

## **ADMINISTRATIVE PANEL DECISION**

Ropes & Gray LLP v. Marco Solo

Case No. D2023-2994

### **1. The Parties**

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

The Respondent is Marco Solo, Israel.

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

The disputed domain name <ropesgrayfirm.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 July 12, 2023. On July 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 19, 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 July 21, 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 July 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 22, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on August 25, 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 the centenary law firm Ropes & Gray.

In addition to its long-standing common law rights in the ROPES & GRAY mark, the Complainant owns a valid and uncontested trademark registration in United States (No. 2,902,936, registered on November 16, 2004).

The Complainant is also the owner of domain names containing the term “Ropes” and “Gray”, including <ropesgray.com>, registered on October 12, 1995.

The Respondent registered the disputed domain name on April 20, 2023.

The disputed domain name does not resolve to any active website.<sup>1</sup> However, the Complainant brought evidence that the Respondent has used the disputed domain name to send phishing emails.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The disputed domain name shows a clear resemblance to the Complainant's registered ROPES & GRAY mark and <ropesgray.com> domain name. The disputed domain name incorporates the Complainant's trademark in its entirety with the only differences being the exclusion of the ampersand and the addition to the end of the mark of the word “firm”, which conveys the type of business entity operated by the Complainant. Minor differences, such as the addition of the business entity type or deletion of an ampersand, have been found to be confusingly similar in many cases. Therefore, the disputed domain name is likely to cause confusion, to cause mistake, and to deceive as to the affiliation, connection, or association of the Respondent with the Complainant.
- The Respondent has no rights or legitimate interests in respect of the disputed domain name. There is no relationship or affiliation between the Complainant and the Respondent giving rise to any license, permission, or other right by which the Respondent could own or use any domain name incorporating the Complainant's registered ROPES & GRAY mark. The Respondent's registration of the disputed domain name without any relationship to the Complainant or its mark itself creates a strong presumption that the Respondent lacks a legitimate interest in the disputed domain name. Both prior to and subsequent to the date of registration, the Respondent has not used or prepared to use the disputed domain name with any *bona fide* offering of goods or services, has not been commonly known by the disputed domain name, and has not made any noncommercial or fair use of the disputed domain name. In fact, aside from potential bad faith use of the disputed domain name in connection with a phishing and wire fraud scheme, the disputed domain name does not appear to be in use at all, and there is no website associated with the disputed domain name.
- The disputed domain name was registered and is being used in bad faith. The Respondent registered the disputed domain name without the Complainant's authorization 158 years after the Complainant was founded, over twenty-five years after the Complainant registered and commenced use of its own <ropesgray.com> domain name and mark, and more than a decade after the Complainant's registration of its

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<sup>1</sup> Further to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.8, “[n]oting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision... This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the disputed domain name...”.

ROPES & GRAY mark. The Respondent's registration of the disputed domain name that is confusingly similar to the Complainant's registered and common law marks, without any relationship to them, is itself sufficient evidence of bad faith registration and use. Further, the Respondent's clear intent is to mislead or to deceive the Complainant's current and prospective clients, and/or to tarnish the Complainant's mark and reputation, as the Respondent has used and appears to be continuing to use the disputed domain name to send phishing emails, falsely claiming to come from a partner at the Complainant, as part of a business email compromise scheme. Even though the disputed domain name now does not resolve to an active website, this does not prevent a finding of bad faith. Indeed, its presence in the hands of the Respondent poses an abusive threat hanging over the head of the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three 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 Panel has no doubt that "ROPES & GRAY" is a term directly connected with the Complainant's centenary law firm.

Besides the Complainant's common law rights, Annex 5 to the Complaint shows a trademark registration for ROPES & GRAY in the United States that date in 2004.

The trademark ROPES & GRAY is essentially encompassed within the disputed domain name. The disputed domain name differs from the Complainant's trademark ROPES & GRAY merely by the exclusion of the ampersand and the addition of the suffix "firm", as well as of the generic Top-Level Domain ("gTLD") extension ".com".

Previous UDRP decisions have found that the mere addition of descriptive terms (such as "firm" for an organization providing legal services) to a trademark in a domain name does not avoid a finding of confusing similarity. This has been held in many UDRP cases (see, e.g., *Inter-IKEA Systems B.V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#); *Wal-Mart Stores, Inc. v. Lars Stork*, WIPO Case No. [D2000-0628](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#); *AltaVista Company v. S. M. A., Inc.*, WIPO Case No. [D2000-0927](#)).

It is also already well established that the addition of a gTLD extension such as ".com" is typically irrelevant when determining whether a domain name is confusingly similar to a complainant's trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks, and that the Complainant has satisfied the first element of the Policy.

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

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the disputed domain name; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

Based on the Respondent's default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed or authorized the usage of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name.

The Panel notes that the present record provides no evidence to demonstrate the Respondent's intent to use or to make preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Indeed, the Complainant has showed that the disputed domain was recently used in connection with a phishing scheme, by which the Respondent pretended to operate in association with the Complainant.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

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

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or 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 that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the respondent 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 its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent (in 2023), the trademark ROPES & GRAY was already directly connected to the Complainant's notorious law firm.

According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 3.1.4, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

The Panel concludes that it would not be feasible to consider that the Respondent – at the time of the registration of the disputed domain name – could not have been aware of the Complainant’s trademark, as well as that the adoption of the expression “ropesgrayfirm” together with the gTLD extension “.com” could be a mere coincidence.

Actually, the Panel considers that in the present case the addition to the Complainant’s trademark of the descriptive term “firm” may even enhance the risk of confusion, suggesting that it is the firm’s official website.

The non-collaborative posture of the Respondent, *i.e.*, (a) not at least submitting a Response to this procedure or providing justifications for the use of a third party traditional trademark, certainly cannot be used in benefit of the Respondent in this Panel’s opinion. Such circumstances, together with (b) the lack of any plausible interpretation for the adoption of the term “ropesgrayfirm” by the Respondent, and (c) with the fact that the disputed domain name was used to operate a phishing scheme, are enough in this Panel’s view to characterize bad faith registration and use in the present case.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied the third element 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 <ropesgrayfirm.com> be transferred to the Complainant.

*/Rodrigo Azevedo/*

**Rodrigo Azevedo**

Sole Panelist

Date: September 11, 2023