

## **ADMINISTRATIVE PANEL DECISION**

Morrison & Foerster LLP v. roerine jullie

Case No. D2023-0168

### **1. The Parties**

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

Respondent is roerine jullie, United States.

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

The disputed domain name <mofo-llp.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 13, 2023. On January 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, 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 (Privacy service provided by Withheld for Privacy ehf), and contact information in the Complaint. The Center sent an email communication to Complainant on January 18, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on January 18, 2023.

The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on January 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 12, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on February 16, 2023.

The Center appointed Phillip V. Marano as the sole panelist in this matter on February 28, 2023. 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

Complainant is an international law firm with over eighteen offices and attorneys located throughout the world. Complainant offers its services through its official <mofo.com> domain name and website. Complainant owns valid and subsisting registrations for the MOFO trademark in the United States (US Reg. No. 2,481,879) with the earliest priority dating back to October 10, 1975.

Respondent registered the disputed domain name on January 9, 2023. At the time this Complaint was filed, the disputed domain name resolved to a “Deceptive Website” web browser warning page and was used to impersonate one of Complainant’s employees and in connection with phishing emails to solicit information from third parties.

#### 5. Parties’ Contentions

##### A. Complainant

Complainant asserts ownership of the MOFO trademark and has adduced evidence of trademark registrations in the United States, with earliest priority dating back to October 10, 1975. The disputed domain name is confusingly similar to Complainant’s MOFO trademark, according to Complainant, because it incorporates Complainant’s MOFO trademark in its entirety and merely adds the corporate identifier “LLP”.

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on: the lack of any authorization or license from Complainant; the lack of any evidence that Respondent is known by the disputed domain name; Respondent’s malicious use of the disputed domain name for an email phishing scheme impersonating Complainant’s employees and targeting unsuspecting clients and third parties.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: the well-known nature of Complainant’s MOFO trademark; and Respondent’s malicious use of the disputed domain name for an email phishing scheme impersonating Complainant’s employees and targeting unsuspecting clients and third parties.

##### B. Respondent

Respondent did not reply to Complainant’s contentions.

#### 6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

1. The disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights;
2. Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. The disputed domain name has been registered and is being used in bad faith.

Although Respondent did not reply to Complainant’s contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent’s default would not by itself mean that the complainant is deemed to have prevailed; a respondent’s default is not necessarily an admission that the complainant’s claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, e.g. where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent.

See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) (“The Respondent’s default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)”).

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

Ownership of a nationally or regionally registered trademark serves as *prima facie* evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the MOFO trademark has been registered with priority dating back to October 10, 1975. Thus, the Panel finds that Complainant’s rights in the MOFO trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant’s MOFO trademark.

In this Complaint, the disputed domain name is confusingly similar to Complainant’s MOFO trademark because, disregarding the “.com” generic Top-Level Domain (“gTLD”), the entirety of the trademark is contained within 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 domain name ... [I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar...”). In regards to gTLDs, such as “.com” in the disputed domain name, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.1.

The combination with the term “LLP” does not prevent a finding of confusing similarity between Complainant’s MOFO trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.8 (Additional terms “whether descriptive, geographic, pejorative, meaningless, or otherwise” do not prevent a finding of confusing similarity under the first element”); see also *Ashfords LLP v. Hioo Uoehojf*, WIPO Case No. [D2020-1579](#) (finding that the addition of a corporate identifier does not prevent a disputed domain name from being confusingly similar to complainant’s trademark). Indeed, the Panel concurs with Complainant that the additional term “LLP” does not prevent a finding of confusing similarity between Complainant’s MOFO trademark and the disputed domain name.

In view of the foregoing, the Panel concludes that Complainant has established the first element of the Policy.

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

Complainant must make out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. [WIPO Overview 3.0](#), section 2.1.

It is evident that Respondent, identified by Whois data for the disputed domain name as “roerine jullie”, is not commonly known by the disputed domain name or Complainant’s MOFO trademark.

In addition, UDRP panels have categorically held that use of a domain name for illegal activity - including the impersonation of the complainant and other types of fraud - can never confer rights or legitimate interests on a respondent. Circumstantial evidence can support a credible claim made by Complainant asserting Respondent is engaged in such illegal activity, including that Respondent has masked its identity to avoid being contactable, or that Respondent’s website has been suspended by its hosting provider. [WIPO Overview 3.0](#), section 2.13. See e.g. *Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrence*, WIPO Case No. [D2009-1017](#) (“Respondent has used the domain name to pretend that it is the Complainant and in

particular to create false emails pretending that they are genuine emails coming from the Complainant and one of its senior executives”); see also *The Commissioners for HM Revenue and Customs v. Name Redacted*, WIPO Case No. [D2017-0501](#) (“In addition, the disputed domain names ... have had their web hosting suspended as a result of fraudulent activities. This is evidence of bad faith registration and use of the disputed domain names”). In its Complainant, Complainant has submitted compelling email evidence that Respondent uses the disputed domain name as part of an email phishing scheme to impersonate Complainant’s employees to seek sensitive financial information and divert payments from unsuspecting clients of Complainant.

In view of the foregoing, the Panel concludes that Complainant has established the second element of the Policy.

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

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent’s documented out of pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

Wrongful use of others’ trademarks to extort information from unsuspecting and unwary people, by using a domain name for phishing activity, is considered abusive registration of the disputed domain name under the Policy. See *CareerBuilder, LLC v. Stephen Baker*, WIPO Case No. [D2005-0251](#); *The Boots Company, PLC v. The programmer adviser*, WIPO Case No. [D2009-1383](#). See e.g. *WSI Holdings Ltd. v. WSI House*, WIPO Case No. [D2004-1089](#) (“Respondent appears to be engaged in “phishing” for mistaken potential employees of the Complainant ... Respondent (1) has adopted a confusingly similar domain name, (2) it has used the trade dress of the Complainant’s website, and (3) it has sought to attract users to its site by creating confusion between its site and the Complainant’s. It has clearly engaged in activity which fulfils the bad faith requirements of Paragraph 4(b)(iv) of the Policy.”) See e.g. *Go Daddy Operating Company, LLC v. Wu Yanmei*, WIPO Case No. [D2015-0177](#) (emails sent by the respondent from domain names using the complainant’s trademark in an attempt to obtain complainant’s customer information was held to be use of the disputed domain name for a phishing scheme and consequently bad faith under the Policy); *AB Electrolux v. Piotr Pardo*, WIPO Case No. [D2017-0368](#) (engaging in fraudulent email phishing activities through unauthorized use of a trademark for obtaining data or deriving information is construed as bad faith under the Policy). As discussed above, Complainant has provided a phishing report from a client and corresponding email from Respondent where Respondent used the disputed domain name as part of an email phishing scheme in order to impersonate Complainant’s employees, and seek sensitive financial information and divert payments from unsuspecting clients of Complainant.

In view of the foregoing, the Panel concludes that 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 <mofo-llp.com> be transferred to Complainant.

*/Phillip V. Marano/*

**Phillip V. Marano**

Sole Panelist

Date: March 15, 2023