

ADMINISTRATIVE PANEL DECISION

Reed Smith LLP v. Ishtvan Towt
Case No. D2024-3718

1. The Parties

The Complainant is Reed Smith LLP, United States of America (“US”), represented by Reed Smith LLP, US.

The Respondent is Ishtvan Towt, Hungary.

2. The Domain Name and Registrar

The disputed domain name <reedsmithkz.online> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 13, 2024. On September 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 13, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 13, 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 September 17, 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 September 20, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 11, 2024.

The Center appointed Shwetaree Majumder as the sole panelist in this matter on October 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 global law firm. The Complainant holds various trademark registrations in multiple jurisdictions for REED SMITH and REED SMITH RICHARDS BUTLER, details of a few of such registrations are as below:

- US Registration No. 1293150 for REED SMITH, registered on September 04, 1984,
- European Union Registration No. 002212405 for REED SMITH, registered on April 29, 2005,
- European Union Registration No. 006554158 for REED SMITH RICHARDS BUTLER, registered on June 09, 2009,
- Kazakhstan Registration No. 74663 for REED SMITH, registered on August 23, 2021.

The Complainant owns several domain names that contain the Reed Smith name and REED SMITH marks, which are mentioned in Annex 11 to the Complaint.

Under the disputed domain name <reedsmithkz.online> Respondent is hosting a website trying to impersonate the Complainant, promoting fraudulent legal services and consultation. The disputed domain name was registered on April 05, 2024. The Respondent has used the below mark on its website.



5. Parties' Contentions

A. Complainant

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

Notably, the Complainant contends that the disputed domain name is confusingly similar to its REED SMITH marks. The Complainant argued that the disputed domain name resolved to a website that mirrored substantial portions of Complainant's website located at "www.reedsmith.com". The website not only featured the Reed Smith name and logo, but also verbatim copies of Reed Smith's slogan – Driving Progress through Partnership. This is likely to divert traffic away from the Complainant's actual website and the Respondent has used the disputed domain name (and perhaps associated email addresses) to impersonate the Complainant to promote fraudulent legal services and consultations, and carry out a phishing scheme to try and deceive consumers into disclosing sensitive information under false pretenses.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name, since it has never licensed or authorized Respondent to use its name or the REED SMITH marks, or to register any domain name incorporating its name or marks. The Complainant further alleged that the Respondent has not used the disputed domain name prior to Complainant's adoption and use of the REED SMITH marks which dates to 1902. The Complainant also alleges that there is no evidence to show that the Respondent is or has been known by the name "Reed Smith" and there are no legitimate websites associated with the disputed domain name that provide any information about the Respondent.

The Complainant asserts that the Respondent has registered the disputed domain name in bad faith and alleged several reasons, including that the Respondent knew about the Complainant's rights in the Reed Smith name and marks; that the Respondent used the disputed domain name to impersonate the

Complainant intentionally to attract commercial gains and carry out phishing activities; that the Respondent registered the disputed domain name using a privacy service.

B. Respondent

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

6. Discussion and Findings

As per paragraph 5(e) of the Rules where a Respondent does not submit a response, in the absence of exceptional circumstances, the panel may decide the dispute based upon the Complaint. The Panel does not find any exceptional circumstances in this case preventing it from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a response. As per paragraph 14(b) of the Rules, where a party does not comply with any provision of the Rules, the Panel may draw such inferences as it considers appropriate. It remains incumbent on the Complainant to make out its case in all respects under paragraph 4(a) of the Policy.

Under paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements required under by a preponderance of evidence:

- i. the disputed 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 respect of the disputed domain name; and
- iii. the disputed domain name has been registered and is being used in bad faith.

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 entirety of the mark is reproduced 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 1.7.

The Panel notes that the only difference between the disputed domain name and the REED SMITH mark is the addition of the letters "kz", which is the ISO country code and two letter country code top level domain abbreviation corresponding to Kazakhstan. Incorporation of letters "kz" does not prevent a finding of confusing similarity. [WIPO Overview 3.0](#), section 1.8. To this the Complainant has cited *LEGO Juris A/S v. pcrmaniabg, Paisiy Aleksandrov*, WIPO Case No. [D2010-1965](#); *eBay Inc. v. David Sach*, WIPO Case No. [D2009-1083](#); *Samsung Electronics, Co., Ltd. v. Maksim*, WIPO Case No. [D2010-1274](#) and *Columbia Pictures Industries, Inc. v. Caribbean Online Int'l Ltd.*, WIPO Case No. [D2008-0090](#).

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 disputed 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 to 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.

The Panel agrees with the Complainant that they never licensed or authorized the Respondent to use their REED SMITH marks. The Complainant also alleges that there is also no evidence that Respondent is using or preparing to use the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services or making a legitimate noncommercial or fair use of the disputed domain name within the meaning of Paragraph 4(c)(i) or (iii) of the Policy. The Complainant alleges that the Respondent has exclusively used the disputed domain name to impersonate the Complainant which is insufficient to establish rights or legitimate interests in the disputed domain name. To this the Complainant has cited *Advance Magazine Publishers Inc. v. Contact Privacy Inc. / Julia Burns*, WIPO Case No. [D2015-0617](#). The Complainant also alleges that there is no evidence that Respondent is or has ever been known by the name “Reed Smith”.

Panels have held that the use of a domain name for illegitimate activity of impersonation / passing off can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

In the absence of a response from the Respondent and its failure to counter the allegations of the Complainant, the Panel cannot see how the Respondent can have rights or legitimate interests in the disputed domain name.

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 that the Respondent registered the disputed domain name which was confusingly similar to that of the Complainant’s REED SMITH marks and mirrored the Complainant’s website “www.reedsmith.com”, intentionally attempted to divert traffic away from the Complainant’s actual website.

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 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 <reedsmithkz.online> be transferred to the Complainant.

/Shwetasree Majumder/

Shwetasree Majumder

Sole Panelist

Date: November 1, 2024