

ADMINISTRATIVE PANEL DECISION

Law Offices of Jeffrey J. Antonelli, Ltd., Inc. dba Antonelli Law, Ltd. v. The Law Offices of Stephen C. Vondran, P.C.
Case No. D2021-2428

1. The Parties

Complainant is Law Offices of Jeffrey J. Antonelli, Ltd., Inc. dba Antonelli Law, Ltd., United States of America, represented by Weaver Robinson Law Firm, PLLC, United States of America.

Respondent is The Law Offices of Stephen C. Vondran, P.C., United States of America, represented by John Berryhill, Ph.d., Esq., United States of America.

2. The Domain Name and Registrar

The disputed domain name <torrentdefenders.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 26, 2021. On July 27, 2021, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 the Respondent of the Complaint, and the proceedings commenced on July 29, 2021. In accordance with the Rules, paragraph 5, the due date for Response was August 18, 2021. On August 13, 2021, Respondent’s representative requested a four-day extension, which was granted by the Center on the same day. The Response was filed with the Center August 22, 2021.

On August 31, 2021, Complainant filed additional unsolicited submissions with the Center.

The Center appointed Francine Tan, Richard G. Lyon, and Brian J. Winterfeldt as panelists in this matter on September 15, 2021. 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.

4. Factual Background

Complainant, Law Offices of Jeffrey J. Antonelli, Ltd., Inc. dba Antonelli Law, Ltd., is a law firm based in Chicago, Illinois, in the United States of America ("United States"). Complainant's services include legal defense services for parties accused of copyright infringement, including uploading files to BitTorrent (file-sharing) sites.

Complainant owns a trademark registration for the TORRENT DEFENDERS word mark (U.S. Reg. No. 5,720,579, filed in 2018 and registered on April 9, 2019), identifying "Online journals, namely, blogs featuring articles on BitTorrent Copyright Infringement cases" in Class 41 and "Providing information about legal services via a website" in Class 45. Complainant also owns a registration for the <torrent-defenders.com> domain name, which Complainant uses to provide a blog offering information on developments in copyright infringement issues.

Respondent, Law Offices of Stephen C. Vondran, P.C., is an intellectual property law firm with offices throughout the United States, including California, Arizona, and Washington, D.C. Respondent's legal services include defense of parties accused of uploading files to BitTorrent sites.

The disputed domain name <torrentdefenders.com> was registered on August 23, 2016. At the time of filing of the Complaint and at the time the decision is rendered, Respondent uses the disputed domain name to redirect to vondranlegal.com/bittorrent-defense-lawyer/, which *inter alia*, offers information on Respondent's BitTorrent defense services.

5. Parties' Contentions

A. Complainant

According to Complainant, the disputed domain name is virtually identical to Complainant's TORRENT DEFENDERS trademark, in which Complainant has demonstrated rights through its United States trademark registration. Complainant asserts that the disputed domain name incorporates Complainant's TORRENT DEFENDERS trademark in its entirety, and that the disputed domain name is also virtually identical to Complainant's <torrent-defenders.com> domain name, with the only difference being that Complainant's domain name includes a dash between the terms "torrent" and "defenders" while the disputed domain name eliminates the dash. Complainant claims that Respondent uses the disputed domain name for services identical to those that Complainant offers at its <torrent-defenders.com> domain name. Complainant argues that Respondent's use of the disputed domain name is so similar to Complainant's use of its own domain name and Complainant's trademark that consumers could be misdirected to a different attorney or that Respondent's conduct could otherwise cause consumer confusion.

Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name. Complainant states that he owns the only TORRENT DEFENDERS trademark registration on record with the United States Patent and Trademark Office. Complainant also claims that he had prior common law rights in the TORRENT DEFENDERS mark arising from its use of the mark in commerce beginning on October 31, 2012, significantly predating Respondent's registration in 2016 of the disputed domain name. Complainant asserts that Respondent is not using the TORRENT DEFENDERS mark as a brand, but is using the

disputed domain name in a commercial capacity to redirect consumers to Respondent's website offering competing, identical services.

Complainant asserts that the disputed domain name was registered and is being used in bad faith. Complainant contends that Respondent was aware of Complainant's TORRENT DEFENDERS brand at the time of registration of the disputed domain name. Complainant alleges that Respondent's specific intent in registering the disputed domain name was to redirect traffic from Complainant's <torrent-defenders.com> domain name and to disrupt Complainant's business, not to establish a brand name in the disputed domain name. Complainant further alleges that Respondent intended to use the TORRENT DEFENDERS trademark to compete with Complainant for the offering of legal services in the defense of BitTorrent copyright infringement cases and to free-ride on Complainant's investment in advertising and promotion of the TORRENT DEFENDERS trademark.

B. Respondent

Respondent admits that Complainant's United States trademark registration in TORRENT DEFENDERS is sufficient to show that the disputed domain name is identical or confusingly similar to a mark in which Complainant holds rights. Respondent argues that, notwithstanding the registration, Complainant's mark is not in use in connection with a *bona fide* offering of services in Class 45, namely "Providing information about legal services via a website," but instead is used to advertise legal services. Respondent asserts that Respondent registered the disputed domain name before Complainant had established rights in the TORRENT DEFENDERS mark. Respondent argues that Complainant admitted that the TORRENT DEFENDERS mark was not inherently distinctive as of its first use in commerce by seeking registration under Section 2(f) of the Lanham Act, which allows otherwise descriptive terms to be registered as trademarks if they have acquired distinctiveness through use in commerce and permits the United States Patent and Trademark Office to accept proof of at least five years of substantially exclusive and continuous use in commerce as *prima facie* evidence of acquired distinctiveness. Respondent argues that a United States trademark cannot have acquired distinctiveness before the date on which it has claimed to have made the aforementioned five years' use. Respondent accordingly contends that the TORRENT DEFENDERS mark would not have acquired distinctiveness and therefore Complainant would not have priority until August 1, 2018, nearly two years after the disputed domain name was registered on August 23, 2016. Respondent asserts that Complainant has not presented evidence of its dates of first use prior to the filing of its application to register TORRENT DEFENDERS on August 1, 2018.

Respondent asserts that it has a legitimate right and interest in using the disputed domain name because its use is prior to the trademark rights for which Complainant has provided evidence. Respondent argues that the registration in TORRENT DEFENDERS is only sufficient to evidence priority in the mark as of August 1, 2018 filing date, as explained above. It also argues in the alternative that trademarks in the United States may only acquire distinctiveness after five years continuous use, that priority runs from the date of acquired distinctiveness and that, therefore, even if Complainant began use of TORRENT DEFENDERS in 2012, its priority would only begin in 2017, after Respondent registered the disputed domain name. Respondent cites several prior UDRP decisions in which the panels found that domain name registrants maintain rights in their domain names even if other parties have later acquired distinctiveness in the terms contained in such domain names. Respondent also argues that Respondent is using the term "torrent defenders" in a descriptive sense to refer to attorneys who provide legal defense services to parties accused of sharing allegedly copyright-infringing content through BitTorrent sites, and provides several examples of other parties' use of "torrent defense" and similar terms in a descriptive sense. Respondent also states that, from time to time, he registers domain names that are descriptive of his legal services and uses them to direct Internet users to the appropriate pages of his website, and provides eight examples of such registrations.

Respondent asserts that the disputed domain name was not registered and used in bad faith. Respondent argues that Respondent could only have registered the disputed domain in bad faith if it knew of exclusive rights in the TORRENT DEFENDERS mark for legal services when the registration was made in 2016. Respondent asserts, however, that because Complainant had not filed a trademark application at that time, Respondent would have had no way of knowing that Complainant sought to use the term “torrent defenders” in a trademark sense instead of in a merely descriptive sense. Respondent also asserts that it would not have learned of Complainant’s registration of <torrent-defenders.com> in making its own registration of the disputed domain name, because the former, hyphenated domain name is “less-preferred” by domain name registrants. Respondent also contends that Respondent’s pattern of registering domain names that correspond to descriptive terms for Respondent’s legal services further demonstrates that there was no bad faith. Respondent argues that this proceeding is brought in knowing bad faith for the improper purpose of securing a transfer of the disputed domain name, which is more desirable than <torrent-defenders.com>, and that Complainant’s claims of priority and acquired distinctiveness have no basis in law based on Section 2(f) of the Lanham Act.

6. Discussion and Findings

Subsequent to filing of the Response, Complainant filed additional unsolicited submissions on August 31, 2021. Per the UDRP Questions, Section 4.6, a panel has discretion to determine whether to accept such supplemental filings. Because Complainant’s supplemental filings do not add any new information that was not contained in the original Complaint, the Panel has decided to disregard the August 31, 2021 submissions. See *Parfums Christian Dior S.A. v. Jadore*, WIPO Case No. D2000-0938.

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

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

A. Identical or Confusingly Similar

A national or international trademark registration is *prima facie* evidence that the holder has the requisite rights in the registered mark for purposes of paragraph 4(a)(i) of the Policy. WIPO Overview 3.0, section 1.2.1. Complainant has provided evidence that it owns a United States registration for the TORRENT DEFENDERS trademark, as referenced above. Respondent has additionally admitted that Complainant’s registration meets this criterion. Therefore, Complainant has established that it has rights in the TORRENT DEFENDERS trademark.

The remaining question under the first element of the Policy is whether the disputed domain name (typically disregarding the Top-Level Domain (“TLD”) in which the domain name is registered) is identical or confusingly similar to Complainant’s 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. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. *Id.*

Making such a side-by-side comparison, the disputed domain name is virtually identical to Complainant's TORRENT DEFENDERS mark, differing only by the absence of a space and the addition of the TLD.

The Panel therefore finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain name is identical to its TORRENT DEFENDERS mark.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, Complainant must make at least a *prima facie* showing that Respondent possesses no rights or legitimate interests in the disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. D2008-1393. Once Complainant makes such a *prima facie* showing, the burden of production shifts to Respondent, though the burden of proof always remains on Complainant. If Respondent fails to come forward with evidence showing rights or legitimate interests, Complainant will have sustained its burden under the second element of the UDRP.

Paragraph 4(c) of the Policy lists the ways that Respondent may demonstrate rights or legitimate interests in the disputed domain name:

- (i) before any notice of the dispute, respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed 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 disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Here, Complainant has alleged that Respondent has no rights or legitimate interests in the disputed domain name. Specifically, Complainant asserts that Respondent registered the disputed domain name in 2016, long after Complainant began using the TORRENT DEFENDERS trademark and the very similar <torrent-defenders.com> domain name, and that Respondent's use of the TORRENT DEFENDERS mark to redirect consumers to Respondent's website for identical completing services does not confer rights or a legitimate interest in the disputed domain name.

Both parties rely significantly on arguments about United States trademark principles applicable to filings under Section 2(f) of the Lanham Act. While trademark law informs Policy precedent, a UDRP proceeding is not an abridged infringement action and Policy precedent may differ from trademark law in some specific respects, and based on individual case facts and circumstances. See, e.g., WIPO Overview 3.0, section 1.1.3 ("Where a domain name has been registered before a complainant has acquired trademark rights, only in exceptional cases would a complainant be able to prove a respondent's bad faith"); *Kellwood Company v. Onesies Corporation*, WIPO Case No. D2008-1172.

Panel determinations under paragraphs 4(a)(ii) and (iii) of the Policy ordinarily turn on two issues: whether the respondent was actually aware, or should have been aware, of the complainant and its mark at the time the disputed domain name was registered; and whether the respondent registered and used the disputed domain name to take advantage of the mark's goodwill. As with any other substantive matter, the complainant must establish these issues with competent evidence.

Complainant here has not met his evidentiary burden on either issue. Complainant filed his trademark application in 2018, two years after Respondent registered the disputed domain name. Had Respondent done a USPTO search prior to registration he would not have discovered the Complainant or his putative mark. True, Complainant has alleged prior usage and common law rights but has furnished scant proof of such rights.

Complainant's claim of acquired distinctiveness under Section 2(f) of the Lanham Act is effectively an admission that the TORRENT DEFENDERS trademark lacks inherent distinctiveness and was initially considered a descriptive term and the Panel independently makes that finding as discussed below. See, e.g., *See Harvard Lampoon, Inc. v. Reflex Publishing Inc.*, WIPO Case No. D2011-0716. The only evidence of pre-filing use are undated firm brochures attached to the Complaint. Even if accepted as predating 2016, they are insufficient to establish that torrent-defender was particularly associated – much less exclusively associated as alleged – with Complainant. There is no evidence on the record before the Panel of any other reason why Respondent should have been aware of Complainant or his mark.

There is similarly no evidence of Respondent's targeting of Complainant, only the unsupported allegation of Complainant's counsel. Those are of no force or effect. WIPO Overview 3.0, section 4.3. Without proof of targeting or direct imitation, Respondent's use of the disputed domain name, a somewhat descriptive term, to relay traffic to his firm's website appears to be legitimate and not done in a bad faith attempt to target Complainant.

Respondent has demonstrated that it is using the term "torrent defenders" in its descriptive sense to describe the subject matter of the website to which it redirects the disputed domain name, which contains information and articles about defending copyright infringement claims related to "torrent" file sharing sites, and to describe its provision of related legal services. WIPO Overview 3.0, section 2.10. Because Respondent has been using the disputed domain name in connection with this offering of services since 2016, before receiving any notice of the domain name dispute at issue in this proceeding, Respondent has satisfied the requirement set forth by Paragraph 4(c)(i) of the Policy. See *B-Boy TV Ltd v. bboytv.com c/o Whois Privacy Service / Chief Rocka LTD, formerly named BreakStation LTD.*, WIPO Case No. D2012-2006.

C. Registered and Used in Bad Faith

For similar reasons, the Panel does not find evidence of bad faith in the registration and use of the disputed domain name. While Complainant states that Respondent must have been aware of Complainant's TORRENT DEFENDERS trademark "on information and belief," Complainant has not provided any direct evidence that Respondent knew, at the time of registration of the disputed domain name, that Complainant was using the term TORRENT DEFENDERS or the <torrent-defenders.com> domain name. Even if Respondent did know of Complainant's use, there is no evidence of record to support the contention that Respondent would recognize that TORRENT DEFENDERS was being used by Complainant in a trademark sense, *i.e.*, as a source indicator for Complainant, rather than in a descriptive sense. The trademark application for TORRENT DEFENDERS and subsequent registration alone cannot serve as evidence that Registrant was on notice of Complainant's assertion of rights because they are subsequent to Respondent's registration of the disputed domain name and the Panel has found the evidence of use before this date insufficient to show knowledge and targeting on Respondent's part. Accordingly, the Panel finds that Complainant has not proven that Respondent registered the disputed domain name in bad faith.

Regarding use of the disputed domain name, Complainant asserts that Respondent has used the disputed domain name to deliberately disrupt Complainant's business. Respondent asserts that he has used the disputed domain name to direct consumers who are looking for BitTorrent defense lawyers to his website. Given these competing claims, and noting that the evidentiary burden falls to Complainant, the Panel is unable to find that Complainant has met its burden here regarding use in bad faith. Prior panels have found that the use of a domain name containing descriptive words for advertising or commercial purposes can be a legitimate use and thus cannot be considered bad faith. See *Tax Analysts v. eCorp*, WIPO Case No. D2007-0040.

The Panel clarifies here that it is not presuming to offer an opinion on the intent of Respondent in registering and using the disputed domain name. The Panel's position is simply that Complainant has not met the criteria under the Policy for demonstrating registration and use of the disputed domain name in bad faith. Any other nuances of trademark law that may be at issue in a dispute between Complainant and Respondent are beyond the scope of the Policy.

Accordingly, Complainant has not satisfied the conditions for demonstrating registration and use in bad faith under Paragraph 4(a)(iii) of the Policy.

D. Reverse Domain Name Hijacking

Under Paragraph 15(e) of the UDRP Rules, "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." Respondent has requested such a finding in this case.

The majority of the Panel believes a finding of abuse is appropriate here. Several of the factors set out in section 4.16 of the WIPO Overview 3.0 that support such a finding are present:

- "(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*," (emphasis supplied).

- "(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," The Policy precedent ignored by Complainant here consists of two fundamental underpinnings of Policy proceedings – registration of the disputed domain name prior to Complainant's accruing trademark rights and failure to provide evidence of crucial allegations. "The matters identified in the preceding paragraph are not Policy arcana; each is a precedent of long standing and derived from scores of cases, and each addresses a fundamental Policy requirement." *DIGITI limited liability company v. Privacy Administrator, Anonymize, Inc / Michele Dinoia, Macrosten LTD*, WIPO Case No. D2018-2148, quoting from *Pick Enterprises, Inc. v. Domains by Proxy, LLC, DomainsByProxy.com / Woman to Woman Healthcare / Just Us Women Health Center f/k/a Woman to Woman Health Center*, WIPO Case No. D2012-1555.

- "(viii) basing a complaint on only the barest of allegations without any supporting evidence."

Further, Complainant, himself an intellectual property lawyer, is represented by counsel, a factor that some panels have found – and the Panel majority finds here – should be held to a higher standard. WIPO Overview 3.0, section 4.16; see also *Centroamerica Comercial, Sociedad Anonima de Capital Variable (CAMCO) v. Michael Mann*, WIPO Case No. D2016-1709 ("the Complainant, who is represented by specialist attorneys who appear to have specific expertise in this area, knew or ought to have known that this was the case."); *Pick Enterprises, Inc., supra*, ("The fact that Complainant is represented by counsel makes the filing of this Complaint all the more inexcusable.")

The majority of the Panel finds that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Brian J. Winterfeldt/
Brian J. Winterfeldt
Presiding Panelist

/Francine Tan/
Francine Tan
Panelist

/Richard G. Lyon/
Richard G. Lyon
Panelist
Date: October 4, 2021