

## **ADMINISTRATIVE PANEL DECISION**

Kilburn & Strode LLP v. Md Hoque  
Case No. D2024-3925

### **1. The Parties**

The Complainant is Kilburn & Strode LLP, United Kingdom, internally represented.

The Respondent is Md Hoque, United States of America (“United States”).

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

The disputed domain name <kilburntrode.com> is registered with IONOS SE (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 23, 2024. On September 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 26, 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 (TBC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 27, 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 amended Complaints on September 27, 2024 and October 7, 2024.<sup>1</sup>

The Center verified that the Complaint together with the amended Complaints 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 October 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 30, 2024.

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<sup>1</sup>The Complainant removed two domain names from the proceeding upon receipt of the Center email of multiple underlying registrants.

The Center appointed Mihaela Maravela as the sole panelist in this matter on November 5, 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**

According to information in the Complaint, the Complainant is a limited liability partnership incorporated in England, United Kingdom. The Complainant's business was founded in England in 1906 by Bertram Edward Dunbar Kilburn and a few years later in 1913, he was joined by Captain Maurice Strode where they combined their surnames to establish the name and partnership Kilburn & Strode. Over the last century, the Complainant business has grown significantly and is now recognised as a leading United Kingdom and European intellectual property law firm. Its head office is in London, United Kingdom, with further offices in the Netherlands (Kingdom of the) and United States. The Complainant is currently ranked Tier 1 for patent and trademark attorney firms in the United Kingdom in the globally recognised Legal 500 and Chambers and Partners legal directories.

The Complainant is the exclusive owner of a number of registered trademarks consisting of KILBURN & STRODE including the United Kingdom trademark No. 1278335 KILBURN & STRODE registered as of October 22, 1990 in classes 35 and 42, and the European Union trademark No. 81380 KILBURN & STRODE registered as of May 26, 1998 in class 42. Also, the Complainant has registered the domain name <kilburnstrode.com>, which it uses as its official website.

The disputed domain name was registered on September 16, 2024 and it does not resolve to an active content. According to evidence with the Complaint, the disputed domain name was used for sending emails requesting payment of fake invoice from the Complainant's clients.

#### **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 highly similar to the Complainant's trademarks and domain name. The disputed domain name differs only insofar as one letter, in that it does not contain the letter "s" at the beginning of the name "Strode". The ampersand (&) is not a valid character in domain names, so its exclusion in the disputed domain name should not have bearing on the comparison of the core distinctive elements.

As regards the second element, the Complainant argues that it has not licensed or otherwise permitted the Respondent to use its trademarks or anything similar thereto in the disputed domain name. Further, the Respondent has chosen a similar domain name by adopting the Complainant's KILBURN & STRODE trademarks as part of the disputed domain name to commit fraud for its own financial gain. The Respondent is using the disputed domain name for email addresses to contact third parties seeking payment for fake outstanding invoices. The Respondent is purporting to be employees of the Complainant business by using the names of actual employees and has created fake outstanding invoices bearing the Complainant's KILBURN & STRODE branding. As such, one email to a third-party (incorrectly) claims it is from a person who is part of the Debt Recovery and Resolution team at the Complainant, using the email address: [...]@kilburntrode.com. The email sign-off bears the Complainant's exact name Kilburn & Strode LLP and the URL to the Complainant's website "www.kilburnstrode.com".

With respect to the third element, the Complainant submits that its business under the KILBURN & STRODE trademark and name is highly reputed in the field of intellectual property legal services. Also, the Respondent has impersonated the Complainant's business and the Complainant's employees to commit fraud i.e., to trick individuals or businesses into making payment to them. Therefore, the Respondent would clearly have been aware of the Complainant, its success, reputation and its trademarks when it registered the disputed domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

No response has been received from the Respondent in this case. However, given that the Complaint was sent to the relevant addresses disclosed by the Registrar, the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (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 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 disputed domain name consists of the obvious misspelling of the KILBURN & STRODE trademark of the Complainant, with the removal of "s" in the second word of the disputed domain name and of the ampersand. This misspelling in the disputed domain name, also referred as typosquatting, does not prevent a finding of confusing similarity, as the trademark is recognizable in the disputed domain name. Section 1.9 of the [WIPO Overview 3.0](#).

It is well accepted by UDRP panels that a generic Top-Level Domain ("gTLD"), such as ".com", is typically ignored when assessing whether a domain name is identical or confusing similar to a trademark. See section 1.11.1 of the [WIPO Overview 3.0](#).

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.

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.

There is no evidence that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services or that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name. Rather, according to the unrebutted evidence put forward by the Complainant, the Respondent used the disputed domain name for scamming activities and such activity cannot amount to a fair use of the disputed domain name, nor can it confer any rights or legitimate interests on the Respondent. See section 2.13 of the [WIPO Overview 3.0](#).

Also, there is no evidence that the Respondent is commonly known by the disputed domain name.

By not replying to the Complainant’s contentions, the Respondent has failed to invoke any circumstances which could demonstrate any rights or legitimate interests in the disputed domain name. Accordingly, the Panel gives prevalence to the Complainant’s affirmation that it has not granted the Respondent any license to use 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.

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.

The disputed domain name was registered many years after the Complainant has obtained registration of its KILBURN & STRODE trademark. The disputed domain name consists of a misspelling of the Complainant’s trademark. The email sent from the disputed domain name uses the name of one of the Complainant’s employees. Under these circumstances, it is most likely that the Respondent was aware of the Complainant’s trademark at the registration of the disputed domain name and sought to take advantage of the KILBURN & STRODE trademark.

Furthermore, according to the un rebutted evidence submitted by the Complainant, the Respondent used the disputed domain name shortly after registration to pass off as one of the Complainant's employees, apparently as part of a phishing scam. Given such evidence, the Panel agrees with previous UDRP decisions that "the Respondent's fraudulent use of the disputed domain name, which began almost immediately after its registration, confirms the possibility that the disputed domain name was registered to conduct a 'social engineering' attack or other type of scam". For such reasons, the Panel finds that the Respondent must have been fully aware of the Complainant's trademarks and activities when it registered the disputed domain name. See, e.g., *Virgin Enterprises Limited v. Vincent Battista*, WIPO Case No. [D2018-1416](#). The use of a domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers and employees constitutes bad faith on the side of the Respondent (section 3.4 of the [WIPO Overview 3.0](#)).

In the Panel's view, these circumstances represent evidence of registration and use in bad faith of the disputed domain name. The Respondent failed to bring evidence as to the contrary.

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 <kilburntrode.com> be transferred to the Complainant.

/Mihaela Maravela/

**Mihaela Maravela**

Sole Panelist

Date: November 19, 2024