

ADMINISTRATIVE PANEL DECISION

Nelson Mullins Riley & Scarborough LLP v. Eli Poler
Case No. D2024-1881

1. The Parties

Complainant is Nelson Mullins Riley & Scarborough LLP, United States of America, internally represented.

Respondent is Eli Poler, United States of America.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 3, 2024. On May 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 6, 2024, 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 (Redacted for Privacy, PrivacyGuardian.org LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on May 14, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on May 15, 2024.

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 Respondent of the Complaint, and the proceedings commenced on May 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 11, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 19, 2024.

The Center appointed Clark W. Lackert as the sole panelist in this matter on June 28, 2024. 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 was founded in 1897 and has grown over the past 127 years into a diversified law firm of more than 1,000 attorneys, policy advisors, and professionals across 37 offices serving clients in more than 100 practice areas. Since at least as early as 1987 and 1999, respectively, Complainant adopted and has extensively and continuously used the NELSON MULLINS RILEY & SCARBOROUGH and NELSON MULLINS service marks in connection with the marketing, advertising, promotion, and rendering of Complainant's legal services (collectively, Complainant's Mark). Due to its long use in commerce and significant marketing, Complainant's Mark has acquired a substantial amount of reputation and goodwill in the marketplace, which consumers recognize as belonging exclusively to Complainant.

Complainant owns the following active registrations on Complainant's Mark in the United States of America:

Trademark	Registration Number	Registration Date
NELSON MULLINS	3,754,391	March 2, 2010
NELSON MULLINS & Design	5,361,314	December 19, 2017
NELSON MULLINS RILEY & SCARBOROUGH LLP	3,757,228	March 9, 2010

Additionally, Complainant registered the domain name <nelsonmullins.com> on April 12, 1997, and has continually used it since then.

Respondent registered the disputed domain name on April 25, 2024. The disputed domain name has been used to send emails impersonating Complainant in order to conduct a phishing scam.

5. Parties' Contentions

A. Complainant

Complainant contends that the Panel should transfer the disputed domain name to Complainant because (1) the disputed domain name is confusingly similar to Complainant's Mark in which Complainant has rights; (2) Respondent does not have any rights or legitimate interests in the disputed domain name; and (3) Respondent registered and is using the disputed domain name in bad faith.

Complainant asserts that the disputed domain name is identical or confusingly similar to Complainant's Mark since Complainant obtained common law and registration rights in the NELSON MULLINS service mark dating back at least as early as 1999, long before the registration of the disputed domain name. The NELSON MULLINS mark is incontestable and as such, the registration constitutes "conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce." 15 U.S.C. § 1115(b); *Ralph Maltby Enterprises, Inc. v. Women With Balls (W.W.B. Accessories)*, WIPO Case No. [D2004-0917](#) (finding that "[u]nder U.S. trademark law (15 U.S.C. Section 1115), these incontestable registrations provide conclusive evidence of Complainant's ownership of the marks in the U.S. and of its exclusive right to use the marks in connection with the goods and services identified in the registrations"). Having established Complainant's prior existing rights in its trademarks, the critical inquiry under the first element of the Policy is whether the Complainant's Mark and disputed domain name, when directly compared, are identical or confusingly similar. *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#). It is well established that a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), Section 1.9. Here, the disputed domain name is unquestionably confusingly similar to Complainant's Mark because the disputed domain name consists of nothing more than an obvious misspelling of the Complainant's Mark wherein Respondent has taken the letter "s" from the end of MULLINS and added it to the end of NELSON forming "nelsonsmullin".

Furthermore, UDRP panels have consistently held that if a domain name “wholly incorporates a complainant's trademark”, it is sufficient evidence that the domain name is identical or confusingly similar. See, e.g., *Intesa Sanpaolo S.p.A. v. Tommy, Bartles associates*, WIPO Case No. [DCO2015-0001](#). Here the disputed domain name consists solely of an obvious misspelling of Complainant's Mark and nothing else. Accordingly, the disputed domain name wholly incorporates the Complainant's Mark and is therefore confusingly similar, if not identical to the mark. Accordingly, Complainant has established that the disputed domain name is identical or confusingly similar to the Complainant's Mark in which Complainant has valid and subsisting trademark rights, and therefore the condition of Paragraph 4(a)(i) is fulfilled.

Complainant further asserts that Respondent has no prior rights or legitimate interest in the disputed domain name because: (1) Respondent is not known by the disputed domain name; (2) Complainant has not authorized Respondent to use its trademarks in any way; (3) Respondent does not have any connection or affiliation with Complainant; (4) Respondent has not made a bona fide use of the disputed domain name nor engaged in any demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services; and (5) Respondent's use of the disputed domain name is in furtherance of an illegal activity, in this case, Business Email Compromise (“BEC”) attacks on Complainant to siphon off its clients. Such assertions constitute a prima facie showing under Paragraph 4(a)(ii) of the Policy thereby shifting the burden of proof to Respondent to show that it has rights or legitimate interests in the disputed domain names under Paragraph 4(c) of the Policy. *Spencer Douglass, MGA v. Bail Yes Bonding*, WIPO Case No. [D2004-0261](#) (absence of authorization of use of trademark constitutes prima facie showing under Paragraph 4(a)(ii) of the Policy). Here, there is no evidence supporting any contrary conclusions in the file.

Lastly, Complainant asserts that Respondent registered the disputed domain name, which is confusingly similar to Complainant's Mark, to divert web traffic to its website, and then subsequently used the disputed domain name in furtherance of a fraudulent and illegal BEC attack impersonating a representative of Complainant aimed at one of Complainant's clients. Prior panels have found such use of a disputed domain name to constitute registration and use of the disputed domain name in bad faith. See *Halliburton Energy Services, Inc. v. Gregory Wilson / Infotech Ltd.*, WIPO Case No. [D2017-0956](#) (“Sent on the very day the disputed domain name was registered and incorporating the disputed domain name in the address”; bad faith found); *BHP Billiton Innovation Pty Ltd v. Domains By Proxy LLC / Douglass Johnson*, WIPO Case No. [D2016-0364](#) (“[T]he use of an email address associated with the disputed domain name, to send a phishing email for the purposes of dishonest activity is in itself evidence that the disputed domain name was registered and is being used in bad faith.”); *Kimley-Horn and Associates, Inc. v. Abraham Hashim*, WIPO Case No. [DCO2019-0017](#) (“registration of a domain name in furtherance of phishing scams supports a finding of bad faith registration and use”).

B. Respondent

Respondent is in default and did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. In particular, [WIPO Overview 3.0](#), section 1.9 addresses issues of intentional misspellings such as the case here: NELSON MULLINS versus “nelsonsmullin”.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity, here fraudulent and illegal BEC attacks/phishing on Complainant’s clients, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. Here, the disputed domain name has been used to intentionally attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion with Complainant’s Mark in violation of paragraph 4(b)(iv) of the Policy. [WIPO Overview 3.0](#), section 3.1.4. Moreover, the illegal BEC attacks/phishing are themselves additional evidence of bad faith. See, [WIPO Overview 3.0](#), section 3.4, and *Ropes & Gray LLP v. Onso Onso*, WIPO Case No. [D2019-0823](#). As the panel stated: “Moreover, the use of the domain name to illegally spoof and phish existing clients of the Complainant into believing that they are authorized to receive funds on behalf of client is a violation of Policy, paragraph 4(b)(iv). *Caffitaly System S.p.A. v. WhoisGuard Protected, WhoisGuard, Inc. / Organization: Winsomgroup, Robert Hills*, WIPO Case No. [D2018-2804](#), and [WIPO Overview 3.0](#), Section 3.1.4”.

Having reviewed the record, the Panel finds Respondent’s registration and use of the disputed domain name constitutes bad faith under 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 <nelsonsmullin.com> be transferred to Complainant.

/Clark W. Lackert/

Clark W. Lackert

Sole Panelist

Date: July 12, 2024