

ADMINISTRATIVE PANEL DECISION

Nelson Mullins Riley & Scarborough LLP v. Eddied Jonnes
Case No. D2023-0952

1. The Parties

The Complainant is Nelson Mullins Riley & Scarborough LLP, United States of America (“United States”), internally represented.

The Respondent is Eddied Jonnes, United States.

2. The Domain Name and Registrar

The disputed domain name <nelsonmullinsllp.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 March 3, 2023. On March 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 3, 2023, 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 the Complainant on March 7, 2023, 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 March 7, 2023.

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 March 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 12, 2023.

The Center appointed Ezgi Baklacı Gülkökar as the sole panelist in this matter on April 13, 2023. 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 Nelson Mullins Riley & Scarborough LLP is a diversified law firm with over 1000 attorneys, policy advisors and professionals across 31 offices in 15 states. The Complainant used the NELSON MULLINS RILEY & SCARBOROUGH and NELSON MULLINS trademarks in connection with the legal services as well as marketing, advertising and promotion dating back as early as 1987 and 1999.

The Complainant holds the registered United States trademarks No. 3757228 for NELSON MULLINS RILEY & SCARBOROUGH LLP registered on March 9, 2010; No. 3754391 for NELSON MULLINS registered on March 2, 2010 and No. 5361314 for NM NELSON MULLINS (Device Mark) registered on December 19, 2017 in class 45 for Legal services.

Further, the Complainant also owns the <nelsonmullins.com> domain name which was registered on April 12, 1997 according to the extract provided at Annex 1 of the Complaint.

The disputed domain name was registered on January 26, 2023. The Respondent in this matter was initially masked by a privacy service but then was revealed to be Eddied Jonnes and the disputed domain name is stated to have been registered in furtherance of a business email compromise (“BEC”) attack directed at one of the Complainant’s clients.

5. Parties’ Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy is satisfied in the present case, as follows:

Identical or confusingly similar

The Complainant argues that the disputed domain name is confusingly similar to the NELSON MULLINS trademark which the Complaint holds registration as well as earlier use rights because it wholly incorporates its trademark. Further, the Complainant argues that the addition of LLP which stands for the abbreviation of limited liability partnership does not create a distinction as the Complainant is a limited liability partnership.

Rights or legitimate interests

The Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name as the Respondent is not known by the disputed domain name. Further, the Complainant submits that the Respondent is not authorized to use the Complainant’s trademark, nor the Respondent is the licensee of the mark.

In addition, the Complainant argues that the Respondent does not have any connection or affiliation with the Complainant; the Respondent has not made a *bona fide* use of the disputed domain name nor engaged in any demonstrable preparations to use it in connection with a *bona fide* offering of goods or services; and the Respondent’s use of the disputed domain name is used to facilitate an illegal activity and such activity can never vest rights or legitimate interests.

The disputed domain name was registered and used in bad faith

The Complainant argues that the disputed domain name was registered in bad-faith as the disputed domain name is identical to the Complainant's NELSON MULLINS trademarks. The Complainant further argues that the disputed domain name used to impersonate a partner of the Complainant to contact one of the Complainant's clients in furtherance of a phishing attack according to the extract provided at Annex 7.

In summary, the Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain name is identical or confusingly similar to the trademarks or service marks in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (ii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has demonstrated that it has well-established rights in NELSON MULLINS trademarks. Further, the Complainant also holds trademarks with the dominant elements NELSON MULLINS.

The disputed domain name <nelsonmullinsllp.com> consists of the registered trademark NELSON MULLINS with an additional element "LLP" at the end. Although the disputed domain name is not identical to the trademarks of the Complainant, the aforementioned addition do not prevent the finding of confusing similarity as the Complainant's trademark is clearly recognizable within the disputed domain name (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.8).

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks and that the first element of paragraph 4(a) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. While the overall burden of proof in UDRP proceedings is on the Complainant, previous UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible 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. 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).

As of the date of this decision, the disputed domain name does not resolve to an active website. Evidence submitted by the Complainant indicates that the disputed domain name was used in a fraudulent attempt to obtain gain from the Complainant's clients by impersonating one of the partners of the Complainant, as

noted within the Annex 7. Previous UDRP panels have categorically held that the use of a domain name for illegal activity, including impersonation or other types of fraud can never confer rights or legitimate interests on a respondent ([WIPO Overview 3.0](#), section 2.13.1). See also *Beam Suntory Inc. v. Name Redacted*, WIPO Case No. [D2018-2861](#) (April 3, 2019) (evidence of “Respondent’s illegal activity, namely, using the disputed domain name to impersonate Complainant in emails to third parties to perpetrate fraud can never confer rights or legitimate interests on a respondent”).

The Panel finds that this use of the disputed domain cannot amount to a *bona fide* offering of goods and services or a legitimate noncommercial or fair use.

Therefore, the Panel finds that the Respondent does not have rights or any legitimate interests in the disputed domain name within the meaning of Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that a complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith. Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s trademark ([WIPO Overview 3.0](#), section 3.1).

The Panel finds that at the time the disputed domain name was registered, the Respondent had undeniable knowledge of the Complainant’s trademarks NELSON MULLINS and its derivatives, as the Complainant’s trademarks are highly distinctive and unlikely to be arrived at and registered by accident. Furthermore, the inclusion of “LLP” to the disputed domain name, which is the abbreviation of the term limited liability partnership reflects that the Respondent is aware of the Complainant and its legal structure.

The disputed domain name does not resolve to an active website as of the date of this decision. However, the evidence submitted by the Complainant indicates that, the disputed domain name earlier has been used in a fraudulent attempt to obtain gain from the Complainant’s clients, by creating the misleading image that there is an affiliation with the Complainant. Such use constitutes bad faith ([WIPO Overview 3.0](#), section 3.4).

The evidence provided at Annex 7 shows that the disputed domain name was used in connection with phishing activities and demonstrates the Respondent’s bad faith under paragraph 4(b)(iv) of the Policy. See *Altria Group, Inc. Altria Group Distribution Company v. Emerson Terry*, WIPO Case No. [D2021-0045](#). See also *Nelson Mullins Riley & Scarborough LLP v. Jamie Feinmesser*, WIPO Case No. [D2020-9585](#).

The Panel finds that the Respondent’s impersonation of the Complainant by use of the trademark NELSON MULLINS in the disputed domain name to send fraudulent emails constitutes bad faith.

In the circumstances, the Panel finds that the Respondent registered and has been using the disputed domain name in bad faith, and paragraph 4(a)(iii) of the Policy has been satisfied.

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 <nelsonmullinsllp.com> be transferred to the Complainant.

/Ezgi Baklacı Gülkökar/
Ezgi Baklacı Gülkökar
Sole Panelist
Date: April 21, 2023