

## **ADMINISTRATIVE PANEL DECISION**

Nelson Mullins Riley & Scarborough LLP v. Skill Lab, Skilllab  
Case No. D2024-1257

### **1. The Parties**

The Complainant is Nelson Mullins Riley & Scarborough LLP, United States of America, internally represented.

The Respondent is Skill Lab, Skilllab, United Arab Emirates.

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

The disputed domain name <nelsonmullins.com> is registered with GMO Internet Group, Inc. d/b/a Onamae.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 22, 2024. On March 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 26, 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 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 16, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 17, 2024.

The Center appointed James Bridgeman SC as the sole panelist in this matter on April 18, 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 law firm that practices under the style and title NELSON MULLINS RILEY & SCARBOROUGH and NELSON MULLINS.

The Complainant has an established international reputation. In 2023 it was ranked 68th in the AmLaw 200 rankings and as the 84th highest grossing law firm in the world in the 2023 Global 200 survey.

The Complainant is the registered owner of the following service mark registrations:

- United States of America registered service mark NELSON MULLINS RILEY & SCARBOROUGH LLP registration number 3,757,228, registered on the Principal Register on March 9, 2010, for services in international class 45;
- United States of America registered service mark NELSON MULLINS, registration number 3,754,391, registered on the Principal Register on March 2, 2010, for services in international class 45: Legal services;
- United States of America registered service mark NELSON MULLINS (stylized) registration number 5,361,314, registered on the Principal Register on December 19, 2017, for services in international class 45.

Furthermore, the Complainant has an established Internet presence and it has owned and used the domain name <nelsonmullins.com> registered since April 12, 1997 and historical records of use by the Complainant as its website address since November 25, 2010.

The disputed domain name <nelsonmullins.com> was registered on February 26, 2024, and it appears that there was an earlier registration on November 14, 2019. There is no evidence on record of there being any website associated with the disputed domain name, however it has been used to establish an email account from which the Respondent has sent out phishing emails purporting to impersonate the Complainant to defraud Complainant's clients.

There is no information available about the Respondent, except for that provided in the Complaint, the Registrar's Whois and the information provided by the Registrar in response to the request by the Center for details of the registration of the disputed domain name for the purposes of this proceeding.

#### **5. Parties' Contentions**

##### **A. The Complainant**

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

The Complainant claims rights in the NELSON MULLINS mark established by its ownership of the service mark registrations described above and extensive use of the mark in its law practice over many years.

Since at least as early as 1987 and 1999, respectively, the Complainant adopted and has extensively and continuously used the style and title NELSON MULLINS RILEY & SCARBOROUGH and NELSON MULLINS service marks in connection with the marketing, advertising, promotion, and rendering of the Complainant's legal services. It claims to now engage than 1,000 attorneys, policy advisors, and professionals across 37 offices in the United States.

The Complainant alleges that the disputed domain name is identical or confusingly similar to the NELSON MULLINS mark in which the Complainant has rights because the disputed domain name consists solely of an obvious misspelling of the Complainant's NELSON MULLINS mark nothing else.

It is submitted that panels established under the Policy have consistently held that, where as here a domain name at issue “wholly incorporates a complainant’s trademark”, it is sufficient evidence that the contested domain name is identical or confusingly similar. See, e.g., *Intesa Sanpaolo S.p.A. v. Tommy, Bartles associates*, WIPO Case No. [DCO2015-0001](#).

The Complainant next alleges that the Respondent has no rights or legitimate interests in the disputed domain name arguing that:

- to the best of the Complainant’s knowledge the Respondent is not commonly known by the disputed domain name nor by the name Nelson Mullins or the misspelling “Nelson Muliins”.
- the Complainant has not authorized the Respondent to use the NELSON MULLINS mark;
- the Respondent is not a licensee of the NELSON MULLINS mark;
- the Respondent does not have any connection or affiliation with the Complainant;
- the Respondent has not made a bona fide use of the disputed domain name nor engaged in any demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services.

The Complainant refers to a copy of a redacted email correspondence, exhibited in an annex to the Complaint, which shows that the Respondent has used the disputed domain name to create an email address. The email address was then used to perpetrate a phishing scam by sending a message to one of the Complainant’s clients. In the email correspondence the Respondent impersonated one of the Complainant’s employees, a billing assistant, as well as one of the Complainant’s partners. This occurred after hacking into the client’s email server, when a chain of messages was intercepted, presenting the Respondent with the opportunity to create a new set of false communications. The Respondent convinced the client to wire USD 7,500 to satisfy a supposed legal bill.

The Complainant submits that it is well accepted that such a phishing scam cannot be considered a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name.

The Complainant argues that the Respondent knew of and intentionally chose to register the disputed domain name, which is a virtually identical misspelling of the Complainant’s NELSON MULLINS mark. See *Independent Health Association Inc. v. Registration Private, Domains By Proxy, LLC / [K. A.]*, WIPO Case No. [D2016-1625](#) (phishing attack involving impersonation of the Complainant as part of an employment scam).

The disputed domain name was intentionally chosen and registered to capitalize on the Complainant’s reputation and has been used to carry out a business email compromise (“BEC”) attack by the Respondent against the Complainant’s client, as illustrated by the messages in abovementioned exhibited email correspondence. See *BHP Billiton Innovation Pty Ltd v. Domains By Proxy LLC / Douglass Johnson*, WIPO Case No. [D2016-0364](#) (“[T]he use of an email address associated with the disputed domain name, to send a phishing email for the purposes of dishonest activity is in itself evidence that the disputed domain name was registered and is being used in bad faith.”).

Prior panels have found such use of a disputed domain name constitute registration and use of the disputed domain name in bad faith. See *Halliburton Energy Services, Inc. v. Gregory Wilson / Infotech Ltd.*, WIPO Case No. [D2017-0956](#) (“Sent on the very day the disputed domain name was registered and incorporating the disputed domain name in the address”; bad faith found).

## **B. The 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 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 Complainant has established unregistered trademark or service mark rights for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.3.

The Panel finds the mark is recognizable 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 1.9.

The disputed domain name <nelsonmullins.com> consists of the Complainant's NELSON MULLINS mark in its entirety, albeit with the name "Mullins" misspelled with a double letter "i" instead of the double letter "l" and the generic Top Level Domain ("gTLD") extension ".com". The Complainant's mark is clearly recognizable as the initial and dominant element in the disputed domain name.

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 the 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 the 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.

Having reviewed the available 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.

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: phishing by impersonation can never confer rights or legitimate interests on the 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegal activity here claimed as applicable to this case: phishing by impersonation 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.

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 <nelsonmuliins.com> be transferred to the Complainant.

*/James Bridgeman SC/*

**James Bridgeman SC**

Sole Panelist

Date: April 24, 2024