

ADMINISTRATIVE PANEL DECISION

Sidley Austin LLP v. Billy Atwood
Case No. D2024-3517

1. The Parties

The Complainant is Sidley Austin LLP, United States of America (“United States”), internally represented.

The Respondent is Billy Atwood, United States.

2. The Domain Name and Registrar

The disputed domain name <sidleyh.com> is registered with Squarespace Domains II LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 30, 2024. On August 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 30, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 6, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on September 12, 2024.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 3, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 4, 2024.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on October 9, 2024. 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 an international law firm originally established in the United States; it and its affiliates operate offices in North America, Europe, and the Asia-Pacific region. It licenses use of the SIDLEY mark from Sidley Austin Holding LLP, an entity established to hold the intellectual property rights on behalf of the various Sidley Austin partnerships, including the Complainant. Sidley Austin Holding LLP is the proprietor of, and accordingly the licensor of, United States Trademark Registration No. 3328229 for SIDLEY (word mark), registered on November 6, 2007, for “legal services” in class 42, claiming a date of first use of January 2006.

The Complainant operates its primary website at the domain name <sidley.com>, which it registered in 1995.

The disputed domain name was registered on August 7, 2024. At the time of the Complaint and of this Decision, it did not resolve to an active website.

No information is available about the Respondent.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that it is one of the world's oldest and most widely-known law firms and has operated over 150 years. It is consistently rated highly in industry publications. It is one of the largest United States-based law firms with approximately 2,300 lawyers and annual revenues of over two billion dollars. It maintains offices in over 20 cities worldwide. Since 2006, the firm has been known as Sidley Austin LLP and has been commonly known as Sidley. The SIDLEY mark is owned by Sidley Austin Holding LLP, which licenses trademark rights to the affiliated partnership, including the Complainant. The disputed domain name is identical to the Complainant's mark except for the addition of the letter “h”. The Respondent is not affiliated with the Complainant and has no rights in the disputed domain name, which is not used in connection with any bona fide business but is being passively held in bad faith. The Complainant's mark is well known and distinctive; the Respondent has no rights in it; the Respondent appears to have provided false or misleading contact information, listing a street address in one state and a telephone number affiliated with a person resident in another state.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.7.

According to UDRP practice, a trademark owner's affiliate such as a subsidiary of a parent or of a holding company, or an exclusive trademark licensee, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint. [WIPO Overview 3.0.](#), section 1.4.1. The Panel notes that the Complainant is one of the licensees of the trademark holder. The Panel finds that the evidence available in

the record establishes the Complainant's authorization to bring this Complaint. Accordingly, the Panel finds that the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the SIDLEY mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The Panel finds that the addition of the terminal letter "h" is a misspelling of the Complainant's mark and does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.9.

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

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel notes that the composition of the disputed domain name, which reflects the SIDLEY mark followed by the letter "h", and that there is a risk that Internet users will not notice the subtle misspelling of the Complainant's mark. Therefore, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation to the Complainant that cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

The Respondent has not proved rights or legitimate interests. There is no evidence that the Respondent is commonly known by the disputed domain name, or that there are any circumstances or activities that would establish the Respondent's rights therein. Rather, the disputed domain name is inactive. Under these circumstances, such use cannot establish rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.5.2, and cases cited thereunder.

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

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has not actively used the disputed domain name.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the SIDLEY mark and the composition of the disputed domain name clearly targeting the Complainant's mark and is almost identical to the Complainant's domain name <sidley.com> and finds that, in the circumstances of this case, the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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 <sidleyh.com> be transferred to the Complainant.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: October 23, 2024