

## **ADMINISTRATIVE PANEL DECISION**

Donald J. Trump v. Scott Stephens

Case No. D2015-0478

### **1. The Parties**

The Complainant is Donald J. Trump, c/o The Trump Organization, New York, New York, United States of America (“USA” or “US”), represented by internal counsel.

The Respondent is Scott Stephens, Chino, California, USA, represented by Brian Ponder LLP, USA.

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

The disputed domain name <trumpestates.com> (the “Domain Name”) is registered with Misk.com, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 18, 2015. On March 19, 2015, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 20, 2015, the Registrar transmitted by email to the Center its verification response confirming that the 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 30, 2015. In accordance with the Rules, paragraph 5(a), the due date for Response was April 19, 2015. The Response was filed with the Center on April 19, 2015. On April 21, 2015, the Complainant submitted a Supplemental Filing. The Center acknowledged receipt of the Supplemental Filing on April 22, 2015 stating that it would be in the sole discretion of the panel (upon appointment) to determine whether to consider and/or admit the Supplemental Filing in rendering its decision, and whether to order further procedural steps, if any. The Panel has decided not to consider the Complainant’s Supplemental Filing.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on April 27, 2015. 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 individual residing in New York City, New York, USA. He is a prominent businessman, real estate developer, hotelier, author, and television personality, well known in the US (where both parties reside) and internationally.

The Complainant, individually or through privately held companies in which he is a principal, has ownership interests in numerous commercial and residential properties bearing his name; in other instances, he licenses his name to be used by unrelated real estate developers. Properties and businesses branded with the Complainant's name include Trump Tower, The Trump Building, Trump World Tower, Trump Park Avenue, Trump Parc, Trump Parc East, Trump Place, Trump Palace, Trump International Hotel and Tower (New York and Chicago), Trump Hotel Las Vegas, Trump Winery, the Trump Rink (an ice skating rink in Central Park, New York City), Trump Model Management, Trump Productions (network and cable television programs), various Trump Entertainment Resorts, Trump Restaurants, several Trump National Golf Clubs, Trump International Golf Club and Trump World Golf Club (both in Dubai), Trump Home (home furnishings), Trump's Fabulous World of Golf (a cable television show), Donald J. Trump Collections (men's clothing and accessories), Trump Ice (bottled spring water), Success by Trump (men's cologne and deodorant), and even Trump Chocolate. The Complainant is also the author of several books prominently featuring his name, and his website affirms that he is "among the highest paid public speakers in the world".

The Complainant's business ventures are described and advertised on websites operated by The Trump Organization LLC at "www.trump.com" and "www.trumphotelcollection.com". The latter features the Trump Estate Collection of private estates in Scotland and Virginia that have been turned into hotels, as well as the Trump Hotel Collection.

The Complainant holds more than 700 registered trademarks, in more than 80 countries, consisting of or incorporating the TRUMP mark. These include the following US trademark registrations:

MARK	REGISTRATION NUMBER	REGISTRATION DATE
TRUMP	2240310	April 20, 1999
TRUMP	3391095	March 4, 2008
TRUMP	3526411	November 4, 2008
TRUMP HOTEL COLLECTION	4025492	September 13, 2011

The Complainant has also applied for US registration of a design mark with the words, ALBEMARLE ESTATE TRUMP ESTATE COLLECTION (Serial No. 86557866, application dated March 9, 2015). That mark and the words TRUMP ESTATE COLLECTION appear on the Complainant's website at "www.trumphotelcollection.com" with a "TM" symbol indicating that they are subject to common law trademark claims or a pending application for trademark registration. However, the Complainant does not establish the foundation, in the record of this proceeding, for claiming common law protection for these as-yet unregistered marks. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 1.7.

The Complaint lists Scott Stephens as the Respondent and gives his organization as "Cnaip Inc." However, the current registration data for the Domain Name does not include a corporate name, nor does it appear in the Response. Therefore, Mr. Stephens alone will be referred to as the Respondent in this Decision.

According to the Respondent's complaint in the pending US federal litigation described below, the Respondent "is in the business of buying, marketing, and selling internet domain names" and "the business of resale of registered domain names in the domain aftermarket."

The Respondent's judicial complaint states that the Respondent acquired the Domain Name in 2004. The Response does not include that information, and nothing in the record of this proceeding supports that assertion. The Registrar's Whois database and its reply to the Center's request for verification in this proceeding show that the Domain Name was initially registered with the Registrar on March 8, 2010. It is conceivable that the Respondent previously registered the Domain Name with another registrar, but the Response does not demonstrate that. The Internet Archive's Wayback Machine has archived screen shots associated with the Domain Name in 2004 and 2005, but they are advertisements from Web.com, not the Respondent, to sell the Domain Name. No other archived screen shots appear until December 2010, and those are similar to the content that now appears on the Respondent's website discussed below. Accordingly, the Panel finds on this record that the Respondent obtained the Domain Name on March 8, 2010.

The Domain Name resolves to a website (the "Respondent's website") headed "TrumpEstates.com", advertising that the Domain Name is for sale on the eBay auction website and on another website at "www.scottnot.com", the website associated with another domain name registered to the Respondent. Both the Respondent's "trumpestates" website and the "scottnot" website feature a photograph of the Respondent and his New York and California telephone numbers, along with a description of his services in areas such as domain sales, search engine optimization, advertising, and audio-video engineering. Numerous domain names, including the Domain Name at issue here, are listed on both websites, with a button to "Submit an Offer" by email. According to a *New York Post* article dated March 1, 2015 concerning the present dispute, the Respondent "is offering to sell the name on eBay for \$21 million." That is the precise amount the Respondent is seeking in compensatory damages in the pending litigation discussed below.

The Complaint attaches screen shots of the Respondent's advertising to sell the Domain Name on the eBay auction site, with statements such as "this highly sought out domain name once owned by Donald Trump can now be yours", "hi profile domain name", "this domain name holds a very strong R.O.I.", and gave prices ranging from USD 15,000 to 21 million. Advertising on the Respondent's website included the announcement that the Domain Name was "up for sale right now at ebay.com", touted the appeal of the Domain Name as a "famous word", and urged, "Donald Trump doesn't want this site, SO BID NOW!".

Counsel for the Complainant sent the Respondent a cease-and-desist letter in February 2015. According to the Complaint, the Respondent replied by telephoning counsel for the Complainant and offering to transfer the Domain Name if, among other things, the Complainant would let the Respondent appear as a contestant on the Complainant's popular television show, "The Apprentice".

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant argues that the Domain Name is confusingly similar to his TRUMP mark and that the addition of the word "estates" only adds to the likelihood of confusion because the Complainant is known for his real estate dealings.

The Complainant contends that the Respondent has no rights or legitimate interests in the Domain Name, which he has used only to try to sell the Domain Name and other domain names.

The Complainant asserts that the Respondent registered and used the Domain Name in bad faith, seeking to sell it for millions of dollars exactly because of its association with the famous TRUMP mark.

## **B. Respondent**

The Respondent, represented by legal counsel, fails to address the substance of the Complaint, other than to recite, paragraph by paragraph, that he denies the allegations of the Complaint. The Response in a UDRP proceeding is normally the only opportunity for a Respondent to make its case, in a speedy, online dispute resolution procedure in which there is no discovery or motions practice as in US civil litigation, and normally no hearings or other opportunities to confront witnesses. The Respondent has chosen not to avail himself of his one opportunity to present facts (typically in the form of documents, screen shots, and declarations) and demonstrate that the Complainant has not met his burden of persuasion on all three elements of the UDRP Complaint.

Instead, the Respondent argues that the Complainant has failed to satisfy certain Rules requirements, such as not listing the Complainant's "known" telefax number, and asserts with little or no explanation or support that the Complainant has not established the elements of the Complaint. The Respondent observes that the Complainant does not hold trademarks in "trumpestates" or "trumpestates.com" and states, again without explanation or support, that the Respondent has "rights and legitimate interests" in the Domain Name.

The Respondent contends that the Complainant has "waived its rights" to the Domain Name by declining the Respondent's offer to transfer it for "\$1 and a handshake".

Otherwise, the Respondent relies on a request that the Panel terminate the UDRP proceeding because the Respondent filed a civil action against the Complainant on the same day that he filed the Response in this proceeding. That request is discussed below.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a disputed domain name, a complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

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

### **A. Pending Litigation**

On the same day that the Respondent submitted the Response in this proceeding, the Respondent filed a civil action against the Complainant and related parties in US federal court, *Stephens v. Trump Organization LLC, Donald J. Trump, Alan Garten, and Michael D. Cohen*, Civil Action No. 1:15-cv-2217 (United States District Court, Eastern District of New York) (Complaint filed April 19, 2015). That action is pending.

The Respondent's complaint in the judicial proceeding does not offer details, but it charges the Complainant with defamation and tortious interference in the Respondent's business relations for accusing the Respondent of cybersquatting. In his judicial complaint, the Respondent seeks compensatory damages of USD 21 million and punitive damages of USD 63 million, as well as declaratory judgments to the effect that the Respondent has not infringed the Complainant's trademarks and has not violated the UDRP Policy or Rules.

The Policy (paragraph 4(k)) provides that the mandatory administrative dispute resolution procedure does not preclude either party from submitting the dispute to a court of competent jurisdiction. UDRP administrative panel decisions issued before the resolution of the judicial complaint are not binding on the courts. Panel decisions have a very limited scope: they are speedy determinations of whether a disputed domain name should be retained, cancelled, or transferred, based on whether the complainant establishes all three elements of the UDRP complaint. If a panel orders cancellation or transfer of a disputed domain name, the registrar waits ten days before issuing instructions to the registrar of the domain name to cancelling or transferring the domain name (Policy, paragraph 4(k)). If the registrar receives documentation, within that time, showing that the domain name holder has commenced litigation, the registrar takes no further action until receiving evidence that the litigation has been settled, withdrawn, or dismissed, or has resulted in a judicial order declaring that the respondent does not have the right to use the domain name.

The Rules (paragraph 18(a)) provide that, “[i]n the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.”

The Panel in this instance finds that the Complaint can be evaluated under the Policy on the current record, without awaiting resolution of the Respondent’s subsequent judicial complaint. See WIPO Overview 2.0, paragraph 4.14. Hence, the Panel declines to terminate or suspend this proceeding and will proceed to a decision. As noted above, however, the Respondent may take steps to forestall the implementation of a decision to cancel or transfer the Domain Name pending resolution of a relevant judicial complaint.

## **B. Identical or Confusingly Similar**

The Complainant holds numerous trademark registrations consisting of, or including, the well-known and long established TRUMP mark. The Domain Name incorporates this mark in its entirety and adds the generic word “estates”. This addition enhances rather than eliminates the likelihood of confusion, because the Complainant’s mark is strongly associated with luxury real estate.

UDRP panels customarily treat the first element of a Policy complaint as a standing requirement, which simply requires “a straightforward visual or aural comparison of the trademark with the alphanumeric string in the domain name”. See WIPO Overview 2.0, paragraph 1.2. The Panel finds that this test is satisfied in the present case and concludes that the first element of the Policy has been established.

## **C. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which the Respondent may establish rights or legitimate interests in the Domain Name, by demonstrating any of the following:

- (i) before any notice to it of the dispute, the Respondent’s use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) that the Respondent has been commonly known by the 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 Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Since a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a disputed domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production to show rights or legitimate interests in the disputed domain name shifts to the respondent. See WIPO Overview 2.0, paragraph 2.1. The Respondent has not done so here, simply making the bald assertion that “Respondent has rights and legitimate interests in the subject domain name.” The business of

buying and selling domain names can be a legitimate enterprise, but it does not confer rights to use for that purpose a domain name identical or confusingly similar to another party's trademark.

The Complainant demonstrates that the Respondent himself tried to sell the Domain Name for a large sum based on its claimed or apparent association with the Complainant, advertising the Domain Name with phrases such as "famous word", "domain name once owned by Donald Trump", "Donald Trump doesn't want this site". The Respondent has not come forward with an alternative explanation for his selection and attempted sale of the Domain Name, which has no evident generic value.

The Panel concludes that the second element of the Complaint has been established.

#### **D. Registered and Used in Bad Faith**

The Policy paragraph 4(b) furnishes a non-exhaustive list of circumstances that "shall be evidence of the registration and use of a domain name in bad faith", including the following cited by the Complainant:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; . . ."

The Respondent does not deny prior knowledge of the TRUMP mark. He acquired the Domain Name at a time when the Complainant was increasingly using or licensing the TRUMP mark in connection with the term "estates", for TRUMP-branded hotel and condominium developments. The Respondent then clearly advertised the Domain Name for sale, over a period of years, as a high-value domain name supposedly owned by or logically associated with the Complainant. Whether the intention was to elicit a substantial offer from the Complainant himself (possibly in the form of a television role, as the Respondent suggested) or from another party hoping to capitalize on the fame of the Complainant's mark, this cannot represent a good faith registration and use of the Domain Name. It is patently an attempt to trade on the reputation associated with the Complainant's mark.

The Panel concludes that the third element of the Complaint is established.

#### **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, <trumpestates.com>, be transferred to the Complainant.



**W. Scott Blackmer**

Sole Panelist

Date: May 8, 2015