

ADMINISTRATIVE PANEL DECISION

Pinsent Masons LLP v. Ielievre Jerome
Case No. D2023-0981

1. The Parties

The Complainant is Pinsent Masons LLP, United Kingdom, represented by Gillian Anderson, United Kingdom.

The Respondent is Ielievre Jerome, France.

2. The Domain Name and Registrar

The disputed domain name <pinsentmasons-lawfirm.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 March 3, 2023. On March 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 March 7, 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 March 10, 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 March 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 3, 2023.

The Center appointed Selma Ünlü as the sole panelist in this matter on April 12, 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, Pinsent Masons LLP, is a full service international law firm providing legal services in various 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 owns several trademarks containing “Pinsent Masons”, *inter alia*, as follows:

- International word mark PINSENT MASONS no. 977347, registered since April 30, 2008;
- the European Union word mark PINSENT MASONS no. 006819197, registered since November 26, 2008, and;
- the United Kingdom word mark PINSENT MASONS no. UK00002484418, registered since September 12, 2008.

The Complainant is also the owner of the domain name including the trademark PINSENT MASONS, <pinsentmasons.com> registered in 2004.

The disputed domain name was registered on May 25, 2022, and at the time of the filing of the Complaint, resolved to a blank webpage where it is only stated that “Hmmm... can’t reach this page” and “ERR_CONNECTION_REFUSED”. At the time of this Decision, the disputed domain name still resolves to an error webpage, this time with a 404 Error.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to the Complainant’s trademark and the domain name includes the trademark in its entirety. The Complainant also contends that the addition of the word “lawfirm” does not avoid a finding of confusing similarity and it is a classic case of domain squatting. Also, the Complainant states that the generic Top-Level Domain (“gTLD”) “.com” causes further confusion because the Complainant offers legal relates services worldwide. Therefore, the Complainant asserts that the disputed domain name is confusingly similar to its prior trademark PINSENT MASONS.

The Complainant asserts that the Respondent is not making a legitimate noncommercial fair use of the disputed domain name. The Complainant also adds that it is reasonable to consider the disputed domain name was registered by the Respondent knowingly that it is likely to attract Internet users searching for the Complainant. Therefore, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant claims that the disputed domain name incorporates the Complainant’s trademark in full without consent and also adds “lawfirm”, which is directly related to the Complainant’s area of activity. The Complainant also states that PINSENT MASONS is used widely and is reputed in legal services. Consequently, the Complainant contends that the Respondent must have known about the Complainant’s trademark, which evidences bad faith.

Moreover, it is claimed that the Respondent does not make any use of the disputed domain name and the Respondent concealed its identity. The Complainant claims that the Respondent's registration of the disputed domain name also prevented the Complainant from registering a domain name corresponding to its trademarks. It is further claimed that the disputed domain name is obviously intended to imply a connection with the Complainant that its use by the Respondent constitutes opportunistic bad faith.

It is also suggested by the Complainant that the public will always assume there is an association between the Respondent and the Complainant's trademarks because of the notoriety of the Complainant, therefore, the Respondent will never be capable of using the disputed domain name for a legitimate reason.

Consequently, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

The Complainant must prove that the three elements of paragraph 4(a) of the Policy have been met for the disputed domain name, namely:

- (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.

Since the Respondent did not object to any of the contentions from the Complainant by not submitting a Response, the Panel will decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable and on the basis of the Complaint and supporting Annexes.

A. Identical or Confusingly Similar

In light of the explanations and evidence provided by the Complainant, the Panel is satisfied that the Complainant has valid trademark rights in the PINSENT MASONS trademark, which is reproduced in its entirety in the disputed domain name.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's PINSENT MASONS trademark and the addition of the word "lawfirm" is not sufficient to vanish the similarity. Furthermore, the addition of the gTLD ".com" does not prevent a finding of confusing similarity, since it is merely a technical registration requirement to be disregarded typically.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists non-exhaustively the relevant circumstances that could show the Respondent's rights or legitimate interests in a domain name, as follows:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the respondent’s] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to [the respondent] of the dispute, [the respondent’s] 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) [the respondent] (as an individual, business, or other organization) ha[s] been commonly known by the domain name, even if [the respondent] ha[s] acquired no trademark or service mark rights; or

(iii) [the respondent] is 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 Panel notes that the Respondent has not filed a Response, and therefore, neither denied the Complainant’s claims, nor brought any information or evidence to prove any rights or legitimate interests.

The Complainant has made a *prima facie* showing that the Respondent does not have any rights or legitimate interests in the disputed domain name.

Since the Complainant made out a *prima facie* case, the burden of production shifts to the Respondent to establish its rights or interests in the disputed domain name. The Respondent, however, has not sought to rebut that *prima facie* case.

In light of the Complainant’s assertions and evidence, the Panel finds that the Complainant has met the requirement under the Policy of *prima facie* showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists certain relevant non-exhaustive circumstances, which can be considered as the registration and use of a domain name in bad faith, namely:

“(i) circumstances indicating that [the respondent has] registered or acquired [a disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration 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 [the respondent’s] 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.”

Given the explanations in the Complaint and the evidence provided by the Complainant, the Panel finds that the disputed domain name was registered in bad faith.

The Panel concludes that the Complainant's PINSENT MASONS trademark is of distinctive character and it has a reputation in its relevant sector. The addition of the word "lawfirm" increases the confusion since it is the type of entity the Complainant is and it refers to the Complainant's area of activity. The fact that the Respondent decided to register the disputed domain name including the trademark in its entirety with such addition strongly suggests that the Respondent took the Complainant's well-known PINSENT MASONS trademark into account and targeted it specifically in order to gain unfair advantage.

Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in the PINSENT MASONS trademarks, the Respondent was aware of the Complainant and its trademarks at the time of registration of the disputed domain name (see *e.g.*, *Ebay Inc. v. Wangming*, WIPO Case No. [D2006-1107](#)). Referring to *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#), the Panel believes that the awareness of the Complainant's trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Moreover, the disputed domain name is currently inactive. Regarding domain names which resolve to inactive websites, section 3.3 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition](#) provides the following: "From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding." The Panel finds that the passive holding of the disputed domain name does not prevent a finding of bad faith here, considering the present circumstances of the case.

Consequently, the Panel decides that the third requirement is also met and both the registration and the use of the disputed domain name are in bad faith.

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, <pinsentmasons-lawfirm.com>, be transferred to the Complainant.

/Selma Ünlü/

Selma Ünlü

Sole Panelist

Date: April 24, 2023