

ADMINISTRATIVE PANEL DECISION

Morrison & Foerster LLP v. Vero Nica, Latvec P.C
Case No. D2022-3381

1. The Parties

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

The Respondent is Vero Nica, Latvec P.C, United States.

2. The Domain Name and Registrar

The disputed domain name <morrisonfoersters.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 September 10, 2022. On September 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 12, 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 (Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 13, 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 September 16, 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 September 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 20, 2022.

The Center appointed William F. Hamilton as the sole panelist in this matter on November 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

The Complainant is a well-known, highly acclaimed international law firm with 18 offices located throughout the United States, Asia, and Europe.

The Complainant has used the MORRISON & FOERSTER trademark (the "Mark") in connection with its legal services since 1975.

The Complainant has obtained two registrations of the Mark with the United States Patent and Trademark Office:

- Registration No. 1,665,352, dated November 19, 1991, and
- Registration No. 2,916,268, dated January 4, 2005.

The disputed domain name was registered on June 29, 2022. The disputed domain name resolves to a parking website hosting pay-per-click links, which led to the third party websites.

5. Parties' Contentions

A. Complainant

The Complainant asserts the disputed domain name is confusingly similar to the Mark because the disputed domain name is composed by dropping the ampersand from the Mark and adding the letter "s" to the end of the Mark.

The Complainant asserts that the Complainant has never authorized the Respondent to use the disputed domain name, that the Respondent is not generally known by the disputed domain name, and that the Respondent has never engaged in any *bona fide* commercial activity in connection with the disputed domain name.

The Complainant asserts that the Respondent registered and used the disputed domain name in bad faith for unspecified reasons which may include deceiving future Internet users or using email addresses associated with the disputed domain name for a wide variety of illicit purposes.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark 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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's Mark.

The disputed domain name is composed by merely dropping the "&" from the Mark and adding the letter "s". The use of a trademark in a domain name in which letters have been omitted, added, inverted, or substituted is commonly known as "typosquatting" and does not negate the confusingly similar aspects of the domain name pursuant to paragraph 4(a)(i) of the Policy. *Andrey Ternovskiy dba Chatroulette v. Registration Private, Domains by Proxy, LLC / I S, ICS INC*, WIPO Case No. D2016-1916.

Moreover, a domain name which incorporates a clearly identifiable component or dominant portion of a complainant's registered mark, as is the case here, is sufficient to establish confusingly similarity for the purposes of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.7; see also WIPO Overview 3.0, section 1.8 ("where the relevant trademark is recognizable with the disputed domain name, the additions of other terms (whether descriptive, geographic, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element"); *Nomura International Plc. v. Name Redacted*, WIPO Case No. D2021-0654.

The generic Top-Level Domain of the disputed domain name, in this case ".com", may be disregarded for the purposes of assessment under the first element, as it is viewed as a standard registration requirement. See WIPO Overview 3.0, section 1.11.1. *Monster Energy Company, a Delaware Corporation v. J.H.M. den Ouden*, WIPO Case No. D2016-1759 (transferring <monsterenergy.world>).

The Complainant has met its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has specifically disavowed providing the Respondent with permission to use the disputed domain name or the Mark. The Respondent is not affiliated with the Complainant in any way and does not have any business relationship with the Complainant. There is no evidence that the Respondent has conducted any *bona fide* business under the disputed domain name or is commonly known by the disputed domain name. *Compagnie de Saint Gobain v. Com-Union Corp*, WIPO Case No. D2000-0020. The fact that the disputed domain name resolves to a "parking" website is further evidence of a lack of the Respondent's rights or legitimate interests in the disputed domain name. Moreover, the potential misuse of email addresses associated with the MX record configuration for the disputed domain name, noting the nature of the disputed domain name, suggests the high possibility, if not likelihood, of misuse of the disputed domain name. See Section C below.

The Complainant has thus established a *prima facie* case in its favor, which shifts the burden of production on this point to the Respondent. The Respondent, however, has failed to come forth with any evidence showing any rights or legitimate interests in the disputed domain name.

The facts and circumstances presented to the Panel demonstrate that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, bad faith may be established by any one of the following scenarios:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of

the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Panel finds the disputed domain name was registered and is being used in bad faith.

On the evidence presented, there is little doubt that the disputed domain name was registered and used in bad faith. The disputed domain name does resolve to a mere parking website. The disputed domain name was registered utilizing a privacy service. The Respondent provided false information to the Registrar when registering the disputed domain name. Annex F to the amended Complaint.

No one can reasonably believe that the Respondent composed the disputed domain name by mere coincidence where the disputed domain name utilizes the exact terms of the Complainant's Mark. Moreover, the Complainant's Mark would have been quickly revealed in a basic Internet search.

Finally, the Respondent has configured an MX record for the disputed domain name, which cagily differs ever so slightly from the Mark. The immediate potential for misuse of the disputed domain name is real and apparent. *Drägerwerk AG & Co. KGaA v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / BLACK ROSES*, WIPO Case No. D2020-3167.

Even ignoring the above compelling conclusions, it is difficult to conceive of any use that the Respondent might make of the disputed domain name without the Complainant's consent that would not involve bad faith. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003; *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. D2012-1909 ("where the reputation of a complainant in a given mark is significant and the mark bears strong similarities to the disputed domain name, the likelihood of confusion is such that bad faith may be inferred"); *DPDgroup International Services GmbH & Co. KG v. Wise One, Wilson TECH*, WIPO Case No. D2021-0109; *Monster Energy Company v. PrivacyDotLink Customer 116709 / Ferdinand Nikolaus Kronschnabl*, WIPO Case No. D2016-1335.

The Complainant has met its burden under paragraph 4(a)(iii) 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 <morrisonfoersters.com> be transferred to the Complainant.

/William F. Hamilton/

William F. Hamilton

Sole Panelist

Date: November 21, 2022