitutes an abuse of the UDRP.

The Respondent also requests the redaction of his name in this Decision in the interests of preserving his privacy.

## **6. Discussion and Findings**

### **6.a. Preliminary Matter – Privacy Redaction**

The Rules and Supplemental Rules do not offer guidance on the redaction of party names for privacy purposes, but this is sometimes done in published decisions when a party offers a compelling reason. The Respondent has not suggested such a reason in this instance.

The two cases which the Respondent cites as including redactions of a respondent's name for replacement with "John Doe" are in fact cases in which the name used for registration of a domain name was "John Doe". See *Banque et Caisse d'Epargne de l'Etat, Luxembourg v. John Doe, Stichting SingularityNET*, WIPO Case No. [D2024-1681](#); and *O2 Worldwide Limited v. John Doe*, WIPO Case No. [D2024-0607](#). Panelists have redacted names in prior decisions for various articulated reasons, such as the privacy of an innocent third-party in cases of identity theft, but the Panel finds no such reason here. See *Championx LLC v. Name redacted*, WIPO Case No. [D2024-1899](#).

The Respondent is a licensed New York lawyer advertising his services online in his own name on his professional website, as detailed below. The Panel also notes that the parties' names have already become a matter of public record in the pending civil litigation between them. Hence, the Panel finds no compelling reason to withhold the Respondent's name in the published Decision in this proceeding and denies the Respondent's request for redaction.

### **6.b. Preliminary Matter – Supplemental Filings**

The Rules do not provide for additional filings other than at the Panel's request, and unsolicited supplemental filings are generally discouraged but may be considered at the Panel's discretion. [WIPO Overview 3.0](#), section 4.6. The Complainant's supplemental filing in this instance

- (a) notifies the Panel that the Complainant has filed an application to register NATIV WINIARSKY as a trademark;
- (b) distinguishes UDRP precedents cited by the Respondent and raises the "impersonation" argument as a counter to the Respondent's claimed fair use of the disputed domain name for a criticism website;
- (c) states that the Respondent "is a former employee of Complainant's law firm" and argues that this raises an inference of bad faith intent to interfere with and "divert" the Complainant's business.

The Respondent's supplemental filing neither confirms nor denies that the Respondent was formerly employed at the Complainant's law firm. Instead, the Respondent argues that the Complainant's impersonation argument is moot because the Complainant has not established that he had trademark rights

in his personal name when the disputed domain name was registered. The Respondent repeats his argument that he had a legitimate fair-use interest in using the disputed domain name for a genuine criticism site even if the disputed domain name were identical to a common law trademark.

The Panel notes that the Complainant's pending trademark application is immaterial, as it does not suffice to establish trademark rights for the first element of the Complaint.

The Panel is capable of assessing the relevance of the precedents cited by the parties in their respective briefs without re-argument in supplemental filings. The Panel notes that the Complainant should have anticipated that it would need to address the Respondent's claim to a legitimate interest in making fair use of the disputed domain for criticism, as the disputed domain name has resolved to a site overtly devoted to criticism, and yet the Complaint and Amended Complaint were silent on that point. This is not an unexpected argument, and there are no "exceptional circumstances" that warrant allowing the Complainant yet another opportunity to brief the issue.

The Amended Complaint, filed after the Respondent was identified, also stated categorically that the "Complainant has no connection whatsoever to Respondent", but the supplemental filing asserts that the Respondent is a former employee of the Complainant's law firm. The Complainant does not call attention to this contradiction but rather contends that the fact of the Respondent's former employment raises an inference of a bad-faith intent to interfere with the Complainant's business and divert business to the Respondent, who is also a lawyer. Of course, this background may also simply help explain how the Respondent came to know the Complainant and for some reason became sufficiently disaffected to mount a critical website. The Respondent, who presumably knows whether or not he had formerly worked for the Complainant's law firm, also chooses not to confirm or deny this assertion or explain his reasons for publishing his criticism site. If the Respondent is indeed a former employee, this fact should have been known to the Complainant at the time it filed the Amended Complaint, but the Panel accepts the Complainant's supplemental filing for the limited purpose of correcting the Amended Complaint in terms of the Parties' former relationship and taking the uncontested fact of the Respondent's former employment into account as potentially relevant to the second and third elements of the Complaint. The Panel does not find it necessary to accept the Respondent's supplemental filing, as it adds no new, material evidence and the relevant issues are already before the Panel.

## **6.c. Substantive Issues**

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

It is well accepted that the first element functions primarily as a standing requirement.

"In situations ... where a personal name is being used as a trademark-like identifier in trade or commerce, the complainant may be able to establish unregistered or common law rights in that name for purposes of standing to file a UDRP case where the name in question is used in commerce as a distinctive identifier of the complainant's goods or services." [WIPO Overview 3.0](#), section 1.5.2. "Merely having a famous name" is not sufficient for this purpose; the name must be used in a trademark, source-identifying sense. *Id.* This requires supporting evidence of acquired distinctiveness (or "secondary meaning") such as the duration and nature of use of the mark, the amount of sales under the mark, the nature and extent of advertising using the mark, and the degree of actual public recognition, as reflected for example in media and industry sources and consumer surveys. [WIPO Overview 3.0](#), section 1.3. The Complainant here points to his practicing law since 1996, serving as a named partner in his law firm with a page devoted to his practice on the law firm website, authoring articles in professional publications, and appearing in media articles and podcasts.

Many of these facts are similar to those in the *Joseph Leccese* decision cited by the Respondent, where the panelist found that the complainant, also a partner in a New York law firm, did not provide legal services independently of the "platform" of his law firm and thus was not making trademark use of his personal name. Similarly, the three-person panel in *Ramsey Mankarious v. Stanley Pace*, WIPO Case No. [D2015-1100](#),

found that the complainant's "business reputation" in the hotel investment industry nevertheless did not establish his personal name as a common law mark, as the Complainant "has always provided his services as an executive of various investment firms, none of which are named after him".

What distinguishes the facts in the current proceeding from these cited cases is that the Complainant's surname, Winiarsky (an uncommon and therefore distinctive name in the United States) does indeed appear in the name of the law firm that serves as the platform through which he provides legal services. The Complainant's services are advertised on the law firm's website that is headed with his surname as a named partner. This firm name, albeit as a whole, is often mentioned in the media articles referring to his work. This was not the case as early as 1996, when the law firm was named Kucker Kraus & Bruh, LLP (and subsequently amended to Kucker & Bruh, LLP), according to the online database of the New York Division of Corporations. But that public database shows that the law firm added the Complainant's surname to the name of the partnership in April 2019. This is also reflected on the law firm's website, as shown in screenshots from 2020 archived by the Internet Archive's Wayback Machine.

The Panel is unable however to find, on this record, that the Complainant's surname by itself has acquired distinctiveness as an unregistered mark for the purposes of the Policy. The Complainant only appears to do business under the firm name, which includes his surname only as part of the longer name Kucker Marino Winiarsky & Bittens LLP, as shown on the firm's website and printed brochure (which is pictured on the firm's website). The firm uses a domain name based on the first two names, "Kucker Marino" and sometimes displays the firm name without the "LLP" designation and sometimes uses a logo with the initials "KMWB" arranged around a plus sign. But there is no real evidence in the record or on the website of the Complainant's firm that the Complainant's services are advertised and sold under the Complainant's name alone or that the Complainant's name is recognized by a relevant market as a service mark for the Complainant law firm.

The Panel finds that the first element of the Policy has not been established.

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

Given the Panel's finding on the first element of the Policy, it is not necessary to reach a conclusion on the second element.

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

Given the Panel's finding on the first element of the Policy, it is not necessary to enter a finding on the third element. The Panel notes that the Complainant relies on assertions of defamation to imply bad faith, but this is an issue that must be addressed in the pending civil action, not in a UDRP proceeding.

#### **D. Reverse Domain Name Hijacking**

Paragraph 15(e) of the Rules provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking (RDNH) or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking. [WIPO Overview 3.0](#), section 4.16.

The Complainant, a lawyer represented by legal counsel, failed adequately to establish common law trademark rights and seems to have confused the elements of a UDRP complaint with those of the tort of defamation. The Complainant failed to address the Respondent's predictable claim to be making nominative fair use of the disputed domain name for a criticism website, until making a belated attempt to brief the issue in a supplemental filing. The Panel does not find RDNH, however, because some complainants have successfully proven trademark use of their personal names, and when the Complaint was initially filed the Respondent's identity was not known; he entered an appearance in the civil suit for defamation only on

February 2, 2015. When the Complaint was filed, it could not be known, for example, whether the Respondent was actually a competitor and using the criticism site as a pretext to gain commercial advantage. The Complainant's arguments have not been well conceived or executed, but it was not outside the realm of possibility that the Complainant could seek relief under the Policy, given the composition of the disputed domain name and the allegation that the criticism site was defamatory.

The Panel does not find, therefore, that the Complainant brought the Complaint in an attempt at Reverse Domain Name Hijacking or to harass the domain-name holder.

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/W. Scott Blackmer/*

**W. Scott Blackmer**

Sole Panelist

Date: February 24, 2025