

ADMINISTRATIVE PANEL DECISION

Slates Harwell LLP v. Name Redacted

Case No. D2024-0595

1. The Parties

The Complainant is Slates Harwell LLP, United States of America (the “United States”), represented by Colbie Brazell Campbell, United States.

The Respondent is Name Redacted.¹

2. The Domain Name and Registrar

The disputed domain name <slatesharwell.com> (the “Domain Name”) is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 8, 2024. On February 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 9, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name that differed from the named Respondent (Redacted For Privacy / Tucows Domains Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 12, 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 amendment to the Complaint on February 17, 2024.

The Center verified that the Complaint together with the amendment to the 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”).

¹The Respondent appears to have used the name of a third party when registering the Domain Name. In light of the potential identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the Domain Name, which includes the name of the Registrant disclosed by the Registrar. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding and has ordered that Annex 1 to this decision not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 12, 2024. The Respondent did not submit a response. Accordingly, the Center notified the Respondent's default on March 13, 2024.

The Center appointed A. Justin Ourso III as the panelist in this matter on March 19, 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, an American limited liability partnership law firm in Dallas, Texas, United States, has provided legal services, particularly construction contract preparation and negotiation, construction litigation, and trademark services, since its founding in 2013. The Complainant claims unregistered trademark rights in SLATES HARWELL.

The Complainant registered the domain name <slatesharwell.com> on June 11, 2013, which it uses for its public-facing web site at "www.slatesharwell.com." On its site, the Complainant uses SLATES HARWELL as a word mark and, together with a design element, in a composite figurative mark. The firm also uses the domain name for its email addresses and for its email communications, internally and with the public.

The Respondent registered the Domain Name on January 31, 2024, without any authorization from the Complainant, and has used the Domain Name for email communications with a client of the Complainant. At the filing of the Complaint, the Domain Name resolved to a web page maintained by the Registrar's reseller, Zoho Corporation PVT Ltd, that offered its services to build a web site for the business of the Domain Name holder, and included an advertisement for services offered by Zillum Consultants, a business consultancy. Cf. *Ropes & Gray LLP v. Contact Privacy Inc. Customer 0158624574-Admin NA, Ropes Gray*, WIPO Case No. [D2020-2376](#) (complaint filed by law firm; web site to which the domain name resolved maintained by reseller, Zoho, and advertised Zillum Consultants; panel found the "domain name has been used by the Respondent as part of a business email scheme to facilitate wire transfer fraud impacting one of the Complainant's clients which constitute evidence of bad faith"). During the preparation of this decision an attempt to access the web site resulted in a browser message warning that "**Your connection isn't private.** Attackers might be trying to steal your information [...] (for example, passwords, messages, or credit cards)."

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 Domain Name.

Notably, the Complainant contends that its SLATES HARWELL mark is a distinctive identifier that consumers associate with its legal services; the Domain Names is virtually identical to its mark, with the exception of the transposition of two adjacent letters, "a" and "r" and is confusingly similar to its mark; the transposition is an intentional misspelling; the Respondent is not making any legitimate noncommercial or fair use of the Domain Name; and the Respondent has fraudulently spoofed email addresses in emails to a client of the Complainant, using the Domain Name to impersonate its controller in an attempt to misdirect payment of invoices for its legal services.

B. Respondent

The Respondent did not submit a response to the amended Complaint.

6. Discussion and Findings

A complainant must prove three elements to obtain relief: (i) the domain name is identical or confusingly similar to a trademark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in the domain name; and (iii) the respondent registered and is using the domain name in bad faith. Policy, paragraph 4(a).

A. Identical or Confusingly Similar

On the first element, to support a claim of unregistered (sometimes referred to as “common law”) trademark rights, a complainant must show that its mark has acquired a distinctiveness that consumers associate with the complainant’s services. That this acquired distinctiveness “may only exist in a particular geographical area or market niche does not preclude the complainant from establishing trademark rights.” WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.3.

“Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning.” *Id.* Relevant evidence includes: (1) the duration and nature of use of the mark, (2) the amount of sales under the mark, (3) the nature and extent of advertising using the mark, (4) the degree of actual public (*e.g.*, consumer, industry, media) recognition, and (5) consumer surveys. *Id.*

The Complainant has alleged that it has used its mark SLATES HARWELL since its founding in 2013, including on its web site at “[www.slatesharwell.com](#)”; the mark is distinctive; and consumers associate the mark with the Complainant. The Complainant has not offered any evidence of the nature of its use of the mark, apart from its web site. The Complainant has not offered any particular evidence that consumers associate the mark with the Complainant, apart from the Complainant’s long use of the mark, including on its web site. The Complainant has not offered any evidence of sales under the mark. The Complainant has also not offered any other form of evidence to demonstrate acquired distinctiveness.

In the Panel’s view, the mark is capable of acquiring distinctiveness. Although the duration of the Complainant’s use of its mark, including on its web site, may not be sufficient to establish unregistered trademark rights taken by themselves, other evidence of acquired distinctiveness exists. The Complainant has alleged and proven these other important facts: (1) the Respondent has typosquatted on the Domain Name by transposing two adjacent letters; and (2) the Respondent has targeted a client of the Complainant with a series of phishing emails in which the Respondent has spoofed the email addresses of the Complainant’s personnel and impersonated its controller in an attempt to fraudulently misdirect payment of invoices for its legal services. These facts, namely, the typosquatting and the targeting, are sufficient evidence that the Complainant’s unregistered trademark has acquired recognition as a source identifier. Together with the Complainant’s long use of its mark on its web site, *inter alia*, they establish the Complainant’s unregistered trademark rights. [WIPO Overview 3.0](#), section 1.3 (“[T]hat a respondent is shown to have been targeting the complainant’s mark may support the complainant’s assertion that its mark has achieved significance as a source identifier.”); and *NTM Engineering, Inc. v. Registration Private, Domains by Proxy, LLC, DomainsByProxy.com / James Priya NA*, WIPO Case No. [D2019-0434](#).

The Panel finds that the Domain Name is confusingly similar to the Complainant’s unregistered trademark. The trademark is readily recognizable within the Domain Name. [WIPO Overview 3.0](#), sections 1.7 and 1.8.

Accordingly, the Panel concludes that the Complainant has proven the first element: the Domain Name is confusingly similar to a trademark in which it has rights.

B. Rights or Legitimate Interests

The Respondent has not claimed the existence of any circumstance under the Policy, paragraph 4(c), that demonstrates that a respondent has rights to, or legitimate interests in, a domain name. The Complainant, on the other hand, has shown that it established its trademark rights before the Respondent registered the Domain Name; it has not authorized the Respondent to use its trademark; the record contains no evidence that the Respondent is commonly known by the Domain Name; and the Respondent is passively holding the Domain Name, which does not resolve to a functioning site, and which is not a bona fide commercial use, a noncommercial use, or a fair use of the Domain Name. These constitute prima facie a showing that the Respondent lacks any rights or legitimate interests in the Domain Name under the Policy, paragraph 4(a)(ii), shifting the burden of production on this second element to the Respondent to come forward with relevant evidence proving rights or legitimate interests in the Domain Name. [WIPO Overview 3.0](#), section 2.1. The Respondent has not submitted any evidence to rebut the prima facie showing.

Additionally, the Respondent masked its identity by using a privacy service; the name of the Respondent identified by the Registrar does not resemble the Domain Name and the email address for the Respondent does not resemble the Domain Name, which corroborate that the Respondent is not commonly known by the Domain Name; the Respondent provided an incorrect address to the Registrar; and the Respondent failed to provide any evidence of an actual or a planned bona fide commercial use, a noncommercial use, or a fair use of the Domain Name, or even to respond to the Complaint. [WIPO Overview 3.0](#), sections 2.13.2 and 2.5.3.

More importantly, the Panel finds that the Complainant has proven that the Respondent has impersonated the Complainant's controller in an attempt to fraudulently misdirect payment of invoices for its legal services. Panels have held categorically that use of a domain name for impersonation to perpetrate a fraud can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.

Accordingly, the Panel concludes that the Complainant has proven the second element: the Respondent lacks rights or legitimate interests in the Domain Name.

C. Registered and Used in Bad Faith

The Respondent's impersonation of the Complainant's controller in an attempt to perpetrate a fraud by misdirecting the payment of invoices for the Complainant's legal services is per se illegitimate activity and a bad faith use of the Domain Name. [WIPO Overview 3.0](#), sections 3.1.4 and 3.4. This finding compels the Panel's conclusion that the Respondent (1) intentionally registered the Domain Name in bad faith to impersonate the Complainant and (2) used it in bad faith to impersonate the Complainant. [WIPO Overview 3.0](#), sections 3.1, 3.1.4, and 3.4. The findings that the Respondent engaged in typosquatting, used a privacy service, provided false contact information, and failed to submit a response to the Complaint support the conclusion of bad faith. [WIPO Overview 3.0](#), sections 3.2.1 and 3.6.

Accordingly, the Panel concludes that the Complainant has proven the third element: the Respondent registered and is using the Domain Name 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 Domain Name <slateshrawell.com> be transferred to the Complainant.

/A. Justin Ourso III/

A. Justin Ourso III

Panelist

Date: April 2, 2024