

## **ADMINISTRATIVE PANEL DECISION**

Ropes & Gray LLP v. matthew rolland, ropes gray  
Case No. D2023-0288

### **1. The Parties**

The Complainant is Ropes & Gray LLP, United States of America (hereinafter “United States”), represented by Ropes & Gray LLP, United States.

The Respondent is matthew rolland, ropes gray, United States.

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

The disputed domain name <ropesgray-us.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 January 23, 2023. On January 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 23, 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 (Redacted for Privacy, Withheld for privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 25, 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 28, 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 February 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 13, 2023.

The Center appointed Kathryn Lee as the sole panelist in this matter on March 21, 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 1,500 attorneys and professionals in 13 offices in the United States, Europe, and Asia. It was founded in 1865 and has been known by the name Ropes & Gray for over 150 years. The Complainant has a number of trademark registrations for the mark ROPES & GRAY including Trademark Registration Number 2,902,936 registered in the United States on November 16, 2004. The Complainant has owned and used the domain name <ropesgray.com> for its official website since October 12, 1995.

The Respondent appears to be an individual with an address in the United States.

The disputed domain name was registered on December 18, 2022 and does not resolve to any active website.

#### **5. Parties' Contentions**

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

The Complainant contends that the disputed domain name is confusingly similar to the ROPES & GRAY trademark in which the Complainant has rights. The Complainant explains that the disputed domain name incorporates the Complainant's trademark as a whole, with the only differences being the lack of the ampersand and the additional term "us." The Complaint also explains that the lack of the ampersand is a minor difference and that the additional term "us" is a two-word letter abbreviation for the United States, which is a generic term and does not eliminate the confusing similarity between the Complainant's trademark and the disputed domain name.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name and confirms that it has not authorized or licensed rights to the Respondent in any respect. The Complainant further contends that there is no evidence of the Respondent's use of, or demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services.

Finally, the Complainant contends that the disputed domain name was registered and is used in bad faith. The Complainant explains that the Respondent's registration of the disputed domain name that is confusingly similar to the Complainant's registered mark is sufficient evidence of bad faith registration and use. Further, the Complainant contends that the Respondent has used the disputed domain name to send phishing emails, falsely claiming to come from a partner at the Complainant's firm, which is clear bad faith use. The Complainant also argues that although the disputed domain name does not resolve to an active website, passive holding does not prevent a finding of bad faith.

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

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

#### **6. Discussion and Findings**

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

The Complainant has demonstrated with supporting evidence that it has rights to the trademark ROPES & GRAY. As for the disputed domain name, it consists of "ropesgray" with a hyphen and the term "us" which is often used as the abbreviation for "United States." According to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7, a domain name is considered confusingly similar to a trademark if it "incorporates the entirety of a trademark, or where at least a dominant

feature of the relevant mark is recognizable in the domain name". In this regard, the main elements of the Complainant's mark – ROPES and GRAY – are incorporated in the disputed domain name and are readily recognizable within the disputed domain name. The lack of the ampersand and the additional term "us" do not prevent a finding of confusing similarity (see [WIPO Overview 3.0](#), section 1.8).

For the reasons mentioned above, the Panel finds that the first element has been established.

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

On the basis of the present record, the Panel finds that the Complainant has made the required allegations to support a *prima facie* case showing that the Respondent has no rights or legitimate interests in the disputed domain name. Once such a *prima facie* case has been established, the burden of production shifts to the Respondent to demonstrate its rights or legitimate interests in the disputed domain name, with the burden of proof always remaining with the Complainant. However, the Respondent in this case has chosen to file no Response to these assertions by the Complainant, and there is no evidence or allegation in the record that would warrant a finding in favor of the Respondent on this point.

Further, the Respondent used the disputed domain name in an apparent phishing scheme in which the Respondent passed itself off as partner from the Complainant seeking information on invoice statements, and a response would no doubt have eventually led to the Respondent soliciting transfer of funds to its own bank account. The use of a domain name for illegal activity can never confer rights or legitimate interests on the Respondent. See [WIPO Overview 3.0](#), section 2.13.1.

For the reasons provided above, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name, and that the second element has been established.

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

The Panel finds that there is strong and clear evidence to find bad faith in this case.

First and foremost, the Respondent used the disputed domain name to perpetuate fraud by sending at least two emails from the disputed domain name to the Complainant's client, seeking payment information. The emails from the Respondent were disguised as an email from a partner at the Complainant, and the Complainant's actual address, telephone number, and logo were used in the signature block in order to deceive the recipient into believing that the email actually came from the partner. Using a domain name in a fraudulent activity is manifestly evidence of bad faith registration and use. See [WIPO Overview 3.0](#), section 3.1.4 and section 3.4.

Further, considering the fame of the Complainant and its mark, and the use of the disputed domain name in perpetuating fraud, it is quite clear that the Respondent registered the disputed domain name with knowledge of the Complainant's trademark and the intent to benefit financially from the disputed domain name and the fame and reputation associated with the Complainant's trademark.

The disputed domain name does not display any content, but from the inception of the UDRP, UDRP panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. See [WIPO Overview 3.0](#), section 3.3. Considering the use of the disputed domain name for phishing activities, the distinctiveness of the ROPES & GRAY mark, the Respondent's failure to submit a response or provide any evidence of actual or contemplated good-faith use, and the implausibility of any good faith use to which the confusingly similar disputed domain name could be put, the Panel finds that the Respondent's non-use of the disputed domain name does not prevent a finding of bad faith.

For the reasons given above, the Panel finds that the third element has been established.

## 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, <ropesgray-us.com> be transferred to the Complainant.

*/Kathryn Lee/*

**Kathryn Lee**

Sole Panelist

Date: April 4, 2023