

## **ADMINISTRATIVE PANEL DECISION**

David M. Guilford v. Paige Luke  
Case No. D2022-1343

### **1. The Parties**

Complainant is David M. Guilford, United States of America (“United States”), represented by Novian & Novian LLP, United States.

Respondent is Paige Luke, United States.

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 14, 2022. On April 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on April 29, 2022, 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 5, 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 Respondent of the Complaint, and the proceedings commenced on May 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 25, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 27, 2022.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on June 7, 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**

Complainant is a lawyer, admitted to the California bar in 2003, who practices in Reno, California. Records from the State Bar of California indicate that his law firm is called Guilford Legal Group, PC, while his LinkedIn profile indicates that he is managing partner of this firm. The Complaint states he has consistently used his name in connection with legal services since 2004.

The Domain Name was registered on October 19, 2021, and has been used to link to a fraudulent website purportedly for “David Guilford & Associates” or “David Guilford Michael Trust & Associates Lawyers.” The content used to populate this website was copied from website for the law firm, Novian & Novian LLP (“Novian”), which is located in Los Angeles, California.

#### **5. Parties’ Contentions**

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

###### **(i) Identical or confusingly similar**

Complainant contends that he has trademark rights in his name as it has been used in commerce in connection with providing legal services. After being admitted to the California State Bar in 2003, and since at least May 2004, Complainant has consistently used his name in connection with legal services.

Complainant contends the use of the descriptive term “lawyers” after his name in the Domain Name renders the Domain Name confusingly similar. Complainant argues that where a mark is the distinctive part of a domain name, that domain name is considered to be confusingly similar to the mark. In this case, the addition of the descriptive term “lawyers” to the Domain Name has little, if any, effect on a determination of legal identity between the Domain Name and Complainant’s name used as a mark, and does not exclude the likelihood of confusion.

Therefore, Complainant concludes that the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights satisfying the first element of the Policy.

###### **(ii) Rights or legitimate interests**

Complainant claims that Respondent has no rights or legitimate interests in the Domain Name because Respondent has never been known as David Guilford, has no registered rights under the law of any nation to that name or mark, nor has Respondent developed any common law rights in the name.

Respondent copied the content for the website linked to the Domain Name from the website for the law firm Novian. Subsequently, a number of customers reached out to Respondent in order to execute cryptocurrency transactions. Shortly thereafter, these customers realized that Respondent had copied Novian’s website in order to impersonate Novian and conduct a cryptocurrency scam. The Novian firm reported the scam to the United States Department of Justice – Federal Bureau of Investigation (the “FBI”). A copy of the Complaint Referral Form was submitted as evidence in this case. As of the date of the Complaint, to the best of Novian’s knowledge, the FBI has not taken criminal action against Respondent.

Complainant submits that pretending to be another, whether as Complainant or the Novian firm, in order to conduct some kind of scam is not a *bona fide* use of a Domain Name. Further, Complainant states that

Respondent has engaged in a number of escrow schemes in the past. For instance, evidence has been submitted that Respondent has pretended to be a shipping company on two occasions and a bank on two others. In each case, Respondent has sought to defraud others of currency or cryptocurrency by pretending to be someone else.

Complainant concludes that operating a law services fraud scheme does not create rights or legitimate interests in the Domain Name.

(iii) Registered and used in bad faith

Complainant contends that Respondent is using the Domain Name in bad faith by using it to disrupt the business of both Complainant and the Novian firm. Complainant explains that the legal service at issue is known as a cryptocurrency swap, which is similar to a foreign currency swap. A foreign currency swap is where two escrow accounts accumulate different foreign currencies, which are converted at a certain exchange rate and then swapped at a later time. The banking system is equipped to execute these transactions with minimal delay. However, the banking system is not equipped to exchange cryptocurrency for either another cryptocurrency or government currency. Law firms fill this gap by using trust accounts to facilitate swaps. This service depends on the trust and reputation of the lawyers involved in order to be safely executed. When Respondent pretends to be Complainant and the Novian firm, Respondent offers a competing (albeit fraudulent) service and creates a likelihood of confusion as to the source.

Complainant states that Respondent, by copying the Novian firm's website, also misappropriates the name, image, likeness, biography, and, in some cases telephone number of attorneys who have no affiliation with Respondent. By using Complainant's name, Respondent is causing confusion as to the source, sponsorship, affiliation, or endorsement of Respondent's site. Of course, in fact, no such sponsorship, affiliation, or endorsement exists between Complainant, the Novian firm, and Respondent.

Complainant concludes that disrupting Complainant's business and using Complainant's name to convert potential clients demonstrates bad faith under the Policy.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. These elements are that:

- (i) the Domain Name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) Respondent has registered and is using the Domain Name in bad faith.

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

The Panel determines that Complainant has established common law rights in his name, David Guilford, in connection with legal services. Complainant states that he has consistently used his name David Guilford in connection with legal services since at least May 2004. Although Complainant has submitted minimal evidence on this point, the record demonstrates that Complainant has been practicing under the name Guilford Legal Group in Reno, Nevada, and that Complainant is the managing partner of his law firm. The WIPO Overview of Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"),

section 1.5, provides that where a personal name is used as a trademark-like identifier in trade or commerce, a complainant may be able to establish unregistered or common law rights in that name for purposes of standing to file a UDRP case. In this case, where Complainant has made a passable showing that he has used his name as a distinctive identifier for providing legal services, and where Respondent has made no effort to rebut Complainant's claim to rights in his name, the Panel finds that Complainant has demonstrated rights in his name for purposes of the first element of the Policy.

Further, the Panel finds that the Domain Name incorporates Complainant's name in its entirety, and differs only by adding the word "lawyers." [WIPO Overview 3.0](#), section 1.8, provides in relevant part that where "the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element." Thus, the Panel finds that the Domain Name is confusingly similar to Complainant's name in which Complainant has common law rights.

Accordingly, the Panel finds that Complainant has satisfied the first element of the Policy in accordance with paragraph 4(a)(i).

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

Regarding the second element of the Policy, section 2.1 of the [WIPO Overview 3.0](#) states, "where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element".

Here, the Panel determines that Complainant has made out a *prima facie* case, while Respondent has failed to respond to the Complaint. The Panel finds that Complainant has not authorized Respondent to use Complainant's name; that Respondent is not commonly known by the Domain Name; that Respondent has not used the Domain Name for a legitimate noncommercial or fair use, nor used it in connection with a *bona fide* offering of goods or services. Instead, the Domain Name is being used to connect to a fraudulent website in connection with a purported scam related to the exchange of cryptocurrency. Moreover, Respondent has made no attempt to rebut any of Complainant's allegations in the Complaint. See WIPO Overview, section 2.13.1 (Panels have categorically held that the use of a domain name for illegal activity ... can never confer rights or legitimate interests on a respondent.").

Accordingly, the Panel finds that Complainant has made a *prima facie* showing of Respondent's lack of rights or legitimate interests in respect of the Domain Name, which has not been rebutted by Respondent. The Panel therefore finds that Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

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

The third element of paragraph 4(a) of the Policy requires that Complainant demonstrate that Respondent registered and is using the Domain Name in bad faith. [WIPO Overview 3.0](#), section 3.1, states that "bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark".

Here, the Panel determines that the Domain Name was registered and is being used in bad faith. With respect to registration, the evidence submitted by Complainant demonstrates that Respondent improperly targeted Complainant and his name when registering the Domain Name. Respondent used Complainant's name in full, while copying the Novian law firm's website to populate content for Respondent's fraudulent site. In the face of these allegations made by Complainant, Respondent has provided no response at all to attempt to justify why Respondent chose to register the Domain Name corresponding to Complainant's name.

This point is further confirmed by Respondent's use of the Domain Name. Complainant has submitted evidence to indicate that the Domain Name was being used by Respondent primarily for the illegal purpose of perpetrating a fraud in relation to the purported effort to facilitate the exchange of cryptocurrency, making the website impersonate a law firm by copying content from the Novian firm. As provided by [WIPO Overview 3.0](#), section 3.1.4, "use of a domain name for *per se* illegitimate activity such as the sale of counterfeit goods or phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith".

In conclusion, the Panel determines that, for all of the above reasons, the Domain Name was registered and is being used in bad faith. Accordingly, Complainant has satisfied 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 Domain Name <davidguilfordlawyers.com> be transferred to Complainant.

*/Christopher S. Gibson/*

**Christopher S. Gibson**

Sole Panelist

Date: July 21, 2022