

## **ADMINISTRATIVE PANEL DECISION**

Sidley Austin LLP v. Hanna Berry  
Case No. D2024-3917

### **1. The Parties**

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

The Respondent is Hanna Berry, Germany.

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

The disputed domain name <sikley.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 25, 2024. On September 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 26, 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 26, 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 October 2, 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 October 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 23, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 24, 2024.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on October 29, 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 one of the world's oldest and widely known law firms providing legal service around the world for more than 150 years.

The Complainant is the owner of the United States word mark SIDLEY No. 3,328,229, registered on November 6, 2007, for services in class 42 (the "SIDLEY Trademark").

The Complainant is also the owner of a domain name incorporating the SIDLEY Trademark: <sidley.com>.

The Complainant changed its name on several occasions, but each time, the SIDLEY Trademark remained the core of its name.

The disputed domain name was registered on August 19, 2024, and is inactive.

#### **5. Parties' Contentions**

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

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

Notably, the Complainant contends that the disputed domain name is identical or confusingly similar to a trademark or service mark in which it has rights. The Complainant highlights that it and its SIDLEY Trademark are widely known and that while the Complainant name evolved with time, the word "sidley" always remained. The Complainant asserts the disputed domain name is confusingly similar to its SIDLEY Trademark since only one letter was changed in the disputed domain name. For the Complainant this only change does not render a domain name significantly different and on the contrary is evidence of a typosquatting situation.

Then, the Complainant submits the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant explains that it does not employ and has never employed the Respondent. The Complainant considers the Respondent is not making any legitimate noncommercial or fair use of the disputed domain name. On the contrary, the Complainant asserts the only known use of the disputed domain name is fraudulent and that the disputed domain does not resolve to a page with any content.

Finally, the Complainant asserts the disputed domain name was registered and is being used in bad faith since it was used to impersonate a partner of the Complainant. The Complainant considers that in this case bad faith can and should be presumed since the Respondent has registered a domain name that is identical to its SIDLEY Trademark and since the Respondent makes no apparent use of the disputed domain name at the moment. Finally, the Complainant underlines that the Respondent has given fake contact details when registering the disputed domain which is evidence of bad faith.

##### **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.

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 Panel finds the mark is recognizable 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.

Indeed, a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. [WIPO Overview 3.0](#), section 1.9.

In this case, the Panel finds the Respondent has misspelled the SIDLEY Trademark by replacing the letter "d" with the letter "k" which does not prevent a finding of confusing similarity.

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.

Indeed, it appears that the Respondent has not received any authorization to use the SIDLEY Trademark in any manner, including for the registration of domain names, and that the Respondent is not affiliated with nor authorized by the Complainant in any way.

Moreover, the Complainant argues that the disputed domain name, which is inactive, was used to impersonate one of its partners.

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 deliberately targeted the Complainant when registering the disputed domain name by using typosquatting methods.

In any case, the disputed domain name is inactive, and the Respondent appears to have given fake contact details when registering the dispute 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 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 or reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case and without the help of a Response, 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 <sikley.com> be transferred to the Complainant.

*/Christiane Féral-Schuhl/*

**Christiane Féral-Schuhl**

Sole Panelist

Date: November 12, 2024