

ADMINISTRATIVE PANEL DECISION

Shearman & Sterling LLP v. Name Redacted
Case No. D2022-2622

1. The Parties

The Complainant is Shearman & Sterling LLP, United States of America (“United States”), internally represented.

The Respondent is Name Redacted.¹

2. The Domain Name and Registrar

The disputed domain name <shearman-us.com> is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2022. On July 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 20, 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 July 22, 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 amendment to the Complaint on July 28, 2022.

The Center verified that the Complaint, together with the amendment to 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”).

¹ The Respondent appears to have used the name of a third party when registering the disputed domain name. Considering the potential identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 18, 2022. The purported disputed domain name registrant identified by the Registrar sent email to the Center on August 9, 2022, disclaiming any knowledge of the registration or use of the disputed domain name.

The Center appointed William F. Hamilton as the sole panelist in this matter on August 25, 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 a venerable international law firm founded in the United States over one hundred years ago.

The Complainant obtained registration of the mark SHEARMAN & STERLING (the “Mark”) with the United States Patent and Trademark Office, Registration No. 2536860, on February 5, 2002.

The Complainant owns and utilizes the domain name <shearman.com>.

The disputed domain name was registered on November 23, 2021.

5. Parties’ Contentions

A. Complainant

The Complainant asserts the disputed domain name is confusingly similar to the Mark because the disputed domain name is composed of a principal component of the Complainant’ Mark and the abbreviation “-us”, which is normally understood to refer to the United States, utilized as a suffix.

The Complainant asserts that the Complainant has never authorized the Respondent to use the disputed domain name, that the Respondent is not generally known by the disputed domain name, and that the Respondent has never engaged in any *bona fide* commercial activity in connection with the disputed domain name.

The Complainant asserts that the Respondent registered and used the disputed domain name in bad faith for unspecified reasons which may include deceiving future Internet users or using email addresses associated with the disputed domain name to trick persons for a wide variety of possible illicit purposes.

B. Respondent

The Respondent did not make a formal response to the Complaint. A person with the same name as the Respondent sent an email communication to the Center stating that he did not register the disputed domain name.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

(i) the disputed domain name is identical 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; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's Mark.

The disputed domain name is composed of a principal component of the Complainant's Mark coupled with the letters "us" separated from the prominent Mark component by a hyphen. A domain name which incorporates a clearly identifiable component or dominant portion of a complainant's registered mark may be sufficient to establish confusingly similarity for the purposes of the Policy especially when, as here, the only other addition to the disputed domain name is a country abbreviation. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7; see also [WIPO Overview 3.0](#), section 1.8 ("where the relevant trademark is recognizable with the disputed domain name, the additions of other terms (whether descriptive, geographic, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element"); *Nomura International Plc. v. Name Redacted*, WIPO Case No. [D2021-0654](#).

The generic Top-Level Domain of the disputed domain name, in this case ".com", may be disregarded for the purposes of assessment under the first element, as it is viewed as a standard registration requirement. See [WIPO Overview 3.0](#), section 1.11.1. *Monster Energy Company, a Delaware Corporation v. J.H.M. den Ouden*, WIPO Case No. [D2016-1759](#) (transferring <monsterenergy.world>).

The Complainant has met its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has specifically disavowed providing the Respondent with permission to use the disputed domain name or the Mark. The Respondent is not affiliated with the Complainant in any way and does not have any business relationship with the Complainant. There is no evidence that the Respondent has conducted any *bona fide* business under the disputed domain name or is commonly known by the disputed domain name. *Compagnie de Saint Gobain v. Com-Union Corp*, WIPO Case No. [D2000-0020](#).

The Complainant has thus established a *prima facie* case in its favor, which shifts the burden of production on this point to the Respondent. The Respondent, however, has failed to come forth with any evidence showing any rights or legitimate interests in the disputed domain name.

Furthermore, the Panel notes that the Complainant owns and operates the domain name <shearman.com>, which is highly similar to the disputed domain name (merely adding "-us" within the disputed domain name). While the disputed domain name does not reproduce the Complainant's Mark in its entirety, the Panel notes that it reproduces the initial component of the Mark, which also corresponds to the Second-Level of the Complainant's domain name, and finds that the disputed domain name carries a risk of implied affiliation with the Complainant. See [WIPO Overview 3.0](#), section 2.5.1. The association of the abbreviation "us" (which is a common abbreviation for the United States, where the Complainant is located) as a suffix to the initial principal component of the Mark in the disputed domain name clearly suggests that the disputed domain name will resolve to a website offering the Complainant's legal services in the United States.

The facts and circumstances presented to the Panel demonstrate that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, bad faith may be established by any one of the following scenarios:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 the respondent's website or location or of a product or service on the respondent's website or location.

The Panel finds the disputed domain name was registered and is being used in bad faith.

On the evidence presented, there is little doubt that the disputed domain name was registered and used in bad faith. The person identified by the Registrar as the registrant of the disputed domain name has disavowed knowledge of the disputed domain name's registration. The fact that the disputed domain name does not resolve to an active website is immaterial. The Complainant is not required to live under the Sword of Damocles. The potential for harm is apparent: a pilfered identity was used in registering the disputed domain name; the disputed domain name was registered utilizing a privacy service; and the disputed domain name was composed with malice aforethought. No one can reasonably believe that the Respondent innocently composed the disputed domain name utilizing a principal element of the Complainant's Mark that would have been revealed immediately in any Internet search.

Even ignoring the above compelling conclusions, it is difficult to conceive of any use that the Respondent might make of the disputed domain name without the Complainant's consent that would not involve bad faith. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#) ("where the reputation of a complainant in a given mark is significant and the mark bears strong similarities to the disputed domain name, the likelihood of confusion is such that bad faith may be inferred"); *DPDgroup International Services GmbH & Co. KG v. Wise One, Wilson TECH*, WIPO Case No. [D2021-0109](#); *Monster Energy Company v. PrivacyDotLink Customer 116709 / Ferdinand Nikolaus Kronschnabl*, WIPO Case No. [D2016-1335](#).

The Complainant has met its burden under paragraph 4(a)(iii) of the Policy.

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 <shearman-us.com> be transferred to the Complainant.

/William F. Hamilton/

William F. Hamilton

Sole Panelist

Date: September 8, 2022