

## **ADMINISTRATIVE PANEL DECISION**

Morrison & Foerster LLP v. Privacy Service Provided by Withheld for Privacy ehf / Shane McMahon  
Case No. D2022-2932

### **1. The Parties**

The Complainant is Morrison & Foerster LLP, United States of America (“U.S.” or “United States”), internally represented.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Shane McMahon, United States.

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

The disputed domain name <morrisonfoersterlaw.info> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 9, 2022. On August 9, 2022, 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 disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 11, 2022, 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 August 13, 2022.

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 August 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 14, 2022.

The Center appointed Anne Gundelfinger as the sole panelist in this matter on September 19, 2022. 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 a large international law firm with 17 offices located throughout the United States, Asia, and Europe and over 1,000 lawyers who advise clients across a range of industries and practices, including intellectual property, litigation, corporate/M&A, business restructuring, and securities. The Complainant's clients include large financial institutions, Fortune 100 companies, and leading technology and life sciences companies, as well as investment funds and startup companies. The Complainant is regularly included on BTI Consulting Group's prestigious list of "Power Elite" law firms, based on the results of interviews with general counsel and other decision-makers at more than 500 leading companies.

The Complainant has used the MORRISON & FOERSTER trademark (the "Mark") in connection with its legal services since at least as early as 1975 and owns trademark registrations in the U.S., the European Union, and a number of other major markets around the world, including the following U.S. trademark registrations:

- MORRISON & FOERSTER, U.S. Registration No. 1,665,352, registered November 19, 1991, in Class 42 for legal services; and
- MORRISON & FOERSTER, U.S. Registration No. 2,916,268, registered January 4, 2005, in Class 41 for educational services, namely conducting seminars in the field of law.

The disputed domain name was registered on May 25, 2022, and does not currently resolve to any website, instead generating only an error message.

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

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

The Complainant contends that the disputed domain name is confusingly similar to its well-established MORRISON & FOERSTER Mark because the disputed domain name is identical to the Mark, with the exception that the disputed domain name omits the ampersand and adds the word "law". The Complainant argues that these differences are nominal and/or irrelevant and do not prevent a finding of confusing similarity.

The Complainant further contends, and has presented supporting evidence, that the Respondent has used the disputed domain name in connection with a business email compromise scheme apparently intended to fraudulently solicit funds. In particular, the Complainant contends that the Respondent is fraudulently presenting itself as one of the Complainant's attorneys and has sent emails from a deceptive email address in the format "[...]@morrisonfoersterlaw.info" in order to solicit payment of allegedly overdue invoices. The content of the email includes the Complainant's name and trademark as well as its actual London office address.

Based on the foregoing, the Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name, and that the disputed domain name was registered and is being used in bad faith. Specifically, the Complainant asserts *inter alia* that (a) the Complainant has given no authorization or license for use of the disputed domain name, (b) the Respondent is not commonly known by the disputed domain name, and (c) the Respondent's use of the disputed domain name for the above-described deceptive email scheme both fails to establish rights or legitimate interests, and also demonstrates the

Respondent's bad faith registration and use.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy requires that the Complainant prove the following three elements to be successful in this action: (i) the disputed domain name is identical or confusingly similar to trademarks or service marks in which the Complainant has rights; (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.

### **A. Identical or Confusingly Similar**

The disputed domain name wholly incorporates the Complainant's long-used and well-established MORRISON & FOERSTER Mark minus the ampersand (which cannot be used in domain names in any event) and along with the common English word "law". It is well established that the addition of other terms (whether generic, descriptive, geographical, pejorative, meaningless, or otherwise) to a complainant's mark does not prevent a finding of confusing similarity between a disputed domain name and that mark. See, section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and cases cited therein. See also, *Allianz SE v. IP Legal, Allianz Bank Limited*, WIPO Case No. [D2017-0287](#); and *Accor v. WhoisGuard, Inc. / Bill Bro*, WIPO Case No. [D2018-2329](#).

Similarly, the addition of the generic Top-Level Domain ("gTLD") ".info" is viewed as a standard registration requirement and as such is generally disregarded in the confusing similarity analysis.

Accordingly, the Panel agrees that the disputed domain name is confusingly similar to the Complainant's Mark, and that the first element of the test is satisfied.

### **B. Rights or Legitimate Interests**

It is well established that a complainant must present a *prima facie* case in relation to the second element of the Policy, not mere allegations. Once a *prima facie* showing is made, the burden of production shifts to the respondent to come forward with evidence of rights or legitimate interests in the disputed domain name. This burden-shifting is appropriate given that the respondent is often the only party with access to evidence of its own rights or legitimate interests. Accordingly, where a respondent fails to file a response, a UDRP panel may draw inferences from the failure to respond as appropriate under the circumstances of the case and while still weighing all available evidence irrespective of whether a response is filed. See, section 2.1 of the [WIPO Overview 3.0](#) and cases cited therein. See also, *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Complainant has demonstrated its rights in, as well as its decades-long use of, the MORRISON & FOERSTER Mark, and has further asserted that the Respondent is not commonly known by the disputed domain name, is not making a legitimate fair use of the name, and that the Complainant has no relationship with the Respondent and has not licensed or otherwise permitted the Respondent's use of the disputed domain name. The Complainant has further demonstrated with credible un rebutted evidence that the Respondent used the disputed domain name to send deceptive and potentially fraudulent emails for commercial gain. Of course, such use does not give rise to any rights or legitimate interests on the part of the Respondent in the disputed domain name. See section 2.13 of the [WIPO Overview 3.0](#). Moreover, such use clearly establishes the Respondent's prior knowledge of the Complainant's Mark.

In the absence of a response from the Respondent, the Panel accepts the Complainant's evidence and assertions, and finds that the Complainant has made a *prima facie* case that the Respondent lacks any rights or legitimate interests in the disputed domain name. Accordingly, the Panel concludes that the Complainant has met its burden and that the second element of the test is satisfied.

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

The third element of the test requires a showing that the disputed domain name has been registered and is being used in bad faith. As previously concluded, the disputed domain name is confusingly similar to the Complainant's well-established, decades-old MORRISON & FOERSTER Mark, and includes the term "law" that is descriptive of the Complainant's services. Given the foregoing, and the fact that the Respondent used the disputed domain name to send deceptive and potentially fraudulent emails, one can only fairly conclude that the Respondent was clearly aware of – and targeted - the Complainant's Mark when registering the disputed domain name. This suffices to establish bad faith registration. See, paragraph 4(b)(iv) of the Policy, and section 3.1.4 of the [WIPO Overview 3.0](#).

Turning to bad faith use, while the disputed domain name resolves only to an inactive website, the Respondent sent deceptive and potentially fraudulent emails apparently for commercial gain using the disputed domain name as well as falsely referencing the name and address of the Complainant. Such use of the disputed domain name clearly constitutes use in bad faith. See *Facebook, Inc. v. WhoisGuard, Inc. / Donna E. Fleming, Mansmann's Department Store*, WIPO Case No. [D2019-1777](#), and section 3.4 of the [WIPO Overview 3.0](#).

Accordingly, the Panel concludes that the disputed domain name was registered and has been used in bad faith, and that the third element of the test is satisfied.

### **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 <morrisonfoersterlaw.info> be transferred to the Complainant.

*/Anne Gundelfinger/*

**Anne Gundelfinger**

Sole Panelist

Date: October 3, 2022