

ADMINISTRATIVE PANEL DECISION

Ropes & Gray LLP v. THE INC, kbragrt ltd
Case No. D2024-3343

1. The Parties

The Complainant is Ropes & Gray LLP, United States of America, represented internally.

The Respondent is THE INC, kbragrt ltd, United States of America.

2. The Domain Name and Registrar

The disputed domain name <ropesgry.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 14, 2024. On August 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 15, 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 (*originally-named Unknown*) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 16, 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 August 16, 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 August 20, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 9, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 10, 2024.

The Center appointed Gary Saposnik as the sole panelist in this matter on September 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, Ropes & Gray LLP, is an international law firm that was founded by John Codman Ropes and John Chipman Gray in 1865 and has been known by the name “Ropes & Gray” for over 150 years. The Complainant’s law practice has attracted substantial press attention worldwide.

The Complainant owns the ROPES & GRAY service mark, United States Registration No. 2902936, registered November 16, 2004, in connection with legal services, and provision of information in the field of law, and in connection with its ongoing business activities.

The Complainant has an active presence on the Internet, through its principal domain name <ropesgray.com>, which was registered on October 12, 1995. Each and every employee of the Complainant, including attorneys and other professionals, uses an email address with the principal domain name (e.g., firstname.lastname@ropesgray.com). As a result of its use of that website for and in connection with its legal services for more than 25 years, the Complainant is claiming acquired common law rights in ROPESGRAY.COM as a service mark.

The disputed domain name was registered on July 15, 2024, by an apparent company located in New Jersey, United States, with a listed phone number located in British Columbia, Canada, and with an email address in the “.co.uk” top level domain. The disputed domain name does not resolve to an active website. However, the Complainant alleges that the Respondent has used and appears to be continuing to use the disputed domain name in emails as part of a phishing scheme.

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 contends that the disputed domain name is confusingly similar to its ROPES & GRAY registered trademark, and its ROPESGRAY.COM common law mark. The disputed domain name incorporates the Complainant’s trademark in its entirety with the only differences being the removal of the ampersand, and the removal of a letter (“a”). Domain names with minor differences, such as the removal of an ampersand and the deletion of a letter, have been found to be confusingly similar in many cases. *Ropes & Gray LLP v. David Turcotte*, WIPO Case No. [D2017-2474](#). As a result, the disputed domain name is likely to cause confusion, to cause mistake, and to deceive as to the affiliation, connection, or association of the Respondent with the Complainant.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. There is no relationship or affiliation between the Complainant and the Respondent giving rise to any license, permission, or other right by which the Respondent could own or use any domain name incorporating the Complainant’s registered mark. The Respondent’s registration of the disputed domain name without any relationship to the Complainant or its mark itself creates a strong presumption that the Respondent lacks rights or legitimate interests in the disputed domain name. *Hanson Bridgett LLP v. Becki Lawson*, WIPO Case No. [D2023-3252](#).

Both prior to and subsequent to the date of registration, the Respondent has not used or prepared to use the disputed domain name with any bona fide offer of goods or services, has not been commonly known by the disputed domain name, and has not made any noncommercial or fair use of the disputed domain name. The disputed domain name does not appear to be in use in relation to a website.

The Respondent registered the disputed domain name 159 years after the Complainant was founded, over 25 years after the Complainant registered and commenced use of its own <ropesgray.com> domain name,

and more than 15 years after the Complainant's registration of its ROPES & GRAY mark. The Respondent's clear intent is to mislead or to deceive the Complainant's current and prospective clients, and/or to tarnish the Complainant's mark and reputation, as the Respondent has used and appears to be continuing to use the disputed domain name in emails as a part of a phishing scheme. Even though the disputed domain name presently does not resolve to an active website, this does not prevent a finding of bad faith, particularly as email addresses associated with a given domain name can be active and used maliciously even if a website is not. *Corning Incorporated v. Charlie Jang*, WIPO Case No. [D2021-4230](#); *Linklaters LLP v. WhoisGuard, Inc./David Balevic, edcc*, WIPO Case No. [D2021-0723](#).

B. 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 mark is recognizable within the disputed domain name. The Respondent merely omitted the letter "a" and ampersand in the Complainant's ROPES & GRAY mark. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. Additionally, a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. [WIPO Overview 3.0](#), section 1.9. *Ropes & Gray LLP v. David Turcotte*, WIPO Case No. [D2017-2474](#).

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 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.

The Respondent registered the disputed domain name on July 15, 2024, more than 159 years after the Complainant was founded, over 25 years after the Complainant registered and commenced use of its own <ropesgray.com> domain name, and more than 15 years after the Complainant's registration of its ROPES & GRAY mark. The Respondent has not shown any rights or legitimate interests in the disputed domain name, has not been known by, nor been authorized to use the Complainant's mark. Moreover, the Complainant

has provided evidence that the Respondent has used and appears to be continuing to use the disputed domain name in emails as part of a phishing scheme.

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 and 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, the Panel notes, as stated above, that the Respondent registered the disputed domain name, without authorization, many years after the Complainant acquired rights in the distinctive ROPES & GRAY mark. The disputed domain name is an obvious typo of a widely known mark. Additionally, by using the disputed domain name by impersonating the Complainant's employees in an email phishing scheme, clearly the Respondent's intent is to mislead or deceive the Complainant's current and prospective clients by capitalizing on or otherwise taking advantage of the likely confusion with the Complainant's mark.

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, including typosquatting, 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 also held that the use of a domain name for illegal activity here, claimed as applicable to this case: phishing, and 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.

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 <ropesgry.com> be transferred to the Complainant.

/Gary Saposnik/

Gary Saposnik

Sole Panelist

Date: September 26, 2024