

ADMINISTRATIVE PANEL DECISION

Morrison & Foerster LLP v. Singh maneesh, Prestige Imports LLC
Case No. D2024-3263

1. The Parties

Complainant is Morrison & Foerster LLP, United States of America (“United States”), represented internally.

Respondent is Singh maneesh, Prestige Imports LLC, United States.

2. The Domain Name and Registrar

The disputed domain name <mofo-us.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 August 8, 2024. On August 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 9, 2024, 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, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint.

The Center sent an email communication to Complainant on August 12, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on August 12, 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on August 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 8, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on September 18, 2024.

The Center appointed Lorelei Ritchie as the sole panelist in this matter on September 23, 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

Complainant is an international law firm based in the United States. For decades prior to the registration of the disputed domain name, Complainant has offered legal services under the mark MOFO. In this regard, Complainant is the owner of several registrations for the MOFO mark. These include, among others, United States Registration No. 2,481,879 (registered August 28, 2001). Complainant also owns a registration for the domain name <mofo.com> (registered October 30, 1992), which Complainant uses to communicate with prospective clients online.

The disputed domain name was registered on July 19, 2024. Although the disputed domain name does not appear to resolve to an active website, Respondent has used it to set up an email address to impersonate Complainant. Respondent has no affiliation with Complainant, nor any license to use its marks.

5. Parties' Contentions

A. Complainant

Complainant contends that (i) the disputed domain name is identical or confusingly similar to Complainant's trademarks, (ii) Respondent has no rights or legitimate interests in the disputed domain name; and (iii) Respondent registered and is using the disputed domain name in bad faith.

Specifically, Complainant contends that it owns rights to the MOFO mark, for which it owns several trademark registrations, and which Complainant uses in its own online communications. Complainant contends that Respondent has incorporated in full Complainant's MOFO mark into the disputed domain name, with only the addition of a non-source-identifying hyphen, and the geographical identifier "us". Complainant further contends that Respondent lacks rights or legitimate interest in the disputed domain name, and rather has registered and is using it in bad faith, having simply acquired the disputed domain name for Respondent's own commercial gain. In particular, Complainant asserts that Respondent has set up an email address associated with the disputed domain name, which Respondent has used in an attempt to impersonate Complainant, sending phishing emails to potential clients or business partners of Complainant, seeking sensitive personal and financial information.

B. Respondent

Respondent did not reply to 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 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. Complainant has shown rights in respect of a trademark or service mark, MOFO, for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Although the addition of other terms (here, a hyphen and the geographic indicator "us") may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not

prevent a finding of confusing similarity between the disputed domain name and Complainant's mark for purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel therefore finds that the disputed domain name is confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which 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.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. 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. Panels have held that the use of a domain name for illegal activity, including phishing activity as here, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds that Complainant has provided sufficient evidence of Respondent's lack of rights or legitimate interests in accordance with paragraph 4(a)(ii) of the Policy which Respondent has not rebutted.

C. Registered and Used in Bad Faith

There are several ways that a complainant can demonstrate that a domain name was registered and used in bad faith. As noted in Section 4, above, Respondent has set up an email address associated with the disputed domain name, which Respondent has used in a phishing attempt to impersonate Complainant. Respondent has not replied to communications regarding this proceeding. Panels have held that the use of a domain name for illegal activity constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Therefore, the Panel finds sufficient evidence that Respondent registered and used the disputed domain name in bad faith for purposes of 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 disputed domain name <mofo-us.com> be transferred to Complainant.

/Lorelei Ritchie/

Lorelei Ritchie

Sole Panelist

Date: October 7, 2024