

ADMINISTRATIVE PANEL DECISION

Hovey Williams LLP v. yzidro lago, lago estates Inc
Case No. D2024-1116

1. The Parties

The Complainant is Hovey Williams LLP, United States of America (“United States”), internally represented.

The Respondent is yzidro lago, lago estates Inc, Mexico.

2. The Domain Name and Registrar

The disputed domain name <hoveywilliams.com> (the “Domain Name”) is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 14, 2024. On March 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 15, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 9, 2024.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on April 12, 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 is a boutique law firm specializing in intellectual property, including but not limited to trademarks, copyrights, trade secrets, and patents. The Complainant provides a wide array of legal services to clients to help them protect their intellectual property in the United States and globally.

The Complainant claims common law rights in the HOVEY WILLIAMS trademark. The Complainant has used this trademark since at least as early as 2003 in connection with its legal services. For a few decades prior 2003, the Complainant's trade name was Hovey Williams Timmons and Collins, which also included the HOVEY WILLIAMS unregistered trademark.

The Complainant is also the owner of the domain name <hoveywilliams.com> incorporating the HOVEY WILLIAMS unregistered trademark.

On March 8, 2024, the Complainant filed an application No. 98441004 with the United States Patent and Trademark Office for the registration of the HOVEY WILLIAMS trademark.

The Domain Name was registered on February 27, 2024.

The Domain Name has been used to send out fraudulent emails impersonating the Complainant's employee. At the time of submitting the Complaint and as of the date of this Decision, the Domain Name has resolved to an inactive website.

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.

First, the Complainant submits that the Domain Name is confusingly similar to the trademark in which the Complainant has rights.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Name.

Third, the Complainant contends that the Domain Name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The requested remedy may only be granted if the above criteria are met. At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”. See section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

A. Identical or Confusingly Similar

Under the first element, the Complainant must establish that the Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights.

The Complainant relies on its common law rights in the HOVEY WILLIAMS trademark. It is constant that the term “trademark or service mark” as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered trademarks. See section 1.1 of the [WIPO Overview 3.0](#). To establish unregistered or common law trademark rights for purposes of the UDRP, the Complainant must show that its trademark has become a distinctive identifier which consumers associate with the Complainant’s goods and/or services. See section 1.3 of the [WIPO Overview 3.0](#).

The Panel considers that the Complainant demonstrated such acquired distinctiveness. In this regard, the Panel notes that the Complainant has used and advertised its legal services using the HOVEY WILLIAMS trademark since at least 2003. For a few decades prior 2003, the Complainant has also operated under the trade name including the HOVEY WILLIAMS trademark. In consequence, the Panel concludes that the Complainant has common law trademark rights in the HOVEY WILLIAMS trademark for purposes of the UDRP. The fact that a respondent is shown to have been targeting the complainant’s mark (e.g., based on the manner in which the related website is used) may support the complainant’s assertion that its mark has achieved significance as a source identifier. See section 1.3 of the [WIPO Overview 3.0](#). The Domain Name has been used to send out fraudulent emails impersonating the Complainant’s employee, in which the Respondent used the Complainant’s name and contact details in the email signature. Such use confirms the Panel’s finding.

The Domain Name consists of a misspelling of the HOVEY WILLIAMS trademark. One letter “l” has been deleted in the word “williams”. As numerous UDRP panels have held, a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered to be confusingly similar to the relevant mark. See section 1.9 of the [WIPO Overview 3.0](#).

The Top-Level Domain “.com” in the Domain Name is viewed as a standard registration requirement and as such is typically disregarded under the first element test. See section 1.11.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Name is confusingly similar to the Complainant’s HOVEY WILLIAMS trademark for purposes of the Policy. Thus, the Complainant has satisfied the requirements under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element, the Complainant must prove that the Respondent has no rights or legitimate interests in the Domain Name.

The Respondent may establish rights or legitimate interests in the Domain Name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made 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 prior to the dispute; or
- (ii) that it is commonly known by the Domain Name, even if it has not acquired any trademark rights; or

(iii) that it 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.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence on record that the Complainant's HOVEY WILLIAMS unregistered trademark predates the Respondent's registration of the Domain Name. There is no evidence in the case record that the Complainant has licensed or otherwise permitted the Respondent to use the HOVEY WILLIAMS trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it results from the evidence on record that the Respondent does not make use of the Domain Name in connection with a bona fide offering of goods or services, nor does it make a legitimate noncommercial or fair use of the Domain Name. On the contrary, at the time of submitting the Complaint and as of the date of this Decision, the Domain Name has resolved to an inactive website. Moreover, the Complainant has been informed by its client that the Domain Name was used for email addresses to impersonate the Complainant in a phishing scheme. As a result of the phishing communications, the Complainant's client was induced to make a significant payment to the Respondent, which was ultimately not concluded. Such use of the Domain Name does not confer rights or legitimate interests on the Respondent.

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Name. Thus, there is no evidence in the case file that refutes the Complainant's prima facie case. The Panel concludes that the Complainant has also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under the third element, the Complainant must prove that the Domain Name has been registered and is being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1 of the [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the Complainant's unregistered rights in the HOVEY WILLIAMS trademark predate the registration of the Domain Name. The Panel finds that the Respondent was or should have been aware of the Complainant's trademark at the time of registration. This finding is supported by the content of the emails sent from the Domain Name which impersonate the Complainant and its employee. Moreover, it has been proven to the Panel's satisfaction that the Complainant's HOVEY WILLIAMS trademark is unique to the Complainant. Thus, the Respondent could not ignore the reputation of services under this trademark.

Furthermore, the Complainant submitted evidence that the Domain Name has been used for an email scam. The Respondent clearly intended for the Domain Name to be confused with the Complainant's HOVEY WILLIAMS trademark, as the emails sent from the Domain Name mimic the emails sent by the Complainant's employee. This serves as an evidence that the Respondent registered and then used the Domain Name to perpetrate an email scam or phishing scheme. The Domain Name does not appear to have been registered for any other purpose. The use of a confusingly similar, deceptive domain name for an email scam has previously been found by panels to be sufficient to establish that a domain name has been registered and is being used in bad faith. See *Samsung Electronics Co., Ltd. v. Albert Daniel Carter*, WIPO Case No. [D2010-1367](#).

For the reasons discussed above, the Panel finds that the Complainant has satisfied the requirements under paragraph 4(a)(iii) 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 Domain Name <hovewilliams.com> be transferred to the Complainant.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: April 16, 2024