

## **ADMINISTRATIVE PANEL DECISION**

Morrison & Foerster LLP v. Privacy Service Provided by Withheld for Privacy ehf / Michael Cove  
Case No. D2022-1862

### **1. The Parties**

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

Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Michael Cove, United States.

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

The disputed domain name <morrisonfoersterlaw.net> (hereinafter the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 24, 2022. On May 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 24, 2022, 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 Complainant on May 25, 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 30, 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 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 20, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 21, 2022.

The Center appointed Lawrence K. Nodine as the sole panelist in this matter on July 12, 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 an international law firm that has provided legal services since at least 1975. Complainant has offices in the United States, Asia, and Europe. Complainant owns two United States trademark registrations for the mark MORRISON & FOERSTER, one covering legal services in International Class 42 (Reg. No. 1,665,352) (Registered November 19, 1991) and the other covering educational services, namely, conducting seminars in the field of law in International Class 41 (Reg. No. 2,916,268) (Registered January 4, 2005) (the “Mark”). Complainant has adopted the abbreviation “Mofo”, and accordingly owns the domain name <mofo.com> and uses this domain name for its company email addresses (“[...][@mofo.com](mailto:[...]@mofo.com)”), for both internal and external communications.

Respondent registered the Disputed Domain Name on May 9, 2022, long after Complainant registered its MORRISON & FOERSTER mark. The webpage associated with the Disputed Domain Name resolves to a landing page indicating the associated webpage is a security threat. According to evidence in the Complainant, the Disputed Domain Name has been used to send fraudulent invoices to Complainant’s clients.

#### **5. Parties’ Contentions**

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

Complainant contends that the Disputed Domain Name is confusingly similar to its MORRISON & FOERSTER mark, as the Disputed Domain Name incorporates the entirety of the Mark, merely (1) omitting the ampersand (which cannot be used in a domain name), and (2) adding the term “law” after the Mark.

Next, Complainant states that Respondent has no rights or legitimate interests in the Disputed Domain Name, as Complainant has not authorized Respondent to use the Disputed Domain Name. According to Complainant, Respondent also has been using the Disputed Domain Name to impersonate an attorney at Complainant’s law firm to send fraudulent invoices to Complainant’s clients. Complainant contends that Respondent registered the Disputed Domain Name to take unfair advantage of the recognition of Complainant’s Mark in order to further its phishing scheme to solicit money from Complainant’s clients.

Finally, Complainant alleges that Respondent registered and continues to use the Disputed Domain Name in bad faith. Complainant contends that Respondent’s use of the Disputed Domain Name to impersonate an attorney at Complainant’s law firm is evidence of Respondent’s bad faith use and registration of the Disputed Domain Name. Because Respondent’s sole purpose in registering the Disputed Domain Name was to illegally obtain money from Complainant’s clients, Respondent is not capable of using the Disputed Domain Name for a legitimate purpose.

##### **B. Respondent**

Respondent did not reply to Complainant’s contentions.

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

The Panel finds that Complainant's trademark registrations establish that it has rights in the MORRISON & FOERSTER mark. The Panel further finds that, because the Disputed Domain Name incorporates the dominant features of the Complainant's Mark, it is confusingly similar to Complainant's registered mark. Respondent's addition of the term "law" in the Disputed Domain Name does not prevent a finding of confusing similarity. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8; see also *L'Oréal v. Yang Jian*, WIPO Case No. [D2018-2938](#) (transferring <loreallegal.com> to complainant L'Oréal).

Complainant has satisfied paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

Complainant has presented a *prima facie* case for Respondent's lack of rights or legitimate interests in the Disputed Domain Name, which Respondent has not rebutted. Complainant has not authorized Respondent to use its trademark and Respondent's registration of the Disputed Domain Name without any relationship to Complainant or Complainant's Mark itself creates a strong presumption that Respondent lacks rights or legitimate interests in the Disputed Domain Name. See, e.g., *Pfizer Inc. v. NA*, WIPO Case No. [D2005-0072](#).

Additionally, the use of an email account to send emails falsely purporting to be Complainant does not give rise to rights or legitimate interests in the Disputed Domain Name. Use of a domain name for illegal activity, such as impersonation and phishing, can never confer rights or legitimate interests on a respondent. See [WIPO Overview 3.0](#), section 2.13; see also *Kimley-Horn and Associates, Inc. v. Abraham Hashim*, WIPO Case No. [DCO2019-0017](#) ("The use of the domain name for such a fraudulent purpose as phishing, obviously, cannot be held to constitute a *bona fide* use of the disputed domain name").

The Panel finds that Respondent does not have rights or legitimate interests in the Disputed Domain Name and that Complainant has satisfied paragraph 4(a)(ii) of the Policy.

### C. Registered and Used in Bad Faith

The Panel finds that Respondent registered and used the Disputed Domain Name in bad faith. First, Respondent's registration of the Disputed Domain Name that is confusingly similar to Complainant's MORRISON & FOERSTER mark without having any relationship to Complainant is evidence of bad faith registration and use. See *Chanel, Inc. v. Buybeauty.com*, WIPO Case No. [D2000-1126](#) ("[g]iven that Respondent has no connection with Complainant and has never been authorized by Complainant to use the CHANEL mark, the very fact that Respondent has registered buychanel.com establishes bad faith use and registration").

Additionally, Respondent explicitly impersonated Complainant through the sending of fraudulent invoices using an email associated with the Disputed Domain Name that also incorporated the name of an employee of Complainant. Respondent's activation of a mail exchange ("MX") record and use of the associated email address is evidence of bad faith. Respondent clearly exploited on the fact that Complainant often refers to itself by the abbreviation "Mofo". The Panel finds that Respondent intended and expected that recipients of its emails would not notice the fraudulent email address because it incorporates the entirety of Complainant's Mark with no misspellings. Recipients unfamiliar with the "Mofo" moniker would mistakenly assume that Complainant sent the emails. Such conduct amounts to bad faith use of the Disputed Domain Name. See *Super Cassettes Industries Private Limited v. Muhammad Irfan*, WIPO Case No. [D2022-0557](#); see also *Clifford Chance LLP v. Domain Administrator, See PrivacyGuardian.org/ rayzy dynamics*, WIPO Case No. [D2019-2127](#).

## 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.net> be transferred to Complainant.

*/Lawrence K. Nodine/*

**Lawrence K. Nodine**

Sole Panelist

Date: July 22, 2022