

ADMINISTRATIVE PANEL DECISION

Hale Law, P.A v. Roger Hale
Case No. D2023-0084

1. The Parties

Complainant is Hale Law, P.A, United States of America (“United States”), represented by Maxey-Fisher, PLLC, United States.

Respondent is Roger Hale, United States, represented by John Berryhill, Ph.d., Esq., United States.

2. The Domain Name and Registrar

The disputed domain name <gotohale.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 6, 2023. On January 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 9, 2023, 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 (Registration Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to Complainant on January 10, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on January 14, 2023.

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 Respondent of the Complaint, and the proceedings commenced on January 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 6, 2023. On February 1, 2023, Respondent’s representative requested an automatic extension of the Response due date. The Center granted the automatic extension on February 1, 2023, extending the due date for the Response until February 10, 2023. The Response was filed with the Center February 7, 2023.

The Center appointed Scott R. Austin, Roderick Thompson, and Sally M. Abel as panelists in this matter on March 31, 2023. 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.

On March 21, 2023, Complainant sent email to the Center, copying Respondent, notifying that it sought to withdraw the complaint and requesting the Center to “dismiss the proceeding with prejudice”. On March 21, 2023, Respondent sent an email to the Center, copying Complainant, objecting Complainant’s request.

4. Factual Background

Complainant is a law firm incorporated as a Florida professional association on February 8, 2018, located in Sarasota, Florida, and whose corporate name relates to the surname of its principal, Patrick M. Hale, Esq., a lawyer licensed to practice law in Florida since 2014.

Complainant is the holder of the following registered trademark: U.S. Reg. No. 6,600,139 for GO TO HALE, registered on December 28, 2021, for “[l]egal services” in International Class 45, and claiming a first use date of May 13, 2020 (the “GO TO HALE Mark”).

Complainant is also the holder of the domain name <halelaw.com>, which it uses to access its official website at “https://halelaw.com” (the “Official GO TO HALE Mark Website”) on which it promotes its legal services using the GO TO HALE Mark.

The Disputed Domain Name was first registered on May 10, 2000.

5. Parties’ Contentions

A. Complainant

Complainant contends that the Disputed Domain Name is identical to Complainant’s federally registered GO TO HALE Mark in which it has established rights. Complainant further asserts that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because although the Disputed Domain Name was registered on May 10, 2000, it has not been used by Respondent for over two decades, since June 2001.

Complainant contends it initiated communications via a Letter to Respondent forwarded to the Registrar on April 22, 2022, via United Parcel Service and thereafter followed up with copies of the same letter sent via United States Postal Service and email to all available addresses for contact, but Complainant has received neither a response from Respondent, nor any acknowledgement of these communications. Complainant contends that in July 2020, Complainant attempted to contact the domain owner through the Registrar, but Respondent refused to communicate with Complainant. Complainant argues that by configuring the Disputed Domain Name essentially identical to Complainant’s registered GO TO HALE Mark, Respondent’s use is for the sole commercial purpose of unlawfully routing internet traffic towards the Disputed Domain Name primarily for the purpose of either selling, renting, or otherwise transferring the domain name registration for valuable consideration in excess of Respondent’s out-of-pocket costs directly related to the domain name or for the purpose of preventing the owner of a trademark or service mark from reflecting such mark in the corresponding domain name and therefore, the Disputed Domain Name was registered and is being used in bad faith. Consumers seeking Complainant’s Services have confused the Disputed Domain Name with Complainant’s Federally Registered Trademark and associated goodwill. Complainant contends that Respondent is, therefore, unlawfully trading on Complainant’s Federally Registered Trademark and associated goodwill and is intentionally creating confusion with Complainant’s Mark and its legal services. Finally, Complainant asserts that continued registration and use of the Disputed Domain Name is in bad faith, in violation of the Lanham Act, under 15 U.S.C. § 1052 et seq., in violation of the Anticybersquatting

Consumer Protection Act of 1999, which is embodied in 15 U.S.C. §1125, and in violation of ICANN's Policies.

B. Respondent

Respondent contends that complainant fails to grasp the basic requirements of the UDRP – in particular, that for a domain name to be “registered and used” in bad faith, it must necessarily have been registered in bad faith. Respondent argues that Complainant fails here because Complainant admits that the domain name was registered by Respondent in 2000, at least twenty years prior to Complainant's first use of the claimed mark as set forth in Complainant's registration for the GO TO HALE Mark.

Respondent submits that he legitimately registered and has used the domain name for legitimate purposes having nothing to do with Complainant's claimed mark for legal services, for more than two decades.

Respondent submits evidence to support that Respondent was in fact the registrant who owned the domain name since at least as early as April 20, 2005 (this being the earliest DomainTools WHOIS history record), operating a legitimate cybersecurity consultancy business. Respondent further verified Respondent's identity through business records filed with the state at that time in which Respondent operated his consultancy business. Respondent contends that although Complainant may be able satisfy the “atemporal” first element of the Policy with its registered GO TO HALE Mark under paragraph 4(a)(i) of the Policy, the bad faith registration and use requirements of paragraph 4(a)(iii) of the Policy are generally fatal to belated claims against prior domain name registrants. Respondent notes that Complainant's principal, whose surname is Hale, was admitted to the practice of law in the fall of 2014. Respondent contends, therefore, that he was “likely a young teenager in 7th or 8th grade when the Respondent, already an accomplished cybersecurity professional, registered the domain name”. Respondent contends Complainant's registration of the GO TO HALE Mark is irrelevant to the ultimate outcome of the decision because registration is for a line of business, legal services, in which Respondent has never engaged, and the registration occurs two decades after Respondent registered the Disputed Domain Name incorporating Respondent's own surname for his legitimate business.

Respondent next contends Complainant has failed to grasp Respondent's legitimate right of priority: as prior UDRP panel decisions have noted that the system of domain name registration is generally a first-come, first-served system in which the first person in time to register a domain name would normally be entitled to use the domain name for any legitimate purpose it wishes.

Respondent next argues that the use of one's own surname in a domain name is generally sufficient evidence of a right or legitimate interest in a disputed domain name.

Respondent argues that Complainant cannot meet its burden under the third element of the Policy: to prove that Respondent registered and used the domain name in “bad faith” relative to Complainant's GO TO HALE Mark. Since Complainant's mark, first used in 2020 and registered in 2021, did not exist when Respondent acquired the domain name in 2001, it is not possible to find the domain name was registered in bad faith.

Respondent goes on to contend that the only bad faith present here, is on the part of Complainant, because in addition to Complainant pursuing a UDRP proceeding on admitted facts demonstrating the case to be without merit, Respondent contends Complainant's intention in filing its claim is to publicly smear Respondent, the chief security officer of a publicly traded company, with false and unsupported accusations pulled completely out of thin air without any evidentiary basis whatsoever.

Respondent contends that Complainant has published baseless and damaging accusations against Respondent considering it would have required “psychic powers” for Respondent to have predicted, in 2000, that Complainant would choose GO TO HALE as its mark 20 years later. It is, therefore, absolutely clear that Respondent could not possibly have intentionally created any confusion with Complainant's mark, contrary to the reckless accusations Complainant has made.

6. Discussion and Findings

6.1 Procedural Issue: Termination of the Proceeding

On February 7, 2023, Respondent's representative timely submitted their Response to the Center via email, copying Complainant and requesting a three-member panel. On February 8, 2023, the Center confirmed receipt, instructed the parties on submitting panelist preferences and notified Complainant of its additional payment required under paragraph 6(b) of the Rules to appoint the three member panel. On February 13, 2023, Complainant emailed its list of three panel candidates and stated: "Complainant is submitting payment in the amount of [USD]500.00 for the three-member panel through the WIPO payment portal." The following day, February 14, 2023, the Center emailed both Parties and confirmed receipt of Complainant's email but also stated "We kindly ask you to send proof of payment for the remaining USD 500". The Center sent similar follow up emails on February 16, 17, and 21 solely to ask Complaint to provide proof of payment for the above amount due, noting additionally on February 21 that "the Proceeding is already delayed".

On March 16, 2023, Respondent emailed the Center noting it had been "over a month since the last communication in this Proceeding", questioning whether Respondent had "missed an email", and requesting any missing emails and a status update on the proceeding.

On March 21, 2023, in an email sent to the Center and Complainant at 14:05 according to Respondent's email header, Respondent: 1) outlined the dates and correspondence comprising the month long delay; 2) noted that since the Center had not advised Respondent of any potentially missing emails, "we can only assume that the delay has been the result of non-payment of the USD 500 owed by Complainant"; and 3) proof of payment made by Respondent of the remaining USD 500 owed by Complainant in order for the Center to appoint the panel and move forward with the case. Respondent in the same email unequivocally objected to a unilateral withdrawal by Complainant, asserting under a prior UDRP decision cited, that termination would leave Respondent vulnerable to the filing of similar actions in the future, while continuing would give Respondent an opportunity to obtain findings regarding the merits of the Complaint and Respondent's request for RDNH consideration under paragraph 15(e) of the Rules.

Within the hour, at 14:52 on Complainant's email header and as it appears the Parties representatives are located in the same time zone, Complainant notified the Center that it was voluntarily withdrawing its complaint and requesting the Center to "dismiss the proceeding with prejudice".

Later that same day, Respondent repeated his objection to Complainant's withdrawal with an additional follow up email providing additional cases supporting its arguments expressly requesting this Proceeding continue to a decision. Respondent contended the funds had been paid for the three member panel's appointment and administrative costs necessary to move the case forward and, therefore, "at a minimum" Respondent was entitled to a decision by the Panel on Complainant's request to unilaterally and unconditionally withdraw to terminate these proceedings.

The Panel agrees with Respondent and denies Complainant's request for termination of the proceeding through unilateral withdrawal of its Complaint, applying relevant decisions of prior UDRP panels. In *Intellect Design Arena Limited v. Moniker Privacy Services / David Wieland, iEstates.com, LLC*, WIPO Case No. [D2016-1349](#) a UDRP panel faced with similar circumstances provided an extensive analysis of the applicable Rules and prior UDRP decisions to reach its finding that the respondent's objections were justifiable to deny a complainant's request for termination, even where the complainant indicated that it would be content for the administrative proceeding to be terminated "with prejudice" and provided an undertaking that it would not refile the complaint. The panel in *Intellect Design* first analyzed paragraphs 17 (b) and 10(b) of the Rules *in pari materia* to reach their result.

The panel viewed Rule 17 (b) as a "catch-all" provision to cover any circumstances where it might be appropriate to order termination in the absence of an agreed settlement (*cf.* paragraph 17(a)), but to ensure that neither of the Parties is disadvantaged by any such termination, paragraph 17(b) also contemplates either Party raising justifiable grounds for objection. Turning to paragraph 10(b) the panel made particular

reference to its requirements that the panel treat the Parties with equality and ensure that each is given a fair opportunity to present its case. *Intellect Design, supra*.

Based on the above analysis, this Panel finds, as in *Intellect Design*, it is clear from the provisions of the Response, read with Respondent's emails of March 21, 2023, that Respondent's objections lie in the fact that Respondent has been put to the time and expense of preparing a Response to a Complaint which Respondent considers to be wholly lacking in merit, entitling Respondent to a finding of RDNH. Thus, terminating the proceedings at this stage would result in Complainant avoiding consideration of the merits in general and the issue of RDNH in particular, leaving Respondent in a disadvantaged position.

At the time of Complainant's purported withdrawal on March 21, 2023, Respondent had already been put to the time and expense of engaging legal representation and submitting a response, enduring undue delay due to Complainant's failure to confirm payment demanded repeatedly by the Center and (somewhat astonishingly given the expectation of professional conduct and candor for a legal representative and in that regard noting the representation in the February 13 email that payment had been submitted) stating in Complainant's March 23, 2023, email to the Center and the Respondent that paid their fee with proof of payment "No deadline for payment of fees was ever communicated to Complainant until yesterday".

Accordingly, this Panel concludes as have prior UDRP panels in the cases cited below, that termination of the proceeding would potentially leave Complainant free to refile a complaint under the Policy or in another forum, whereas continuing the proceeding will give the Parties but notably here Respondent an opportunity to obtain findings regarding the merits of the Complaint and Respondent's request for consideration under paragraph 15(e) of the Rules. See *Design Intellect, supra*; see also *Gstaad Saanenland Tourismus v. Domain Administrator, PrivacyGuardian.org / Dimitri Dimitriadis*, WIPO Case No. [D2016-2601](#) ("In the same way as a complaint is *prima facie* entitled to ask for a full decision so that its position is publicly vindicated, so is a respondent. This is particularly so where, as here, the respondent has actively sought a finding of reverse domain name hijacking."); *Türkiye'nin Otomobili Girişim Grubu Sanayi Ve Ticaret Anonim Şirketi v. The Office of George Gould*, WIPO Case No. [D2021-1949](#) (request for termination granted on similar grounds).

On March 21, 2023, the Center noted that Respondent objected to withdrawal of the Complaint and notified the parties that "absent a joint request to withdraw the case, the Center expects to proceed to panel appointment on March 24, 2023". The Center also once again, for at least the fourth time, requested Complainant to provide proof of payment that Complainant said it was submitting to WIPO on February 13, 2023.

In an email dated March 23, 2023, which appears to be the last entry in the case file, Complainant wrote to the Center, which email contained a number of statements which appear clearly at odds with the factual record in the emails discussed above. These statements include: "No deadline for payment of fees was ever communicated to Complainant until yesterday [March 22, 2023]"; ... "in an effort to prolong the proceeding, Respondent has attempted to pay the \$500 fee subsequent to Complainant's notice of withdrawal of the Complaint to Respondent" and "Complainant made a payment of \$500 for the three-member panel today [March 23, 2023]. We will circulate the proof of payment tomorrow morning". Complainant's March 23 email concluded with: "Under the circumstances, we believe it is unnecessary to continue with the administrative proceeding. We respectfully request that WIPO reconsider our request to terminate the UDRP proceeding with prejudice."

Considering the foregoing cases applied to all of the circumstances, the Panel denies Complainant's request for reconsideration.

6.2 Substantive Issues

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on Complainant to make out its case and it is apparent from the terms of the Policy that Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer a domain name. The standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See, [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition \(“WIPO Overview 3.0”\)](#), section 4.2.

Thus, for Complainant to succeed it must prove within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
2. Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
3. The Disputed Domain Name has been registered and is being used in bad faith.

The Panel will deal with each of these requirements in turn.

A. Identical or Confusingly Similar

To prove this element, Complainant must first establish that there is a trademark or service mark in which it has rights. Ownership of a nationally registered trademark constitutes *prima facie* evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant claims trademark rights in the GO TO HALE Mark for legal services in the United States under the trademark registration referenced above in Section 4, for which sufficient evidence has been submitted in the form of electronic copies of a valid and subsisting certificate of registration in the name of Complainant.

With Complainant’s rights in the GO TO HALE Mark established, the remaining question under the first element of the Policy is whether the Disputed Domain Name is identical or confusingly similar to Complainant’s GO TO HALE Mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. [WIPO Overview 3.0](#), section 1.7.

The Panel has considered a side-by-side comparison between the Disputed Domain Name and Complainant’s GO TO HALE Mark and finds the GO TO HALE Mark is incorporated in its entirety and identical to the Disputed Domain Name, except for the removal of spaces and the addition of the Top-Level Domain “.com”, both of which are irrelevant in determining whether the Disputed Domain Name is confusingly similar. See, *e.g.*, *Afton Chemical Corporation v. Frank Cole, Mohammed Vissaka*, WIPO Case No. [D2014-0892](#); *Research in Motion Limited v Thamer Ahmed Alfarshooti*, WIPO Case No. [D2012-1146](#).

Accordingly, a majority of the Panel (Thompson and Austin) find the Disputed Domain Name confusingly similar to the GO TO HALE Mark in which Complainant has rights and Complainant has thus satisfied its burden under paragraph 4(a)(i) of the Policy (this not being a particularly onerous test). The third member of the Panel (Abel) prefers to find the fact that the domain name registration predates Complainant’s trademark rights renders Complainant’s claim on this prong fatally flawed. However, while she does not agree with the reasoning and finding of the majority of the Panel with regard to this first element of the Policy, as the Panel are in agreement with regard to the remaining elements of the Policy, the outcome of the decision is unanimous.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, Complainant has the burden of establishing that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. It is established through prior UDRP decisions under the Policy that it is sufficient for Complainant to make a *prima facie* showing that Respondent has no rights or legitimate interests in the Disputed Domain Name in order to shift the evidentiary burden of production, by way of rebuttal, to Respondent.; See *Champion Innovations, Ltd. v. Udo Dussling (45FHH)*, WIPO Case No. [D2005-1094](#).

It is clear from the record there is no pre-existing business relationship here between Respondent and Complainant. Complainant has also asserted that Respondent has not used the Disputed Domain Name since 2001 and shows the domain name currently resolves to a parked page with pay per click (“PPC”) links to services for flights and apartment rentals and claims that Respondent is not using the Disputed Domain Name for a legitimate use.

Respondent persuasively argues, however, with supporting evidence in the Response, that contrary to Complainant’s assertions Respondent registered the Disputed Domain Name at least 20 years before Complainant registered its GO TO HALE Mark and has for the past 23 years made legitimate use of the Disputed Domain Name. Respondent shows in the Exhibits attached to the Response, that since 2001 Respondent made use of the Disputed Domain Name for an IT consultancy business incorporating his surname, “Hale Solutions”, while he was employed as the IT Director of a university in Idaho in the early 2000’s as shown on Mr. Hale’s submitted LinkedIn profile and Idaho business registration. Respondent also shows in evidence submitted in the Exhibits that Respondent has relied upon the Disputed Domain Name as configured for his email address which Respondent has maintained for conducting his personal and professional business for more than twenty years before Complainant began using “Go to Hale” as a mark for legal services. In one example, Respondent announces to his email recipients in 2001 that his website accessed through the Disputed Domain Name is active, above a photo advertising that his 1999 Jeep is for sale.

Prior UDRP panels have held that the use of one’s own surname in a domain name is generally sufficient evidence of a right or legitimate interest in a disputed domain name. See *Colussi S.p.A. v. Andrea Colussi*, WIPO Case No. [D2017-1293](#); see also *G. A. Modefine S.A. v. A.R. Mani*, WIPO Case No. [D2001-0537](#).

Respondent’s evidence also shows that he holds the legitimate right of priority, considering he registered the Disputed Domain Name 20 years before Complainant began using their GO TO HALE Mark.

Prior UDRP panels have noted that domain name registration is a “first in time system” and typically the first person in time to register a domain name would normally be entitled to use the domain name for any legitimate purpose it wishes. See, e.g., *Inbay Limited v. Ronald Tse dba Neosparx International*, WIPO Case No. [D2014-0096](#); see also *Verb Products Inc. et al. v. Richard Bloxham* WIPO Case No. [D2014-1023](#); *Wildfire, Inc. v. Namebase*, WIPO Case No. [D2007-1611](#).

Accordingly, Respondent has demonstrated that he legitimately registered and has used the Disputed Domain Name for more than two decades for legitimate purposes having nothing to do with Complainant’s claimed mark for legal services. Respondent therefore has rights and legitimate interests in respect of the Disputed Domain Name and Complainant has failed to meet its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Given the Panel’s finding on the issue of rights and legitimate interests, it is unnecessary to consider the issue of bad faith registration and use. The Panel has nonetheless decided to consider the issue for completeness. This element of the Policy requires Complainant to prove that Respondent both registered and used the domain name in “bad faith” relative to Complainant’s mark. It appears obvious to the Panel that since neither the mark nor Complainant existed at the time Respondent acquired the domain name, it is not possible to find the Disputed Domain Name was registered in bad faith. Given the 20 years by which

Complainant's trademark rights postdate Respondent's registration and legitimate use of the Disputed Domain Name, this Panel echoes the findings of a prior UDRP panel under similar facts: "There is no possibility that the Domain Name was registered in bad faith as Complainant was not in existence at the time and the Respondent could not therefore have contemplated Complainant's then non-existent right when he registered the Domain Name." See *Patricks Universal Export Pty Ltd. v. David Greenblatt*, WIPO Case No. [D2016-0653](#); see also [WIPO Overview 3.0](#), section 3.8.1, and cases cited there.

Complainant has failed to meet its burden under paragraph 4(a)(iii) of the Policy.

7. Reverse Domain Name Hijacking ("RDNH")

Respondent argues that Complainant brought this case in bad faith based on a number of factors, the most important of which is Complainant's decision to pursue a UDRP on admitted facts demonstrating the case to be without merit, namely, the registration of the Disputed Domain Name 21 years before Complainant registered its GO TO HALE Mark and 18 years before Complainant existed as a law firm.

Section 4.16 of [WIPO Overview 3.0](#) deals with the question "In what circumstances will panels issue a finding of RDNH?":

"Paragraph 15(e) of the UDRP 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'.

RDNH is furthermore defined under the UDRP Rules as 'using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name'. Panels have also referred to paragraphs 3(b)(xiii) and (xiv) of the UDRP Rules addressing possible RDNH scenarios.

Panels have consistently found that the mere lack of success of a complaint is not itself sufficient for a finding of RDNH. At the same time, the mere fact of a respondent default would not by itself preclude an RDNH finding as this ultimately turns on the complainant's conduct. In either event, following some early cases to the contrary, panels have more recently clarified that, for an RDNH finding to be made, it is not necessary for a respondent to seek an RDNH finding or prove the presence of conduct constituting RDNH.

Reasons articulated by panels for finding RDNH include: (i) facts which demonstrate that the complainant knew it could not succeed as to any of the required three elements – such as the complainant's lack of relevant trademark rights, clear knowledge of respondent rights or legitimate interests, or clear knowledge of a lack of respondent bad faith (see generally section 3.8) such as registration of the disputed domain name well before the complainant acquired trademark rights, (ii) facts which demonstrate that the complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint, including relevant facts on the website at the disputed domain name or readily available public sources such as the Whois database, (iii) unreasonably ignoring established Policy precedent notably as captured in this WIPO Overview – except in limited circumstances which *prima facie* justify advancing an alternative legal argument, (iv) the provision of false evidence, or otherwise attempting to mislead the panel, (v) the provision of intentionally incomplete material evidence – often clarified by the respondent, (vi) the complainant's failure to disclose that a case is a UDRP refiling, (vii) filing the complaint after an unsuccessful attempt to acquire the disputed domain name from the respondent without a plausible legal basis, (viii) basing a complaint on only the barest of allegations without any supporting evidence.

Given the undertakings in paragraphs 3(b)(xiii) and (xiv) of the UDRP Rules, some panels have held that a represented complainant should be held to a higher standard.”

Dealing with this final paragraph first, it is to be observed that Complainant is itself a law firm and legally represented. Paragraph 3(b)(xiii) of the Rules provides for the closing certificate required for every complaint under the Policy. The certificate reads:

“Complainant certifies that the information contained in this Complaint is to the best of Complainant’s knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.”

The Panel is entitled to assume that a lawyer signing that certificate has undertaken the necessary research to ensure that the Complaint is properly based. Moreover, the Panel is entitled to assume that the Complaint has been seen by Complainant and seen to be “complete and accurate” and approved by Complainant.

The substance of the Complaint in respect of the second and third elements comprises six paragraphs taken almost word for word from Complainant’s representative’s letter of demand of April 21, 2022. That letter contained no supporting evidence for Complainant’s claims and neither did the Complaint other than a parked page with links unrelated to Complainant’s legal services or Respondent’s IT consultancy services. In the view of the Panel Complainant must have known that without supporting evidence the Complaint was doomed to failure – at least from the moment of naming Respondent Hale in the Amended Complaint, especially given that Respondent filed first by twenty years.

On the above grounds alone the Panel would have made a finding of RDNH. No attention appears to have been given to the resources available on the Center’s website, a primary resource being the [WIPO Overview 3.0](#) in the drafting of the Complaint; alternatively, they were ignored. The Complaint is entirely devoid of citation to any UDRP case and relies solely on a general unsupported assertion that: “The continued registration and use of the domain name is in bad faith, in violation of the Lanham Act, under 15 U.S.C. § 1052 et seq., in violation of the Anticybersquatting Consumer Protection Act of 1999, which is embodied in 15 U.S.C. §1125, and in violation of the ICANN’s Policies.”

Finally, as noted above, Respondent produced evidence to show the registration of the Disputed Domain Name 21 years before Complainant registered its Mark and 18 years before Complainant existed as a law firm. In that respect the Complaint was incomplete as Complainant did not address this issue in its Complaint. While it could have been understandable that the Complainant was in the dark as to the identity of the Respondent as under privacy when the Complaint was filed (and noting there is no current use of the disputed domain name and Respondent did not reply to Complainant’s demand letters), the Amended Complaint lists Respondent Hale as the registrant. Respondent has also produced evidence to show Respondent has used the Disputed Domain Name for legitimate purposes for its email for the past 23 years, contrary to Complainant’s unsubstantiated allegations in its Complaint that Respondent had not used the Disputed Domain Name since June 2001.

Respondent submitted that this Complaint amounts to a case of reverse domain name hijacking for these reasons and what Respondent correctly claims are speculative, unsubstantiated accusations by Complainant accusing Respondent of intentionally creating confusion, when it was Complainant who registered its identical conflicting mark 20 years after Respondent registered its domain name, totally unaware, of course, of a law firm that would only come into existence decades later. There is no evidence on the record that Respondent set out to intentionally create confusion. With the benefit of apparently experienced intellectual property advisors, Complainant should have been aware that, in these circumstances, its Complaint – at least as Amended – could not succeed. However it proceeded with the claim. While it did seek to withdraw the case, this was not on learning the identity of Respondent – which would have been an understandable moment to seek to withdraw the case – but only once a Response was submitted. This is an abuse of the Policy and the Panel therefore finds this to be a case of reverse domain name hijacking.

8. Decision

For the foregoing reasons, the Complaint is denied.

/Scott R. Austin/

Scott R. Austin

Presiding Panelist

/Roderick Thompson/

Roderick Thompson

Panelist

/Sally M. Abel/

Sally M. Abel

Panelist

Date: April 20, 2023