

ADMINISTRATIVE PANEL DECISION

Greenberg Traurig, LLP v. Abbas Surgi and Privacy Protect,
My Domain Provider
Case No. D2024-0021

1. The Parties

The Complainant is Greenberg Traurig, LLP, United States of America (“U.S.”), internally represented.

The Respondents are Abbas Surgi, U.S., and Privacy Protect, My Domain Provider, Netherlands (Kingdom of the).

2. The Domain Name and Registrar

The disputed domain name <gtlew.com> is registered with INWX GmbH & Co. KG (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 4, 2024. On January 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Also on January 5, 2024, the Registrar transmitted by email to the Center its verification response disclosing the registrant as “Privacy Protect, My Domain Provider”, 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 January 8, 2024, 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 12, 2024.

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 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 6, 2024.

On January 18, 2024, a third-party privacy proxy provider contacted the Center, copying the Complainant, disclosing the underlying registrant details behind the privacy service, “Abbas Surgi”. The Center forwarded

the Notification email with all the annexes to the email address disclosed by the third-party privacy proxy provider. The Complainant submitted a second amended Complaint on January 23, 2024, identifying both "Privacy Protect, My Domain Provider" and "Abbas Surgi" as Respondents.

The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on February 7, 2024.

The Center appointed Edoardo Fano as the sole panelist in this matter on February 9, 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.

The Panel has not received any requests from the Complainant or the Respondents regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), "to employ reasonably available means calculated to achieve actual notice to [the] Respondent". Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules and the Supplemental Rules and without the benefit of a response from the Respondents.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is Greenberg Traurig, LLP, a U.S. law firm operating in the legal field all over the world, and owning several trademark registrations for GT, among which:

- International Trademark Registration No. 1238079, registered on February 2, 2015 based on the U.S. Trademark Application No. 86488061 and extended, among other countries, to the European Union.
- U.S. Trademark Registration No. 4,790,133, registered on August 11, 2015.

The Complainant also operates on the Internet, its official website being "www.gtlaw.com".

The Complainant provided evidence in support of the above.

According to the WhoIs records, the disputed domain name was registered on December 12, 2023, and it directs to an inactive website. However, on December 12 and 15, 2023, the Respondent used an email address associated with the disputed domain name to send emails to a Complainant's client, impersonating a Complainant's attorney and attempting to get the Complainant's client to send funds to a fraudulent bank account.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant states that the disputed domain name is confusingly similar to its trademark GT, as the disputed domain name wholly contains the Complainant's trademark with the addition of the term "lew" as a misspelled version of the term "law".

Further to section 6.1 below, the Complainant considers both Respondents collectively as "Respondent" and thus addresses the Respondents in the singular. The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain name or to use its trademark within the disputed domain name, it is not commonly known by the disputed domain name and it is not making either a bona fide offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. The disputed domain name was used to send emails to a Complainant's client, impersonating a Complainant's attorney and attempting to get the Complainant's client to send funds to a fraudulent bank account.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since the Complainant's trademark GT is well known in the legal field. Therefore, the Respondent targeted the Complainant's trademark at the time of registration of the disputed domain name and the Complainant contends that the use of the disputed domain name to impersonate the Complainant and disrupt the Complainant's business, qualifies as bad faith registration and use.

B. Respondents

The Respondents have made no reply to the Complainant's contentions and are in default. In reference to paragraphs 5(f) and 14 of the Rules, no exceptional circumstances explaining the default have been put forward or are apparent from the record.

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.3.

6. Discussion and Findings

6.1 Procedural issue - Multiple Respondents

The Complainant has requested to consider both Respondents, namely Abbas Surgi and the privacy service disclosed by the Registrar, Privacy Protect, My Domain Provider, collectively as "Respondent". No objection to this request was made by the Respondents.

Pursuant to the [WIPO Overview 3.0](#), section 4.4.5, "In all cases involving a privacy or proxy service and irrespective of the disclosure of any underlying registrant, the appointed panel retains discretion to determine the respondent against which the case should proceed. Depending on the facts and circumstances of a particular case, e.g., where a timely disclosure is made, and there is no indication of a relationship beyond the provision of privacy or proxy registration services, a panel may find it appropriate to apply its discretion to record only the underlying registrant as the named respondent. On the other hand, e.g., where there is no clear disclosure, or there is some indication that the privacy or proxy provider is somehow related to the underlying registrant or use of the particular domain name, a panel may find it appropriate to record both the privacy or proxy service and any nominally underlying registrant as the named respondent".

Having reviewed the record, the Panel finds it appropriate to consider both the privacy service and the underlying registrant as the named respondent. The alleged underlying registrant was only disclosed following the Notification of Complaint, requiring the added attention and second amendment of the Complaint via an unsolicited supplemental filing otherwise unwarranted in the normal course of a UDRP proceeding. Moreover, the details associated with said Respondent include false contact details, underscoring the fact that the privacy service and said false contact details were likely used with the intent of

trying to obfuscate the true underlying registrant and frustrate a proceeding such as here. The Panel further notes that the Respondents did not object to the Complainant's request. The Panel therefore accepts the Complainant's request. Hereinafter, the Panel will refer to the Respondents in the singular, *i.e.*, "the Respondent".

6.2 Substantive Issues

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (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

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 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms, here "lew", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It is also well accepted that a generic Top-Level Domain ("gTLD"), in this case ".com", is typically ignored when assessing the similarity between a trademark and a domain name. [WIPO Overview 3.0](#), section 1.11.1.

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.

While 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 often impossible 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. 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.

Having reviewed the record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the 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 disputed domain name was used to send emails to the Complainant's client, impersonating one of the Complainant's attorney and attempting to get the Complainant's client to send funds to a fraudulent bank account.

Panels have held that the use of a domain name for illegal activity, here impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

In the present case, regarding the registration in bad faith of the disputed domain name, the reputation of the Complainant's trademark GT in the legal field is clearly established, and the Panel finds that the Respondent must have known of the Complainant, and deliberately registered the disputed domain name in bad faith, especially because the disputed domain name was used to send emails to a Complainant's client, impersonating a Complainant's attorney and attempting to get the Complainant's client to send funds to a fraudulent bank account.

Panels have held that the use of a domain name for illegal activity, here impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

As regards the current use of the disputed domain name, directing to and inactive website, Panels 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. Having reviewed the record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3. Having reviewed the record, the Panel notes the reputation of the Complainant's trademark in the legal field, the composition of the disputed domain name, the Respondent's utilization of not only a privacy service but also false underlying contact details in an apparent attempt to frustrate a proceeding such as this, and the failure of the Respondent to submit a response, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Furthermore, the Panel considers that the nature of the inherently misleading disputed domain name, which includes the Complainant's trademark in its entirety with the mere addition of the term "lew" as a misspelled version of the term "law" (being almost identical to the Complainant's domain name <gtlaw.com> and official website "www.gtlaw.com"), further supports a finding of bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Panel finds that the Complainant has established 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, <gtlew.com>, be transferred to the Complainant.

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: February 13, 2024