

ADMINISTRATIVE PANEL DECISION

Akerman LLP v. Ty Turn
Case No. D2024-0711

1. The Parties

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

Respondent is Ty Turn, United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 15, 2024. On February 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 16, 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 (Withheld for Privacy Purposes/Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to Complainant on February 19, 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 February 21, 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 February 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 13, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 14, 2024.

The Center appointed Bradley A. Slutsky as the sole panelist in this matter on March 19, 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 law firm with more than 700 lawyers and consultants across 24 offices in the United States. Complainant was founded more than 100 years ago. In 2023 Complainant was ranked by the American Lawyer as one of the top 100 law firms in the United States by gross revenue. Complainant also has received recognition from a number of other publications such as Financial Times, U.S. News, Law360 Chambers USA, and others. Complainant registered the <akerman.com> domain name on October 19, 1996. Complainant has used the AKERMAN mark since its inception and has registered the following AKERMAN marks in the United States:

- U.S. Trademark registration number 4055042, registered on November 15, 2011;
- U.S. Trademark registration number 4686778, registered on February 17, 2015;
- U.S. Trademark registration number 5752122, registered on May 14, 2019;
- U.S. Trademark registration number 5764350, registered on May 28, 2019.

The disputed domain name was registered on February 6, 2024, and does not resolve to an active website. On that same day, an email was sent from the disputed domain name – purportedly from a partner in Complainant’s law firm – seeking to change the bank account information that a client of Complainant would use to pay Complainant.

5. Parties’ Contentions

A. Complainant

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

Notably, Complainant contends that the disputed domain name is confusingly similar to Complainant’s AKERMAN trademark and that Respondent is engaging in typosquatting. Complainant also asserts that Respondent has no rights or legitimate interests in the disputed domain name, as the disputed domain name was registered more than a decade after Complainant’s registration and first use of the <akerman.com> domain name and more than a decade after Complainant first registered the AKERMAN trademark. Complainant further asserts that “[t]he sole purpose of the domain is in furtherance of Respondent’s attempt to defraud Akerman and its client. Fraudulent activities are obviously not bona fide offerings”. Complainant also asserts that such use is not a noncommercial or fair use, and that Respondent is known as Ty Turn and not by the disputed domain name. Complainant asserts that Respondent registered and is using the disputed domain name in bad faith, in that “[b]y using an obvious typo-squatting of Complainant’s well-known trademark as its domain name and using that domain to send impersonating emails for the sole purpose of defrauding [...] Akerman’s customers and [...] Akerman, Respondent’s use of the disputed domain name is the epitome of bad faith”.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

Pursuant to paragraph 15(a) of the Rules, a panel in UDRP proceedings “shall 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”.

Under paragraph 4(a) of the Policy, Complainant must prove the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

- (ii) 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 Panel finds Complainant's mark is recognizable within the disputed domain name. The disputed domain name consists of the AKERMAN trademark, except the "m" has been replaced with "rn", and the ".net" generic Top-Level Domain ("gTLD") has been appended at the end. In some fonts, "rn" looks very similar to "m", such that some people may be confused when looking at the disputed domain name and may think that it reads "akerman". "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. [...] Examples of such typos include [...] substitution of similar-appearing characters [...]." [WIPO Overview 3.0](#), section 1.9. Further, "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test". [WIPO Overview 3.0](#), section 1.11.1. The disputed domain name thus is confusingly similar to Complainant's mark for the purposes of the Policy.

Accordingly, 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 a disputed domain name. "Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [Respondent's] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to [Respondent] of the dispute, [Respondent's] use of, or demonstrable preparations 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
- (ii) [Respondent] (as an individual, business, or other organization) ha[s] been commonly known by the [disputed] domain name, even if [Respondent has] acquired no trademark or service mark rights; or
- (iii) [Respondent is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue." Policy, paragraph 4(c).

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 disputed domain name. There is no evidence of any use or demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services, or that Respondent "Ty Turn" has been commonly known by the disputed domain name, or that Respondent is making a legitimate noncommercial or fair use of the disputed 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 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, including phishing, impersonation/passing off, and other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. In a very similar case to this one, a respondent registered <akermam.com> and on the same day, the "Respondent, purporting to be one of the partners in Complainant's law firm, used the disputed domain name to send several emails to one of Complainant's clients requesting payment of invoices that Respondent had created and enclosed, and listed bank accounts for payment that were not in any way associated with Complainant". *Akerman LLP v. Withheld for Privacy Purposes, Privacy Service / Teresa Swanzy, grford*, WIPO Case No. [D2021-1120](#). The panel in that matter found, as does this Panel, that under such circumstances Respondent has no rights or legitimate interests in the disputed domain name.

Accordingly, 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. Specifically, "the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that [Respondent has] registered or [Respondent has] acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to [C]omplainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of [Respondent's] documented out-of-pocket costs directly related to the domain name; or
- (ii) [Respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [Respondent has] engaged in a pattern of such conduct; or
- (iii) [Respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, [Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [Respondent's] web site or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of [Respondent's] website or location or of a product or service on [Respondent's] website or location". Policy, paragraph 4(b).

"Given that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative, even where a complainant may not be able to demonstrate the literal or verbatim application of one of the above scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to Complainant's trademark would also satisfy Complainant's burden." [WIPO Overview 3.0](#), section 3.1.

In the present case, the Panel notes that on the same day the disputed domain name was registered, Respondent used the disputed domain name to send an email message to a client of Complainant, attempting to convince the client to pay invoices to a bank account that is not Complainant's bank account.

Respondent's typosquatting signals an intention to confuse users seeking or expecting to do business with Complainant. [WIPO Overview 3.0](#), section 3.1.4. A number of UDRP decisions have held that using a confusingly similar domain name to attempt to convince someone to send money to the wrong bank account constitutes bad faith. See, e.g., *Akerman LLP v. Withheld for Privacy Purposes, Privacy Service / Teresa Swanzy, grpord*, WIPO Case No. [D2021-1120](#); *BJ2 LLC v. Cimpres Schweiz GmbH*, WIPO Case No. [D2017-2066](#); *Pentair Flow Services AG v. Phillip Lentz, Pentair*, WIPO Case No. [D2018-0699](#). "Panels have held that [...] the respondent's use of [a] domain name to send deceptive emails, e.g., [...] to solicit payment of fraudulent invoices by the complainant's actual or prospective customers" constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds that Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

Accordingly, the Panel finds that 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 <akernan.net> be transferred to Complainant.

/Bradley A. Slutsky/

Bradley A. Slutsky

Sole Panelist

Date: April 2, 2024