

## **ADMINISTRATIVE PANEL DECISION**

Salomon Brothers Group Inc. v. Domain Administration, CitiBank, N.A.  
Case No. D2022-3406

### **1. The Parties**

Complainant is Salomon Brothers Group Inc., United States of America “United states or US”, internally represented .

Respondent is Domain Administration, CitiBank, N.A., US, represented by Perkins Coie, LLP, US.

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

The disputed domain name <salomonbrothers.com> (the “Domain Name”) is registered with CSC Corporate Domains, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 13, 2022. On September 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 15, 2022, 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 September 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 9, 2022. The Response was filed with the Center on October 7, 2022. Complainant submitted to the Center a first, second, and third supplemental filings on October 7, October 10, and October 13, 2022, respectively. Respondent submitted a supplemental filing on October 18, 2022. Complainant submitted a fourth supplemental filing on October 31, 2022.

The Center appointed Christopher Gibson as the sole panelist in this matter on November 14, 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**

Complainant is a holding company for companies providing financial services to individuals and institutions. Records from United States, New York state (provided by Respondent) indicate Complainant was incorporated on June 1, 2020. Complainant is the owner of the trademark SALOMON BROTHERS. The mark is registered with the United States Patent and Trademark Office (“USPTO”), registration no. 6008154. The mark is registered on the principal register, was filed on April 11, 2016, has been registered since March 10, 2020, and indicates a date of first-use-in-commerce of January 15, 2020. The trademark covers services provided in Class 36 for investment banking services, asset management, financial advisory and related services. The record indicates Complainant purchased the SALOMON BROTHERS trademark from a third-party – the assignment for this purchase was recorded with the USPTO on June 12, 2020.

Respondent is the banking subsidiary of the global investment bank and financial services corporation, Citigroup Inc (collectively, “Respondent”). Respondent was founded in 1812 as the City Bank of New York. In 1998, Travelers Group acquired Salomon Brothers, an investment bank founded in 1910. Citigroup was formed in 1998 as a business combination of Citicorp and Travelers Group. Through that combination, Citigroup acquired Salomon Brothers and continued to use variations of that name and the SALOMON BROTHERS mark for several years for different products and services, including Salomon Smith Barney. Respondent ceased use of the SALOMON BROTHERS mark and it was officially designated as abandoned by the USPTO in December 2011 (because registrant did not file an acceptable declaration under Section 8).

The Domain Name was registered on April 4, 2001. At the time Respondent registered the Domain Name, Respondent owned two United States federal trademark registrations for the mark SALOMON BROTHERS (US reg. nos. 0911433 and 1581876). The stylized mark registration was filed on September 14, 1970, and registered on April 13, 1971, and the wordmark registration was filed on November 18, 1987, and registered on February 6, 1990. The applications that matured into these (now cancelled) trademark registrations were filed by Complainant’s subsidiary at the time, Salomon Brothers Inc.

The Domain Name resolves to an inactive website.

#### **5. Parties’ Contentions**

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

(i) Identical or confusingly similar

Complainant has submitted evidence of its SALOMON BROTHERS trademark registration. Complainant states the Domain Name uses the name “Salomon Brothers” exactly as it appears in its identical SALOMON BROTHERS mark and there is therefore a high likelihood of confusion if any party, other than Complainant as the trademark owner, were to use the Domain Name.

Further, Complainant states the SALOMON BROTHERS trademark is highly distinctive. It is not a common name or a dictionary name, nor is it a common phrase or expression. As further evidence of its high distinctiveness, the SALOMON BROTHERS mark is the only trademark designated as “LIVE” on the USPTO register for marks with the name “Salomon Brothers.”

(ii) Rights or legitimate interests

Complainant contends that Respondent has no rights or legitimate interest in the Domain Name. According to the Whois database, Respondent registered the Domain Name on April 4, 2001, and for over 21 years

(nearly 22) has squatted on it with no use. Complainant submits that Respondent has not used for the Domain Name and is squatting on it because: (1) the Domain Name resolves to an empty screen; and (2) the Internet Archive at “www.archive.com” shows no use of the Domain Name in over 21 years. Complainant explains that the Internet Archive captured screenshots for the Domain Name at 26 random times over the last 22 years and they all showed a blank screen; and (3) an extended search of the Internet results in no references to the Domain Name. Consequently, according to Policy, paragraph 4(c) there is no indication of use or preparation for use and, as shown previously, no right or legitimate interest to use the Domain Name.

(iii) Registered and used in bad faith

Complainant submits that in this case there is no evidence of any webpage associated with the Domain Name, as it resolves to a blank screen, making this an example of passive holding. Complainant contends that the apparent lack of active use (e.g., to resolve to a website) without any active attempt to sell or to contact the trademark holder (i.e., passive holding) does not prevent a finding of bad faith. The panel must examine all of the circumstances of the case to determine whether a respondent is acting in bad faith.

Complainant claims that in the present case, the excessive holding period (nearly 22 years), denying Complainant an opportunity to use its trademark in a Domain Name that is identical to it, and with no viable prospective use that could not infringe Complainant's trademark rights, makes this a clear case where passive holding is in bad faith. Moreover, Complainant cites a prior UDRP case, *Government Employees Insurance Company (“GEICO”) v. Steven Blome, Blome Agency*, WIPO Case No. [D2021-4019](#), where the panel noted that having a domain name that is identical to the trademark, and resolves to an inactive, blank web page would serve to confuse and mislead Internet users – particularly a domain name that is distinctive, as compared to a common or dictionary word, and which therefore would be more likely to be associated with an identical trademark.

Complainant states that Respondent is a top US federally-chartered bank that provides banking and other financial services to its customers in more than 30 states and more than 40 countries around the world. Therefore, any use of the Domain Name by Respondent would be sure to cause confusion with Complainant's trademark, which provides Complainant a right to sell financial goods and services under the SALOMON BROTHERS mark. Consequently, it is not possible to conceive of any plausible actual or contemplated use of the Domain Name by Respondent that would not infringe Complainant's mark and thereby amount to bad faith use within the meaning of the Policy, because it would involve intentional deception of Internet users.

Complainant urges that UDRP cases have proven that squatting on a domain name – while not actually using it – can itself be proof of bad faith registration. It makes sense that a panel may look to other factors, such as the length of non-use, because otherwise a party could simply deprive a trademark owner of use of a domain name that fits its name and effectively leaves a hole in the Internet where the trademark owner's business should be. Given the extent to which commerce is conducted on the Internet, it would obviously cause enormous harm to the trademark holder. Further, Complainant claims Respondent's nearly 22 year holding period without any active use in this case may well be an unprecedented long period of non-use. The modern commercial Internet itself is not much older than the period this Domain Name has been held passively with no activity.

Complainant states that history provides important context in this case. The SALOMON BROTHERS trademark was once owned by Respondent. It was acquired by Respondent in 1999, and in May 2001, Respondent publicly announced it would no longer use the SALOMON BROTHERS mark, and that announcement was published in major business media. Respondent ceased using the mark and it was officially designated as abandoned by the USPTO in 2011. Complainant indicates a spokesperson for Respondent publicly stated, as quoted in a news story in Global Capital published in February 2022, that Respondent has not used the Salomon Brothers name in 20 years: “nearly twenty years ago we unified our branding under ‘Citi’ and no longer use the names of our predecessor companies.” Given this fact,

Complainant contends the Domain Name was registered, and re-registered continuously, solely for the bad faith purpose of blocking a subsequent owner of the SALOMON BROTHERS trademark from using it.

Complainant states that as the Panel reviews the following timeline, the Panel should bear in mind that Respondent is one of the largest banks in the US and the world. Therefore, major marketing decisions are not taken in a matter of weeks but rather in months:

- April 4, 2001 – Respondent registered the Domain Name.
- May 21, 2001 – Respondent announced as a major global brand strategy – estimated USD 1+ billion impact on Respondent’s business – that it will no longer use “Salomon Brothers” or “Salomon”.
- May 22, 2001 – stories printed in major newspapers concerning this decision.
- February 2022 – Respondent’s spokesperson confirms it has not used the “Salomon” or “Salomon Brothers” name for 20 years.

Complainant contends this time line makes it obvious that Respondent registered the Domain Name to prevent any future trademark owner from having access to it. Respondent announced a global realignment of branding and trademarks on May 21, 2001, which included dropping “Salomon Brothers”, and just 6 weeks earlier it had registered the Domain Name. Complainant states that a major market strategy change – which requires board-level approval and has more than a USD 1 billion impact – takes more than 6 weeks to prepare. More realistically, six months. Complainant urges this timeline is therefore the proverbial “smoking gun” – a set of facts that Respondent cannot change and is impossible to argue against or innocently explain away. Complainant claims this is irrefutable evidence of bad faith – that this egregious conduct is domain hijacking.

Further, Complainant urges the purpose of blocking a future trademark owner indicates not only bad faith at registration and each following re-registration, but also bad faith use (or in this case, non-use). Indeed, “non-use” is a conscious decision that requires intent and “bad faith” requires an element of intent and intent is inferred from action (or inaction, as in this case).

Complainant states the SALOMON BROTHERS trademark has been registered by Complainant for years. Yet, according to the Whois lookup, Respondent recently renewed the Domain Name registration. Respondent renewed the registration on March 31, 2022. It is instructive that Respondent’s recent registration renewal date is five years after Complainant’s trademark was first published by USPTO for opposition and two years after the trademark was registered. Complainant contends that as a matter of US law, Respondent had prior constructive or actual knowledge of Complainant’s trademark.

Complainant submits there is no evidence of any actual or any contemplated good faith use by Respondent of the Domain Name – Internet archive screenshots show no use of any kind since initial registration or subsequent renewal registrations and Respondent’s spokesperson is quoted in a recent business publication as saying Respondent has not used the trademark for 20 years.

From these facts, Complainant contends that Respondent never intended to use the Domain Name in commerce. The long-term (nearly 22 years) squatting on the Domain Name shows a pattern of conduct that is evidence that the owner has intended to prevent a future trademark owner from having use of it. Complainant submits this is domain squatting and should be sanctioned by the Panel as “domain hijacking.”

## **B. Respondent**

Respondent submits that Complainant has failed to prove the three required elements under the Policy and cannot prevail in this case. Moreover, Respondent contends that Complainant has acted in bad faith by filing the Complaint and is engaging in reverse domain name hijacking.

(i) Identical or confusingly similar

Respondent asserts the Domain Name was registered on April 4, 2001, and at the time of registration, Respondent owned two US federal trademark registrations for the mark SALOMON BROTHERS. By comparison, Respondent states that Complainant alleges it applied for the SALOMON BROTHERS trademark on April 11, 2016; that the mark was registered on March 10, 2020; that Complainant claims a first use in commerce date of January 15, 2020; that Complainant purchased its trademark registration from a third-party; and that Complainant was not incorporated until 2020.

Thus, Respondent asserts that while at the time it registered the Domain Name in 2001, it was the owner of two active registrations for the SALOMON BROTHERS marks, Complainant did not come into existence until 19 years later in 2020. As such, Respondent owned the Domain Name and two federal trademark registrations for SALOMON BROTHERS many years before Complainant came into existence. Respondent argues that on these facts alone, the Complaint must be denied.

(ii) Rights or legitimate interests

Respondent contends that Complainant has failed to meet its burden of making a *prima facie* showing that Respondent lacks rights or legitimate interests in the Domain Name. To the contrary, as demonstrated by the facts and timeline, Respondent owned registered rights to the mark SALOMON BROTHERS when the Domain Name was registered, and Respondent could not possibly have registered the Domain Name to violate rights owned by a company that did not come into existence until many years later. Respondent merely registered a Domain Name that incorporated a trademark in which Respondent held registered rights and under which it offered services, and did this years before Complainant existed.

(iii) Registered and used in bad faith

Respondent contends that Complainant did not come into existence until 2020 – that is, 19 years after the Domain Name was registered. As such, Respondent owned the Domain Name and two federal trademark registrations for SALOMON BROTHERS many years before Complainant came into existence. It therefore is not possible that Respondent could have registered the Domain Name in bad faith in 2001, much less have taken steps to target the non-existent Complainant. On these facts Respondent urges this case must be denied.

Respondent submits the Policy requires Complainant to prove that Respondent both (1) registered the Domain Name in bad faith and (2) used the Domain Name in bad faith. Respondent claims Complainant has failed to meet both elements. As an initial matter, it is impossible that Respondent registered the Domain Name in bad faith many years before Complainant was created. Respondent also could not have used the Domain Name in bad faith because Respondent's registered rights to the SALOMON BROTHERS trademark predated Complainant's existence.

Respondent asserts that Complainant also fails to demonstrate that Respondent used the Domain Name in bad faith, relying instead on inapposite cases where warehousing and passive non-use were considered bad faith uses. None of the cases cited by Respondent involve situations where the complainant came into existence years or even decades after the respondent registered the disputed domain name and obtained federal trademark rights to the underlying trademark. Respondent argues that, as Complainant's own cases show, passive holding arguments require as a threshold matter a registrant with no legitimate rights to own a disputed domain name. That clearly is not the case here and the passive holding claims are fatally flawed. Complainant therefore has failed to demonstrate that Respondent registered or used the Domain Name in bad faith.

(iv) Reverse domain name hijacking

Respondent contends that Complainant's actions in this case constitute reverse domain name hijacking ("RDNH"). According to Respondent, the purpose of RDNH is to intimidate legitimate domain name owners

into transferring domain names that they rightfully own. The Policy defines RDNH as “using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.”

Respondent submits circumstances that would support a finding of RDNH include: (1) the domain name was registered before Complainant obtained trademark rights, (2) Complainant has provided no evidence of bad faith, and (3) Complainant uses the UDRP to secure the domain name after prior attempts have failed. Respondent claims that although just one of these circumstances is sufficient to find RDNH, all three apply here.

First, Respondent registered the Domain Name in April 2001, long before both Complainant or any rights that may attach to Complainant’s cited trademark registration were created. Complainant admits that “[a]ccording to the ‘Who Is’ data base, Respondent registered the domain on April 4, 2001”. Complainant elsewhere states that it is the owner of, “the trademark ‘Salomon Brothers’ registered with the United States Patent & Trademark Office...was filed in [sic] April 11, 2016 and [sic] been so registered since March 10, 2020”. Thus, Complainant admits it was aware that Respondent registered the Domain Name before the alleged rights that Complainant claims in its trademark, yet Complainant still filed this case.

Second, Complainant has presented no evidence of bad faith and has relied instead on Respondent’s lawful renewal of the Domain Name and bogus allegations that failure to use a rightfully-registered domain name is evidence of bad faith. Respondent submits that prior panels are clear that a renewal of a domain name by the owner does not create a new registration of the domain name. As such, Respondent’s renewal of the Domain Name is not evidence of bad faith registration and use.

Thirdly, Respondent asserts that Complainant is using the UDRP in a bad faith attempt to coerce Respondent into transferring the Domain Name after failing to obtain it by other means. Prior to this case, Complainant sent Respondent a letter on January 28, 2022, demanding Respondent transfer the Domain Name to Respondent. Respondent did not respond and never requested compensation.

Respondent submits that prior panels have found RDNH in cases with similar fact patterns as the present proceeding, *i.e.*, a complainant owned a trademark that was registered years after Respondent registered the disputed domain name and sought to forcibly obtain the domain name via the UDRP. Respondent claims Complainant knew or should have known that it would be unable to prove that Respondent had registered and used the Domain Name in bad faith. The primary factor in support of this finding is that the Domain Name was registered many years before Complainant’s alleged trademark rights came into existence.

Respondent further notes that this is not a circumstance where Complainant was unaware of Respondent’s longstanding history with the trademark that is incorporated in the Domain Name. On its website, Complainant states that it selected the “Salomon Brothers” trademark due to its longstanding history and reputation in the financial industry and refers to it in the tagline “The Modern Salomon Brothers” under Complainant’s current name, “Salomon Encore”. Additionally, Complainant’s CEO was previously employed by the original Salomon Brothers company (which was later acquired and combined with Respondent’s parent company). Complainant’s website at “[www.salomonencore.com](http://www.salomonencore.com)” displays the SALOMON ENCORE mark with the tagline “The Modern Salomon Brothers” and links to an article entitled, “Salomon Brothers Alumni Rally for Historic Encore”, which states, “This rebranding initiative reflects the firm’s desire to focus on the future while honoring and building upon Salomon Brothers’ venerable past as one of the world’s most established investment banking houses. The firm made the change to “Encore” as a way to identify as the “modern Salomon Brothers”. As such, Respondent states that Complainant had constructive or actual knowledge of Respondent and its historic rights in the SALOMON BROTHERS mark prior to filing the Complaint, and Complainant nonetheless decided to use the SALOMON BROTHERS mark in its company name and for its company business.

## 6. Discussion and Findings

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. Those elements are as follows:

- (i) the Domain Name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) Respondent has registered and is using the Domain Name in bad faith.

### A. Supplemental Filings

Complainant filed several supplemental submissions in this case, while Respondent filed one responsive supplemental submission.

Paragraph 12 of the UDRP Rules provides that it is for the panel to request, in its sole discretion, any further statements or documents from the parties that it may consider necessary to decide the case. Thus, unsolicited supplemental filings are generally discouraged by UDRP panelists, and “panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response (e.g., owing to some ‘exceptional’ circumstance)”. See section 4.6 of WIPO Overview of Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Here, the Panel finds that Complainant’s October 7, 2022, and October 10, 2022, submissions present arguments that (i) reiterate points already made in the Complaint, or (ii) seek to frame new arguments that could have been articulated in the Complaint. The Panel therefore denies admission of Complainant’s October 7, 2022, and October 10, 2022 supplemental submissions.

Complainant’s supplemental submission of October 12, 2022 presented information in the form of an affidavit from a witness (also claiming to be an expert) regarding the circumstances of Respondent’s rebranding efforts in 2001 and the registration of the Domain Name. Complainant’s submission of October 31, 2022, seeks to demonstrate that this information was not available to Complainant at the time the Complaint was filed. Respondent’s supplemental submission of October 18, 2022, contends that Complainant’s October 12, 2022, supplemental submission is self-serving and late-filed, that Respondent has had no opportunity to cross-examine the witness, who was paid by Complainant, and that the Panel should disregard the affidavit. In the alternative, Respondent argues that the affidavit supports Respondent’s position that its ownership of the SALOMON BROTHERS trademark registrations and the Domain Name predated Complainant’s existence by many years and supports Respondent’s contention that Complainant engaged in RDNH.

The Panel determines that it will accept Complainant’s supplemental submission of the October 12, 2022, insofar as it presents information newly obtained after the Complaint was filed. The Panel will also accept Respondent’s responsive supplemental submission of October 18, 2022, as it relates to the new information in Complainant’s October 12, 2022, submission. The Panel reminds that parties of its general powers under the Rules, paragraph 10, to “determine the admissibility, relevance, materiality and weight of the evidence” and to “ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.”

### B. Identical or Confusingly Similar

Complainant has demonstrated that it has rights in its SALOMON BROTHERS trademark through registration with the USPTO and use dating from January 2020. The Panel further finds that the Domain Name incorporates the SALOMON BROTHERS mark in its entirety, with no variation other than the addition of the generic top-level domain (“gTLD”) extension, “com.” It is noted that the Respondent’s arguments on

this first element focusing on its own rights in its (now canceled) trademarks and the later timing of Complainant's mark miss the point as to what the Panel is required to consider under the first element (a standing test of showing rights in a mark, and for identity or confusing similarity), and are better suited to the second and/or third elements.

Accordingly, the Panel finds that the Domain Name is identical to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy, and Complainant has satisfied the first element of the Policy.

### **C. Rights or Legitimate Interests**

Regarding the second element of the Policy, Complainant contends that Respondent has no rights or legitimate interest in the Domain Name. In particular, Complainant has provided evidence of its rights in the SALOMON BROTHERS trademark and that the Domain Name is identical to this mark. Further, Complainant has provided evidence to show that Respondent registered the Domain Name on April 4, 2001, and for over 20 years has not used or made preparations to use the Domain Name in connection with a website, and claims that any use by Respondent now would cause confusion with Complainant's mark. In response, Respondent indicates that it owned registered rights in the SALOMON BROTHERS mark at the time when Respondent registered the Domain Name and that Respondent could not possibly have registered the Domain Name to violate rights owned by a company that did not come into existence until 19 years later. Thus, Respondent merely registered a Domain Name that incorporated a trademark in which – at the time – Respondent held registered rights and under which it offered services, and did this years before Complainant existed.

The Policy provides that to demonstrate rights or legitimate interests in a domain name, non-exclusive respondent defenses under UDRP paragraph 4(c) include the following:

- (i) before any notice of the dispute, 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; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Reviewing each of these factors, the Panel finds that there is no evidence of Respondent's use of, or demonstrable preparations to use, the Domain Name in connection with a *bona fide* offering of goods or services; that Respondent is not commonly known by the Domain Name; and that Respondent is not making any legitimate noncommercial or fair use of the Domain Name. Importantly, the Panel observes that “[p]anels tend to assess claimed respondent rights or legitimate interests in the present, *i.e.*, with a view to the circumstances prevailing at the time of the filing of the complaint.” See [WIPO Overview 3.0](#), section 2.11. Thus, a respondent “claiming a right or legitimate interest in a domain name for example ... based on past good-faith use (thus demonstrating merely a past right or legitimate interest) would not necessarily have rights or legitimate interests in the domain name, at the time a decision is rendered.” *Id.* Here, Respondent has relied on its previous rights in the SALOMON BROTHERS trademark and the prior use of that name in connection with Respondent's business dating back to the period around 2001, but it is not entirely clear that Respondent has put forward adequate evidence that would support its case under the second element. Moreover, Respondent's previous rights in the SALOMON BROTHERS mark were determined by the USPTO to be cancelled in December 2011.

That said, especially insofar as the parties operate in the financial sector, Respondent may well have a legitimate reason to keep a domain name corresponding to its former (global) brand out of the hands of third parties (even if the brand was not resurrected, this would go toward preventing potential consumer



confusion; at the same time, it does not appear that Respondent has opposed Complainant's trademark registration).

Above all, considering the Panel's finding under the third element, it is not necessary to make a finding here under the second element of the Policy.

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

The third element of paragraph 4(a) of the Policy requires Complainant demonstrate that Respondent registered and is using the Domain Name in bad faith.

Complainant has argued vigorously that Respondent's passive holding of the Domain Name for over 20 years, by effectively denying Complainant an opportunity to use Complainant's trademark in a domain name that is identical to it, and with no viable prospective use by Respondent that would not infringe Complainant's trademark rights, makes this a case where passive holding is in bad faith. Further, Complainant's urges that the history in this case – where Respondent registered the Domain Name just several weeks before announcing that it was unifying its branding under the "Citi" brand and no longer using the names of predecessor companies, such as Salomon Brothers – demonstrates Respondent registered the Domain Name knowing it would have no commercial use for it and thus registered it for the bad faith purpose of blocking a subsequent trademark owner.

Complainant claims that the purpose of blocking a future trademark owner indicates not only bad faith at registration and at each following renewal, but also bad faith in use (or in this case, non-use). Respondent recently renewed the registration of the Domain Name on March 31, 2022, five years after Complainant's trademark was published for opposition by the USPTO and two years after the mark was registered. Complainant contends that Respondent thus had prior constructive or actual knowledge of Complainant's trademark at the time of renewal. Complainant further contends that all of this amounts to squatting and should be sanctioned as domain hijacking.

Respondent has responded that the third element of the Policy requires both bad faith registration and bad faith use. Respondent emphasizes that it owned the Domain Name and two corresponding federal trademark registrations for the SALOMON BROTHERS mark many years before Complainant came into existence. Therefore, Respondent did not register the Domain Name in bad faith in 2001, nor did Respondent target Complainant, which did not come into existence until 2020. Respondent also claims it could not have used the Domain Name in bad faith because Respondent's registered rights to the (now cancelled) SALOMON BROTHERS mark predated Complainant's existence. Further, Respondent submits that the renewal of a domain name by an owner does not create a new registration, and as such, Respondent's renewal of the Domain Name is not evidence of bad faith registration and use. Respondent asserts that Complainant is using the UDRP in a bad faith attempt to coerce Respondent into transferring the Domain Name after failing to obtain it by other means (and annexes a cease and desist letter from Complainant to Respondent). Finally, Respondent states that Complainant had constructive or actual knowledge of Respondent and its historic rights in the SALOMON BROTHERS mark and nonetheless decided to use the mark for its company name and business.

In view of all of the evidence in this case, the Panel determines that Complainant has failed to establish bad faith registration and use of the Domain Name. The Policy provides four non-exclusive circumstances that are evidence of the registration and use of a domain name in bad faith:

(i) registering or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring it to the complainant who is the owner of the trademark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or

(ii) registering the domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided the respondent has engaged in a pattern of such conduct; or

- (iii) registering the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) using the domain name to intentionally attempted to attract, for commercial gain, Internet users to the respondent's 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 site or location or of a product or service on respondent's site or location.

Here, the record is undisputed that (i) Respondent did not register the Domain Name for the purpose of selling, renting, or otherwise transferring it to Complainant or to a competitor of Complainant; (ii) Respondent did not register the Domain Name to prevent the owner of a trademark from reflecting that mark in a corresponding domain name; instead, when Respondent registered the Domain Name, it was the owner of at least two corresponding federal trademark registrations for the SALOMON BROTHERS mark, and had been using this mark actively in its business after having acquired the Salomon Brothers investment firm; (iii) Respondent did not register the Domain Name for the purpose of disrupting the business of a competitor; instead, it is clear that Respondent registered the Domain Name many years before Complainant existed and many years before Complainant decided to purchase the SALOMON BROTHERS trademark in or about 2020. See [WIPO Overview 3.0](#), section 3.8.1 ("where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent"); and (iv) Respondent has not used the Domain Name to intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the site or on-line location.

Moreover, Respondent's decision to cease use of the Salomon Brothers name and SALOMON BROTHERS mark, even if made while at the same time choosing to register the Domain Name corresponding to the SALOMON BROTHERS mark (as indicated in affidavit accompanying Complainant's October 12, 2022, supplemental submission), does not demonstrate bad faith registration. Respondent continued to own federal rights to the SALOMON BROTHERS trademark for another ten years after registering the Domain Name, until December 6, 2011. Moreover, Respondent was not required, as Complainant alleges, to have intended an active commercial use for the Domain Name. Registering a domain name, while owning a corresponding identical trademark and with no evidence of targeting a third-party's trademark, is not bad faith registration, even if the domain name registrant does not intend to use the domain name. While Complainant has alleged that the only plausible use of the Domain Name was to block a future trademark owner from using it, Complainant has provided no evidence to suggest that, at the time when the Domain Name was registered, there were indications that a future owner of the SALMON BROTHERS mark, other than Respondent, might emerge.

Complainant has referred to the exception contained in section 3.8.2 of [WIPO Overview 3.0](#), addressing domain names registered in anticipation of trademark rights. That section provides in relevant part:

"As an exception to the general proposition described above in 3.8.1 [i.e., when a respondent registers a domain name before complainant's trademark rights accrue, panels will not normally find bad faith], in certain limited circumstances where the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalize on the complainant's nascent (typically as yet unregistered) trademark rights, panels have been prepared to find that the respondent has acted in bad faith.

Such scenarios include registration of a domain name: (i) shortly before or after announcement of a corporate merger, (ii) further to the respondent's insider knowledge (e.g., a former employee), (iii) further to significant media attention (e.g., in connection with a product launch or prominent event), or (iv) following the complainant's filing of a trademark application."

The scenarios envisaged by section 3.8.2 of [WIPO Overview 3.0](#) all refer to a respondent who, due to specific and special knowledge, intends to unfairly capitalize on a particular complainant's nascent trademark rights that are about to come into existence. Those circumstances are not present in this case. Instead, it is

Complainant who appears to have chosen to use the Salomon Brothers name and SALMON BROTHERS mark, even in view of the prior history associating that name and mark with Respondent years before Complainant existed. Moreover, even if Respondent, at a time when it held trademark rights in the SALOMON BROTHERS mark, chose to register the Domain Name to avoid potential confusion by a third party who might, in the future, seek to use the Salomon Brothers name, this is not evidence of bad faith.

Furthermore, Respondent's periodic renewals of the Domain Name's registration is not evidence of bad faith registration and use. See [WIPO Overview 3.0](#), section 3.9 ("panels have found that the mere renewal of a domain name registration by the same registrant is insufficient to support a finding of registration in bad faith").

Under Complainant's line of reasoning for bad faith passive holding, even where no trademark exists at the time of registration, a domain name registrant could be found to have registered a domain name for a bad faith blocking purpose if the registrant merely holds the domain name, with no intent to use it, and a trademark corresponding to that domain name is subsequently registered by a third-party many years later. Complainant is not the only company choosing a new brand name – whether corresponding to a fanciful term, word or acronym – only to find that that brand has already been registered as a domain name many years previous by a third-party. In such cases, there is no bad faith registration of the domain name, nor does the long holding of the domain name constitute bad faith blocking or squatting. See e.g., [WIPO Overview 3.0](#), section 3.1.1. Unless the registration of the domain name targeted a trademark owner (and/or its trademark or about-to-be launched nascent trademark), the domain name registrant does not register in bad faith. Here, Respondent actually owned the SALOMON BROTHERS trademark at the time when it registered the Domain Name, and Respondent's trademark rights remained in place for another 10 years. By comparison, Complainant acquired its trademark rights recently in 2020, and therefore cannot claim that Respondent has been "blocking" Complainant's trademark for a more than 20-year period.

Complainant cites to cases such as *Government Employees Insurance Company ("GEICO") v. Steven Blome, Blome Agency*, WIPO Case No. [D2021-4019](#) and *Universal Services of America, LP d/b/a Allied Universal v. Contact Privacy Inc. Customer 7151571251 / Tyree Jenkins, Allied Universal Security*, WIPO Case No. [D2022-2581](#), to argue that Respondent's passive holding of the Domain Name was in bad faith. However, in each of these cases the disputed domain name was registered *after* the complainant's trademarks rights were well established. The panels found that it was unlikely the respondents were, or could have been, unaware of the complainant's pre-existing trademarks and instead the respondents took unfair advantage of those marks. That is not the case here, where Respondent actually owned the SALOMON BROTHERS trademark when it registered the Domain Name in 2001, and continued to own that mark until December 2011. Looking at the totality of the circumstances in this case, Respondent's passive holding of the Domain Name has not been in bad faith.

On the evidence presented by Complainant in this case, the Panel is unable to find bad faith registration and use of the Domain Name under the Policy. The Panel's decision is without prejudice to any claims that might exist under United States trademark laws.

Accordingly, Complainant has failed to satisfy the third element of the Policy.

#### **E. Reverse Domain Name Hijacking**

Respondent contends that Complainant's actions in this case constitute RDNH, as Complainant knew or should have known that it would be unable to prove that Respondent had registered and used the Domain Name in bad faith. The primary factor in support of this finding is that the Domain Name was registered many years before Complainant's alleged trademark rights came into existence, and Complainant is using this case in a bad faith attempt to coerce Respondent into transferring the Domain Name after failing to obtain it by other means.

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 or was brought primarily 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 Panel notes that the use by Complainant of the tagline “The Modern Salomon Brothers” on its website raises a question as to whether it seeks to capitalize on Respondent’s prior (now cancelled) rights; and while that is a matter beyond the scope of this proceeding, it does seem to generally raise a question of potential bad faith or opportunism on the part of Complainant (the Panel also notes the tone and contents of Complainant’s cease and desist letter to Respondent). At the same time, it is difficult to ignore that Complainant’s trademark registration seems to have gone unopposed by Respondent. Given these competing factors, and insofar as Complainant satisfied the first two of the three elements under the Policy while advancing an argument under the third element, although unsuccessful in demonstrating bad faith, the circumstances of this case do not in the Panel’s view merit a finding of RDNH (but indeed may speak to broader issues between the parties to be resolved by a court or in their own private resolution of the matter).

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Christopher Gibson/*

**Christopher Gibson**

Sole Panelist

Date: December 20, 2022