

ADMINISTRATIVE PANEL DECISION

Akerman LLP v. Evelyn Rutherford
Case No. D2024-4094

1. The Parties

Complainant is Akerman LLP, United States of America (“United States”), internally represented.

Respondent is Evelyn Rutherford, Canada.

2. The Domain Name and Registrar

The disputed domain name <akermarn.com> (the “Domain Name”) is registered with Amazon Registrar, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 5, 2024. On October 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 8, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Identity Protection Service) and contact information in the Complaint. The Center sent an email communication to Complainant on October 8, 2024 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on October 8, 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 Respondent of the Complaint, and the proceedings commenced on October 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 1, 2024.

The Center appointed Dinant T. L. Oosterbaan as the sole panelist in this matter on November 8, 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 a large United States law firm founded more than 100 years ago in Florida. Complainant now has 24 offices throughout the United States serving local, regional, national, and international clients.

Complainant owns several trademarks registered with the United States Patent and Trademark Office for AKERMAN, including the wordmark AKERMAN, US registration number 4055042 and registration date November 15, 2011.

In addition, Complainant runs since 1996 a website using the domain name <akerman.com>.

The Domain Name was registered on September 18, 2024.

The Domain Name does not resolve to an active website. The Domain Name has been used for a fraudulent scheme.

The trademark registrations of Complainant were issued prior to the registration of the Domain Name.

5. Parties' Contentions

A. Complainant

Complainant submits that the Domain is confusingly similar to Complainant's AKERMAN marks.

The Domain Name is identical to the AKERMAN marks except for the typo-squatting, i.e. the addition of a second letter "r" in the Domain Name. According to Complainant, domain names which constitute typo-squatting are confusingly similar by definition.

According to Complainant, Respondent has no rights nor any legitimate interest in the Domain Name.

Complainant asserts that Respondent uses the Domain Name for fraudulent activities. Respondent registered the Domain Name solely to impersonate Akerman and its employees and attempt to defraud both Akerman and its clients. The moment the Domain Name was registered, Respondent used the Domain Name to impersonate at least one of Complainant's partners by sending an email to Complainant's client asking for payment information. Specifically, on September 24, 2024, Respondent impersonated one of Akerman's partners using the email address "[...]@akermarn.com" to send an email with Respondent's bank information: "Hi xxx, Trust y'all had a great weekend? Attached to this email you will find our payment instructions for electronic payments. I will be traveling and won't have access to phone calls but I am available to verify this today. So if you could give me a call, I would appreciate that."

Complainant submits that if the scam had worked, the obvious next step was for payment to be diverted to Respondent based on the attached bank details.

Complainant submits that Respondent is not using the Domain Name in connection with a bona fide offering of goods or services. The only known use of the Domain Name was an attempt to defraud Complainant and its client. The Domain Name does not resolve to a website, and thus, Respondent does not sell any products or services. The sole purpose of the Domain Name is in furtherance of Respondent's attempt to defraud Complainant and its client. Fraudulent activities are obviously not bona fide offerings.

According to Complainant, Respondent registered and uses the Domain Name in bad faith.

By registering an obvious typo-squat version of Complainant's well-known trademark as its domain name and using that Domain Name to send impersonating emails for the sole purpose of defrauding Complainant and its customers, Respondent's registration and use of the Domain Name is the epitome of bad faith. As a general proposition, typo-squatting is recognized as classic bad faith. The fact that the Domain Name does not resolve to a web page does not affect the above conclusions. It is an established principle that the lack of active use of a domain name does not as such prevent a finding of bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraph 4(a) of the Policy requires that a complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (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 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 for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Domain Name incorporates the trademark AKERMAN in its entirety, with the addition of a second letter "r" in the trademark. Many UDRP panels have found that a disputed domain name is identical or confusingly similar where the relevant trademark is recognizable within the disputed domain name, especially in the case of a misspelling of complainant's trademark (i.e. typo-squatting). [WIPO Overview 3.0](#), sections 1.7 and 1.9.

The generic Top-Level Domain ".com" is disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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 Respondent may demonstrate rights or legitimate interests in the 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 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 Domain Name such as those enumerated in the Policy or otherwise.

Based on the undisputed submission and evidence provided by Complainant, as summarized above, Respondent used the Domain Name to impersonate one of Complainant’s partners by sending an email to Complainant’s client containing Respondent’s bank information. Panels have held that the use of a domain name for illegal activity such as impersonation can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. The Panel does not consider such use a bona fide offering of goods or services, nor a legitimate noncommercial or fair use of the Domain Name. Respondent is also not commonly known by the Domain Name nor has it acquired any trademark or service mark rights.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel finds that the Domain Name has been registered and is being used in bad faith. Noting the status of the AKERMAN mark and the overall circumstances of this case, the Panel finds it more likely than not that Respondent knew or should have known Complainant’s AKERMAN mark. The registration of the Domain Name in awareness of the AKERMAN mark and in the absence of rights or legitimate interests amounts under these circumstances to registration in bad faith.

In particular the Panel takes into account that previous panels have held that the use of a domain name for illegal activity, such as applicable to this case impersonation and sending deceptive emails, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

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 Domain Name, <akermarn.com>, be transferred to Complainant.

/Dinant T. L. Oosterbaan/
Dinant T. L. Oosterbaan
Sole Panelist
Date: November 15, 2024