

ADMINISTRATIVE PANEL DECISION

Pinsent Masons LLP v. Scott Rosen
Case No. D2022-4689

1. The Parties

The Complainant is Pinsent Masons LLP, United Kingdom, internally represented.

The Respondent is Scott Rosen, United States of America.

2. The Domain Name and Registrar

The disputed domain name <pinsentmasons-download.com> (the “Domain Name”) is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 7, 2022. On December 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On December 9, 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 (Registration Private / Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 12, 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 December 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 December 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 12, 2023.

The Center appointed Jeremy Speres as the sole panelist in this matter on January 18, 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

The Complainant, based in the United Kingdom, is a full-service international law firm engaged in the provision of legal services across a broad spectrum of practice areas including construction, dispute resolution, outsourcing and technology, corporate finance and intellectual property. The Complainant operates internationally with 26 offices across the United Kingdom, Europe, the Gulf, Asia Pacific and Africa. The Complainant's history dates back to 1995. After numerous mergers the Complainant adopted the name PINSENT MASONS in December 2004 and has used it continuously since then. The Complainant's PINSENT MASONS mark has been recognised as being well-known by prior UDRP panels (see, for example, *Pinsent Masons LLP v. Contact Privacy Inc. Customer 1246646498 / Barry Quinn*, WIPO Case No. [D2020-0956](#)).

The Complainant's mark is registered in various jurisdictions, including United Kingdom trade mark registration no. UK00002484418 PINSENT MASONS (word) in classes 9, 16, 35, 36, 41 and 45, with registration date September 12, 2008.

The Domain Name was registered on October 18, 2021, and does not resolve to any website.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to its PINSENT MASONS mark, that the Respondent has no rights or legitimate interests in the Domain Name, and the Domain Name was registered and used in bad faith under the doctrine of passive holding in light of the renown of the Complainant's mark.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant's registered PINSENTS MASONS mark is wholly contained within the Domain Name with only "-download" added. Where the trade mark is recognisable within the disputed domain name (as in this case), the addition of other terms does not prevent a finding of confusing similarity (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.8). The Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant's un rebutted evidence establishes that its PINSENT MASONS mark was registered and well-known long prior to registration of the Domain Name. The Domain Name is confusingly similar to the Complainant's mark and the Complainant has certified that the Domain Name is unauthorised by it.

The Respondent has provided no explanation as to why it chose the Domain Name. There is no semantic value to the Domain Name which the Respondent might, in good faith, have sought to adopt. There is no evidence of use of the Domain Name for a *bona fide* offering of goods or services or any legitimate noncommercial or fair use. Thus, there is no evidence that any of the circumstances set out in paragraph 4(c) of the Policy, nor any others which might confer rights or legitimate interests upon the Respondent, pertain. The Complainant has satisfied paragraph 4(a)(ii) of the Policy by virtue of having made out an un rebutted *prima facie* case ([WIPO Overview 3.0](#) at section 2.1).

C. Registered and Used in Bad Faith

Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term as in this case) to a well-known trade mark by an unaffiliated entity can by itself create a presumption of bad faith ([WIPO Overview 3.0](#) at section 3.1.4).

Linguistically the Domain Name does not make sense other than as referring to the Complainant's mark, which is well-known, has no generic meaning and is highly specific to the Complainant. A Google search for the Complainant's mark reveals results overwhelmingly relating to the Complainant. The Respondent did not respond to the Complaint. As such, there is no plausible explanation for the Respondent's choice of domain name other than as targeting the Complainant.

The Panel's independent research establishes that mail exchange (MX) records are set for the Domain Name, enabling use for email. This raises the risk of email-based fraud (*Statoil ASA v. Registration Private, Domains By Proxy, LLC / Eldar Saetre*, WIPO Case No. [D2018-0563](#)). The composition of the Domain Name, incorporating the Complainant's well-known mark together with the term "download", raises the risk of use of the Domain Name for downloadable malware. It also falsely suggests to users that content relating to the Complainant can be downloaded at the Domain Name.

The fact that the Domain Name does not resolve to any website does not prevent a finding of bad faith under the doctrine of passive holding; all the factors that panels typically consider under that doctrine favour the Complainant ([WIPO Overview 3.0](#) at section 3.3).

The Panel draws adverse inferences from the Respondent's failure to take part in the present proceeding where an explanation is certainly called for ([WIPO Overview 3.0](#) at section 4.3) and the use of a privacy proxy service ([WIPO Overview 3.0](#) at section 3.6).

The Complainant has satisfied 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 Domain Name, <pinsentmasons-download.com>, be transferred to the Complainant.

/Jeremy Speres/

Jeremy Speres

Sole Panelist

Date: January, 26, 2023