

## **ADMINISTRATIVE PANEL DECISION**

Bryan Cave Leighton Paisner LLP v. Metodi Darzev  
Case No. D2023-0155

### **1. The Parties**

The Complainant is Bryan Cave Leighton Paisner LLP, United States of America (“United States”), internally represented.

The Respondent is Metodi Darzev, Bulgaria.

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 12, 2023. On January 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 13, 2023, 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 the Complainant on January 13, 2023, 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 January 19, 2023.

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 January 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 14, 2023.

The Center appointed Torsten Bettinger as the sole panelist in this matter on March 3, 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 is an international law firm with more than 1,200 lawyers in 30 offices around the world, including in North America, Europe, the Middle East, and Asia.

The Complainant provided evidence of the following trademark registrations for the term BRYAN CAVE:

- European Union Registration No. 008806036, registered on June 2, 2010, for “legal services” in International Class 45;
- United Kingdom (“UK”) Registration No. UK00908806036, registered on June 2, 2010, for “legal services” in International Class 45;
- UK Registration No. UK00002307344, registered on January 10, 2003, for “legal services; legal research; litigation services; provision of information and/or advice in respect of the foregoing” in International Class 42;
- Chinese Registration No. 14060148, registered on April 14, 2015, for “legal research; legal services” in International Class 45;
- Chinese Registration No. 14060149, registered on May 7, 2015, for numerous services in International Class 35, including business management, organizational, and professional consulting services;
- Hong Kong, China Registration No. 200303516 registered on August 5, 2002, for legal services in International Class 42;
- Singapore Registration No. T1402595A registered September 10, 2014, for various services in International Classes 35 and 45, including legal services.

The Respondent registered the disputed domain name on July 3, 2022. The disputed domain name resolves to a parked page comprising pay-per-click (“PPC”) advertising links related to legal services.

#### **5. Parties’ Contentions**

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

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant asserts that:

- the disputed domain name incorporates the BRYAN CAVE mark in its entirety and that the incorporation of a trademark in its entirety or a dominant feature of a trademark is sufficient to establish that a domain name is identical or confusingly similar to the complainant’s mark;
- the mere addition of the word “datamatters” which is descriptive of the Complainant’s core business is not sufficient to dispel confusion and actually enhances confusion;

- the Respondent seeks to exploit consumer confusion and the Complainant's reputation and goodwill by fully incorporating the Complainant's BRYAN CAVE Marks in the disputed domain name.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- the Respondent is not in any way associated with the Complainant and has never sought nor received authorization or a license to use the Complainant's BRYAN CAVE marks in any way or manner;
- the Complainant's BRYAN CAVE marks are well-known and widely recognized in the United States and abroad, and, in particular, throughout the global legal community;
- the Respondent has no means to establish that they are or ever have been commonly known as BRYAN CAVE or BRYAN CAVE DATA MATTERS;
- the Respondent has not sought or procured any registrations for any tradenames, corporations, or trademarks with any governmental or business authority for BRYAN CAVE or BRYAN CAVE DATA MATTERS;
- the Respondent does not have any legitimate trademark, service mark, or other intellectual property rights in or to any of the BRYAN CAVE marks or any similar marks;
- the Respondent registered and uses the disputed domain name to lure consumers to an imposter's site for commercial gain;
- the disputed domain name resolves to a parked page comprising "pay-per-click" links advertising services that directly compete with, capitalize on the reputation and goodwill of the Complainant's BRYAN CAVE marks, and otherwise mislead Internet users;
- The Respondent is not making any legitimate noncommercial use of the disputed domain name;
- the Respondent adopted and continues to use the disputed domain name for potentially illegal and improper purpose of (i) illegally trading upon the Complainant's goodwill to confuse, mislead, deceive and divert customers; and (ii) intentionally tarnishing and diluting the Complainant's valuable and well-known trademarks;
- the disputed domain name could be used for potential phishing e-mails or to bait and lure consumers to the Respondent's imposter site.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the disputed domain name is plainly designed to trade on the reputation and goodwill of the Complainant and its BRYAN CAVE marks for financial gain;
- the Respondent utilizes the disputed domain name to divert potential users away from the Complainant and its authentic BRYAN CAVE services and toward their website;
- the registration of a domain name by someone with no connection to the Complainant suggests opportunistic bad faith to create an impression of association with the Complainant, especially where no legitimate interest is clearly proven by the Respondent;
- the Respondent's complete lack of intellectual property rights in the disputed domain name demonstrates bad faith in adopting and using the disputed domain name;
- the Respondent registered the disputed domain name, which wholly incorporates and/or is confusingly similar to the Complainant's BRYAN CAVE marks, but for the addition of the descriptive phrase "data matters," and is passively holding the domain to advertise pay-per-click links referring to the Complainant's core services and leading to websites of some of the Complainant's competitors;
- the fact that the Respondent used a privacy shield for registration of the disputed domain name is further evidence of bad faith;
- the disputed domain name resolves to a webpage that does not contain direct contact information for the Respondent, and there is no disclaimer to notify the public that the website is not affiliated with the Complainant;
- the Respondent is a habitual cyber-squatter and repeat offender, having been implicated in no less than eight UDRP disputes since 2019, each of which resulted in the transfer of the domain names to the complainants.

## B. Respondent

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

## 6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns multiple trademark registrations for the mark BRYAN CAVE.

It is well-established that the test of identity or confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases. (See sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

In this case, the disputed domain name contains the BRYAN CAVE trademark in its entirety. As set forth in section 1.7 of [WIPO Overview 3.0](#): "in cases where a domain name incorporates the entirety of a trademark [...] the domain name will normally be considered confusingly similar to that mark." (See, e.g., *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy")).

Further, the disputed domain name only differs from the Complainant's trademark BRYAN CAVE by the addition of the terms "DataMatters". It is well-established that the addition of wording to a trademark in a domain name does not prevent a finding of confusing similarity under the first element of the UDRP (see section 1.8 of [WIPO Overview 3.0](#)).

Finally, it is well accepted under the UDRP case law that the specific generic Top-Level Domain ("gTLD") designation such as ".com", ".net", ".org" is not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable top-level suffix may itself form part of the relevant trademark ([WIPO Overview 3.0](#) section 1.11).

For the foregoing reasons the Panel concludes that the disputed domain name is confusingly similar to the Complainant's BRYAN CAVE Trademark in which the Complainant has exclusive rights.

### B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy a respondent may establish its rights or legitimate interests in the domain name, among other circumstances, by showing any of the following elements:

- "(i) before any notice to you [the Respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you [the Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [the Respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or

service mark at issue.”

The Complainant states that the Respondent is not in any way associated with the Complainant and has never sought nor received authorization or a license to use the Complainant’s BRYAN CAVE marks in any way or manner.

Further, the Complainant asserted and presented evidence that the disputed domain name resolves to a parked page comprising PPC advertising links that redirect Internet users to various sites and services, some of which compete with the Complainant’s offerings.

These assertions and evidence are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

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 disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent chose not to contest the Complainant’s allegations and has failed to come forward with any evidence to refute the Complainant’s *prima facie* showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts these allegations as undisputed facts.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain names or more generally any of the BRYAN CAVE marks. Nor could the Respondent likely ever become commonly known by the disputed domain names or any of the BRYAN CAVE Marks without infringing on the exclusive trademark rights of the Complainant.

From the record in this case, the Respondent has also not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, the evidence demonstrates that the Respondent has used the disputed domain name to resolve to a PPC advertising webpage featuring various links that redirects Internet users to competing websites.

Regardless of whether the Respondent consciously included those links or whether an algorithm over which the Respondent had limited or no control generated them, the advertisements undoubtedly take advantage of the Complainant’s trademarks and the Panel therefore concludes that such use can convey no rights or legitimate interests in the disputed domain name and that, accordingly, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- i. circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- ii. the Respondent has registered the disputed 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 disputed domain name primarily for the purpose of disrupting the

business of a competitor; or

iv. by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online 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 Complainant holds multiple trademark registrations for the BRYAN CAVE mark in various countries that predate the registration of the disputed domain name.

Given that the Complainant's BRYAN CAVE mark was widely known at the time the Respondent registered the disputed domain name and that the term BRYAN CAVE has no ordinary meaning that might explain why the Respondent registered the domain in combination with descriptive terms that have clear connotations to the Complainant's offerings, it is inconceivable that the Respondent coincidentally registered the disputed domain name without any knowledge of the Complainant and its BRYAN CAVE mark.

The Panel therefore concludes that the Respondent registered the disputed domain name in bad faith.

Based on the record in this proceeding it is also undisputed that the disputed domain name redirects Internet users to a PPC parking page featuring links to websites some of which compete with the Complainant's offerings.

The purpose of this PPC parking website clearly was to attract Internet users to the site, for profit, based on their confusing the Respondent's domain name and/or website with the Complainant. Once on the Respondent's page, some users likely click on PPC links, which presumably result in click-through fees and thus in a commercial benefit on the Respondent.

The Panel therefore infers that the Respondent by using the disputed domain name in this manner, has intentionally created a likelihood of confusion with the Complainant's trademark for the Respondent's financial gain and that the Respondent is using the disputed domain name in bad faith.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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 <bryancavedatamatters.com> be transferred to the Complainant.

*/Torsten Bettinger/*

**Torsten Bettinger**

Sole Panelist

Date: March 17, 2023