



## DECISION

Ian Schrager and IS Company LLC d/b/a Ian Schrager Company v. Christopher Allen

Claim Number: FA2004001892062

### PARTIES

Complainant is **Ian Schrager and IS Company LLC d/b/a Ian Schrager Company** (collectively, "Complainants"), represented by **Eleanor Atkins** of **McDermott Will & Emery LLP**, Illinois. Respondent is **Christopher Allen** ("Respondent"), represented by **Mark Muller**, Florida.

### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<schragercompany.org>** (the "Disputed Domain Name") registered with **Tucows Domains Inc.**

### PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

David L. Kreider, Chartered Arbitrator, as Panelist.

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on April 14, 2020; the FORUM received payment on April 14, 2020.

On April 15, 2020, Tucows Domains Inc. confirmed by e-mail to the FORUM that the **<schragercompany.org>** domain name is registered with Tucows Domains Inc. and that Respondent is the current registrant of the name. Tucows Domains

Inc. has verified that Respondent is bound by the Tucows Domains Inc. registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On April 17, 2020, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of May 7, 2020 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@schragercompany.org. Also, on April 17, 2020, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received on May 6, 2020, consisting of an email from the Respondent's legal representative. The Response purports to consent on behalf of the Respondent, Christopher Allen, to the transfer of the Disputed Domain Name to the Complainant, IS Company LLC d/b/a Ian Schrager Company.

On May 11, 2020, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed David L. Kreider, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

## RELIEF SOUGHT

Complainants request that the domain name be transferred from Respondent to Complainant IS Company LLC d/b/a Ian Schrager Company.

## PARTIES' CONTENTIONS

Complainants:

### **A. The [schragercompany.org](http://schragercompany.org) Domain Name is Confusingly Similar to Complainants' Marks and Official Domain [Rule 3(b)(ix)(1)]**

Complainants have established rights in the IAN SCHRAGER® mark and the IAN SCHRAGER COMPANY mark through continuous and widespread use of the Marks in commerce in the United States and foreign countries, as well as through federal registration of IAN SCHRAGER®. The Disputed Domain Name was registered on March 18, 2020, more than ten years after the registration for IAN SCHRAGER® was issued. *See Ian Schrager v. Satoru Saito / Personal*, FA 1405001557171 (Nat. Arb. Forum June 12, 2014) (“Complainant owns trademark rights in the IAN SCHRAGER mark through its registration thereof with the USPTO.”).

The Disputed Domain Name, [schragercompany.org](http://schragercompany.org), is nearly identical to Schrager’s well-known and federally registered IAN SCHRAGER® mark and Complainants’ valuable IAN SCHRAGER COMPANY mark. *See Ian Schrager v. Satoru Saito / Personal*, FA 1405001557171 (Nat. Arb. Forum June 12, 2014) (finding the domain name <i-schrager.biz> confusingly similar to the IAN SCHRAGER mark).

The Disputed Domain Name is nearly identical to and is confusingly similar to the Ian Schrager Company website domain, [ianschragercompany.com](http://ianschragercompany.com).

The Disputed Domain Name is a form of typosquatting, which “many UDRP panels have found to be confusingly similar” to a complainant’s trademark. *VMWare, Inc. v. Above.com Domain Privacy*, Case No. D2015-1449 (WIPO Oct. 21, 2015).

The addition of the generic top-level domain “.ORG,” does nothing to distinguish the Disputed Domain Name from Complainants’ Marks. *See Travelocity.com LP v. Thomas Lefleur c/o n/a*, FA0911001296087 (Nat. Arb. Forum January 11, 2010) (“Similarly, the addition of a gTLD does not reduce the likelihood of confusion between the resulting domain name and the mark, because every domain name must contain a top-level domain.”).

Therefore, the Disputed Domain Name is nearly identical to and confusingly similar to Complainants’ Marks.

**B. Respondent Has No Rights or Legitimate Interest in the Domain Name**

[Rule 3(b)(ix)(2)]

Respondent does not have any rights or legitimate interests in the Disputed Domain Name.

Schrager is entitled to a presumption of ownership, validity, and the exclusive right to use the IAN SCHRAGER® and Ian Schrager Company marks in connection with the services named in the registration certificate. 15 U.S.C. §1057(b).

Respondent is neither affiliated with, nor has it been licensed or permitted to use Complainants’ Marks or any domain names incorporating the Marks. Under the Policy, Paragraph 4(a)(ii), a statement that the Respondent is not licensed or otherwise authorized to use the disputed domain names constitutes *prima facie* proof for the Complainants that the Respondent lacks any rights or legitimate

interests in the Disputed Domain Name. *See CareerBuilder, LLC v. Stephen Baker*, WIPO Case No. D2005-0251 (May 6, 2005).

Furthermore, on information and belief, there is no indication that Respondent is commonly known by the Disputed Domain Name, either as a business, individual, or other organization. It is well established by prior panel decisions that a respondent does not have rights in a disputed domain name when the respondent is not commonly known by that name. *See Policy ¶ 4(c)(ii)*; *see also Tercent Inc. v. Lee Yi*, FA 139720 (Nat. Arb. Forum Feb. 10, 2003) (stating “nothing in Respondent’s WHOIS information implies that Respondent is ‘commonly known by’ the disputed domain name” as one factor in determining that Policy 4(c)(ii) does not apply). However, as noted above, the Disputed Domain Name is nearly identical and confusingly similar to Schragger’s personal name and the name of his business, the Ian Schragger Company.

Respondent is not engaging in a *bona fide* offering of goods or services or making a legitimate noncommercial fair use of the Disputed Domain Name. *See Policy, Paragraph 4(c)(iii)*. There is currently no content on the page to which the Disputed Domain Name resolves. Failure to make an active use of the name demonstrates that Respondent has no rights to the Disputed Domain Name. *See Infineon Technologies AG v. mustafa mushari*, FA1505001619868, 2015 NAFDD LEXIS 737, at \*9-10 (Nat. Arb. Forum June 27, 2015) (finding Respondent’s failure to actively use website indicative of no rights or legitimate interests in domain).

Respondent’s failure to use the Disputed Domain Name to provide a *bona fide* offering of goods and services confirms that it does not have a right or legitimate interest in the Disputed Domain Name, particularly since Complainants have proven their rights in the Marks at issue. *See Kate Spade, LLC v. Darmstadter Designs*, D2001-1384 (WIPO January 3, 2002) (finding when a mark is proven,

the burden then shifts to the domain holder to prove a right or legitimate interest). Thus, Respondent has not used the Disputed Domain Name in connection with a *bona fide* offering of goods or services. See Policy ¶ 4(c)(i).

Respondent registered and/or acquired the Disputed Domain Name on March 18, 2020, as noted by the date that the domain name record was created. Accordingly, Respondent registered the Disputed Domain Name more than a decade after the IAN SCHRAGER® trademark registration issued. *Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding no rights or legitimate interests where (1) the respondent is not a licensee of the complainant; (2) the complainant's prior rights in the domain name precede the respondent's registration; (3) the respondent is not commonly known by the domain name in question).

Respondent cannot claim to have rights or legitimate interests in the Disputed Domain Name because Respondent is using the domain in bad faith, for the reasons set forth in Section (c) below. See *N.C.P. Marketing Group, Inc. v. Entredomains*, Case No. D2000-0387)(WIPO Jul. 5, 2000) ("Bad faith registration and use of domains does not establish rights or legitimate interests in the names.").

For all of the foregoing reasons, Respondent has no rights or legitimate interests in the Disputed Domain Name.

**C. The Domain Name Was Registered and is Being Used in Bad Faith**

[Rule 3(b)(ix)(3)]

Schrager's ownership of a U.S. registration for the IAN SCHRAGER® mark charged Respondent with constructive notice of Schrager's rights in those marks and is evidence of bad faith. Respondent registered its Disputed Domain Name

ten years after Schrage's IAN SCHRAGER® mark was registered. *See* 15 U.S.C. § 1072; *AARP v. Domains Ventures*, No. 514786 (Nat. Arb. Forum August 25, 2005) (ownership of federal registrations charged respondent with constructive notice of complainant's rights).

By registering the Disputed Domain Name, Respondent engaged in typosquatting as it purposefully registered a variation of Complainants' Marks. Typosquatting constitutes bad faith and a disruption to Complainants' business. *See SunGloss Hut Corporation v. AAANet, Inc.*; FA0003000094370 (Nat. Arb. Forum May 11, 2000) (SUNGLASSHOT.COM vs. SUNGLASSHUT.COM).

By using a domain name confusingly similar to Complainants' Marks, Respondent registered the Disputed Domain Name primarily to disrupt Complainants' business. This constitutes bad faith registration and use under UDRP Policy ¶ 4(b)(iii). *See EthnicGrocer.com v. Latin Grocer.com*, FA0003000094384 (NAF July 7, 2000) (registration of slight variation of Complainant's mark suggests Respondent registered names primarily for the purpose of disrupting Complainant's business).

Respondent's failure to use the Disputed Domain Name for any legitimate purpose shows its bad faith and use of same. Numerous UDRP panels have found that a failure to attempt to develop or use a domain name which contains an established trademark is evidence of bad faith registration pursuant to Policy ¶ 4(a)(iii). *See Am. Broad. Cos., Inc. v. Sech*, FA893427 (Nat. Arb. Forum Feb. 28, 2007) (finding that a respondent's failure to make active use of its domain name in the three months after its registration indicated that the respondent registered the disputed domain name in bad faith).

Finally, given the well-known status of Complainants' Marks and Complainants' ownership of [ianschragercompany.com](http://ianschragercompany.com), there is no reason for Respondent to

have registered the Disputed Domain Name other than to trade off of the reputation and goodwill of Complainants' Marks. *See Charles Jordan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding that the domain name in question is "so obviously connected with the Complainant and its products that its very use by someone with no connection with Complainant suggests opportunistic bad faith").

Respondent:

Respondent's Response consists of an email reciting as follows:

"This law firm represents Christopher Allen in the above-referenced Complaint. Please accept this e-mail communication as our formal response to the Complaint. Mr. Allen has no knowledge of the application for or issuance of the domain name schragercompany.org. The phone number and e-mail address for Mr. Allen are not his. Whoever applied for the domain name did so (*recte*) without Mr. Allen's permission or consent. We suspect that the true applicant prepared the application with false information with the intention of hiding their true identity, and may have picked Mr. Allen's name and street address from a website or directory.

Mr. Allen hereby consents to the relief requested by the Complainant, to wit: that the schragercompany.org Domain Name be transferred to the Complainant, IS Company LLC d/b/a Ian Schrager Company.

Please include me on all future filings in this case."

## **FINDINGS**

Complainants have rights in the IAN SCHRAGER mark through their registration of the mark with the United States Patent and Trademark Office ("USPTO") (*e.g.*,



Reg. No. 3,421,787, registered May 6, 2008) and under the common law in relation to the IAN SCHRAGER COMPANY mark (collectively, the "Marks").

Respondent's Response does not provide the information required by paragraph 5(c) of the Rules, and particularly lacks the certification required by paragraph 5(c)(viii).

The Complainant has not accepted the Respondent's unilateral consent to transfer the Dispute Domain Name.

There exists reason to doubt the genuineness of the Respondent's consent to transfer, where the Respondent's Response disclaims all knowledge of the application for or issuance of the Disputed Domain Name.

Complainants have established all the elements entitling them to relief.

## **DISCUSSION**

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent 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 domain name; and
- (3) the domain name has been registered and is being used in bad faith.

### Preliminary Issue – Respondent’s Consent-to-Transfer

Alleging in his Response that he “has no knowledge of the application for or issuance of the domain name **schragercompany.org**”, and further asserting that whoever applied for the domain name did so “without his permission or consent”, the Respondent casts himself in the role of a stranger to the Disputed Domain Name.

Wishing apparently to both “have his cake and eat it”, Respondent also purports in his Response to consent to the transfer of the **<schragercompany.org>** domain name to Complainants.

In such circumstances (i.e., where the Respondent does not contest the granting of the relief sought by Complainant), it is within the discretion of the Panel to forego the traditional UDRP analysis and order the immediate transfer of the **<schragercompany.org>** domain name. *See Boehringer Ingelheim Int’l GmbH v. Modern Ltd. – Cayman Web Dev.*, FA 133625 (FORUM Jan. 9, 2003) (transferring the domain name registration where the respondent stipulated to the transfer).

The Panel apprehends, however, that such a “consent-to-transfer” approach is sometimes used as a strategy to avoid adverse findings being made against a respondent. For this reason, the presence of special facts or circumstances in a particular case may compel the panel to exercise discretion to undertake a process of fact-finding and analysis of the three Policy elements and render a decision to accompany an order to transfer. Such is the case here.

In *Graebel Van Lines, Inc. v. Tex. Int’l Prop. Assocs.*, FA 1195954 (FORUM July 17, 2008), the panel stated:

“Respondent has admitted in his response to the complaint of Complainant that it is ready to offer the transfer without inviting the decision of the Panel in accordance with the Policy. However, in the facts of this case, the Panel is of the view that the transfer of the disputed domain name deserves to be along with the findings in accordance with the Policy.”

In *Societe Francaise du Radiotelephone-SFR v. Karen*, Case No. D2004-0386 (WIPO July 22, 2004), even though the Respondent agreed to transfer the domain name, the Panel determined that it should examine the merits and consider whether “all requirements have been cumulatively fulfilled for a transfer of a domain name to be affected.” The *Societe Francaise* Panel focused in particular on the quality of the Respondent’s purported consent to an immediate transfer, observing:

“In [the] Panel’s view one should take into account whether (i) the Respondent’s consent was authentic and obviously expressed its true will and intention indicating expressly and unconditionally that the domain name should be transferred, (ii) the Respondent is without doubt the true registrant, and (iii), there are no other circumstances which may give rise to a reasonable doubt as to the true intention of any of the parties involved.” (Emphasis added).

Applying this test to the facts presented in that case, the *Societe Francaise* Panel determined:

“[I]n this case the Panel concludes that not all the above tests have been satisfied because (i) the Respondent seems not to be the true owner and registrant of the domain name [ ]. Consequently, this Panel considers its duty [is] to make findings on the following issues before reaching a final

decision and the Panel shall now turn to examine each one of them separately.” (Emphasis added).

By parity of reasoning in the present case, in view of the Respondent’s Response disclaiming all knowledge of the application for or issuance of the Disputed Domain Name, the Panel decides that it will analyze this case under the elements of the UDRP, Respondent’s purported consent to transfer notwithstanding. *See also, Guess? IP Holder L.P. and Guess?, Inc. v. I S / ICS INC / GEORGE WASHHERE / DOMAIN MAY BE FOR SALE, CHECK AFTERNIC.COM Domain Admin / Domain Registries Foundation, FA1711001758582.*

#### Identical and/or Confusingly Similar

The Disputed Domain Name <**schragercompany.org**> is identical or confusingly similar to a trademark or service mark in which Complainants have rights.

The Disputed Domain Name is nearly identical to Complainants’ well-known and federally registered IAN SCHRAGER® mark and valuable IAN SCHRAGER COMPANY mark. *Ian Schrager v. Satoru Saito / Personal, FA 1405001557171* (Nat. Arb. Forum June 12, 2014) (finding the domain name <i-schrager.biz> confusingly similar to the IAN SCHRAGER mark). Moreover, Respondent’s Domain Name is nearly identical to and is confusingly similar to the Ian Schrager Company website domain, **ianschragercompany.com**. The inclusion of the generic top-level domain “.ORG”, does nothing to distinguish the Disputed Domain Name from Complainants’ Marks.

Complainants have satisfied the first element at Policy ¶ 4(a)(i).

## Rights or Legitimate Interests

Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

Complaints allege that Schragger is entitled to a presumption of ownership, validity, and the exclusive right to use the IAN SCHRAGER® and IAN SCHRAGER COMPANY marks in connection with the services named in the registration certificate. 15 U.S.C. §1057(b).

The Complainant having established a *prima facie* case that Respondent lacks rights and legitimate interests in the Disputed Domain Name under Policy ¶ 4(a)(ii), the burden shifts to Respondent to show it does have rights or legitimate interests. *See Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011)

On its part, as has been noted above, Respondent purports to be a stranger to the Disputed Domain Name, alleging in the Response that he “has no knowledge of the application for or issuance of the domain name **schragercompany.org**”, and further asserting that whoever applied for the domain name did so “without his permission or consent”.

The Panel finds, based on the evidence and Respondent’s admission, that Respondent lacks rights and legitimate interests in the Disputed Domain Name under Policy ¶ 4(a)(ii).

Complainants have satisfied the second element at Policy ¶ 4(a)(ii).

## Registration and Use in Bad Faith

The Disputed Domain Name has been registered and is being used in bad faith.

Complainants' Marks comprise the distinctive, non-dictionary, eponymous terms IAN SCHRAGER and IAN SCHRAGER COMPANY. The Complainant argues, and the Panel finds, that the Respondent knew or must have known of the existence of the Marks at the time the Disputed Domain Name was registered. The Respondent has not alleged the contrary.

The Disputed Domain Name was registered on March 18, 2020. Since that time, the Disputed Domain Name has not been used in connection with an active website. The fact that there is no active website linked to the Disputed Domain Name is another element that shows that the Respondent is not using the Disputed Domain Name in good faith. *See Telstra Corporation Ltd v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 (February 18, 2000).

In addition to the above, the Respondent itself in its email of May 6, 2020, confirmed that the Disputed Domain Name had been registered and used by an unknown person, and thereby implicitly agreed that it had been registered and is being used in bad faith.

The Respondent offered no counter arguments to the Complainant's submissions. The Panel holds the Complainant's contentions as true and proved and therefore concludes that the Respondent registered and used the disputed domain name in bad faith.

Complainants have satisfied the third element at Policy ¶ 4(a)(iii).

## DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be GRANTED.

Accordingly, it is Ordered that the <**schragercompany.org**> domain name be **TRANSFERRED** from Respondent to Complainant, IS Company LLC d/b/a Ian Schrager Company.

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David L. Kreider, Chartered Arbitrator, Panelist

Dated: May 15, 2020