

ADMINISTRATIVE PANEL DECISION

Bryan Cave Leighton Paisner LLP v. Fox Great
Case No. D2023-5069

1. The Parties

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

The Respondent is Fox Great, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <bclpiaw.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 December 5, 2023. On December 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 6, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 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 December 11, 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 December 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 12, 2024.

The Center appointed Tommaso La Scala as the sole panelist in this matter on January 17, 2024. 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 in this administrative proceeding is Bryan Cave Leighton Paisner LLP (hereinafter "BCLP" or the "Complainant"), a law firm and limited liability partnership with more than 1,200 lawyers across 30 offices around the world, including in North America, Europe, the Middle East, and Asia.

Bryan Cave LLP and Berwin Leighton Paisner LLP merged to create BCLP in 2018. Following this merger, the BCLP name and mark were adopted.

The Complainant has proven to have rights in the BCLP and BCLP LAW trademarks, which enjoy protection through several registrations.

The Complainant has rights in *inter alia* the following trademarks:

- United Kingdom Trademark BCLP LAW No. UK00003263855 registered on January 26, 2018;
- United Kingdom Trademark BCLP No. UK00003263851 registered on January 26, 2018;
- International Trademark BCLP (stylized) No. 1416299 registered on March 28, 2018;
- International Trademark BCLP No. 1424544 registered on March 1, 2018.

Furthermore, the Complainant is the holder of the domain name <bclplaw.com> under which the official website of the Complainant is accessible.

The disputed domain name was registered on November 21, 2023, and has been used to fraudulently impersonate the Complainant via e-mail regarding redirection of payments on bills to Respondent's personal accounts.

5. Parties' Contentions

A. Complainant

The Complainant claims that:

- (a) The disputed domain name is confusingly similar to the Complainant's trademarks and to the domain name <bclplaw.com>;
- (b) the Respondent lacks any rights or legitimate rights in the disputed domain name; and
- (c) the Respondent registered and is using the disputed domain name in bad faith, namely for impersonating one of the Complainant's administrative assistants.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has established rights in the BCLP and BCLP LAW trademarks.

The disputed domain name consists of the BCLP LAW trademark with the sole replacement of the letter "i" for the letter "l." This Panel agrees with the Complainant's assertion that such minimal variation in the disputed domain name is irrelevant in assessing the confusing similarity between the Complainant's trademarks and the disputed domain name.

Therefore, the Panel finds the disputed domain name to be confusingly similar to the BCLP and BCLP LAW trademarks in which the Complainant has rights.

Accordingly, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, 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 domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

This Panel finds that the Complainant has made a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name. As a matter of fact, the Respondent does not appear to be commonly known by the name "BCLP" and/or any similar name. The Respondent has no connection to or affiliation with the Complainant, and the Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant's trademarks. The Respondent does not appear to make any legitimate noncommercial or fair use of the disputed domain name, nor any use in connection with a *bona fide* offering of goods or services. Lastly, the Respondent has used the disputed domain name to illicitly impersonate one of the Complainant's administrative assistants.

Having reviewed the available record and considering that Respondent has not rebutted Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Complainant has documented that the Respondent has purposely used the disputed domain name to attempt to defraud others by impersonating an administrative assistant at BCLP – with the purpose of redirecting payments on bills to Respondent’s personal accounts – with an email box specifically created by the Respondent for such reason.

This conduct is, in the Panel’s view, sufficient to show that the Respondent not only knew of the Complainant and its trademarks, but intentionally intended to impersonate the latter and divert internet users accordingly.

The Panel finds that the Respondent’s use of the disputed domain name constitutes a disruption of the Complainant’s business and qualifies as bad faith registration and use under the Policy.

The Panel finds the third element of the Policy 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 <bclpiaw.com> be transferred to the Complainant.

/Tommaso La Scala/

Tommaso La Scala

Sole Panelist

Date: January 31, 2024