

ADMINISTRATIVE PANEL DECISION

Nelson Mullins Riley & Scarborough LLP v. Registration Private, Domains By Proxy, LLC / Heather England
Case No. D2022-1404

1. The Parties

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

The Respondent is Registration Private, Domains By Proxy, LLC, USA / Heather England, USA.

2. The Domain Name and Registrar

The disputed domain name <nelsonmulins.com> (the “Domain Name”) is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 20, 2022. On that same date, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 21, 2022, the Registrar transmitted by email to the Center its verification response, which disclosed registrant and contact information for the Domain Name that differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 1, 2022, 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 May 3, 2022.

The Center verified that the Complaint together with the amended Complaint (collectively, the “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 May 4, 2022. In accordance with the Rules, paragraph 5, the due date for the Response was May 24, 2022. The Respondent did not submit any Response. Accordingly, the Center notified the Respondent’s default on May 25, 2022.

The Center appointed D. Brian King as the sole panelist in this matter on May 31, 2022. 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

A. The Parties

The Complainant is Nelson Mullins Riley & Scarborough LLP (“Nelson Mullins”), a law firm based in Columbia, South Carolina, USA. The Complainant was founded in 1897 and presently has over 800 employees across 25 offices engaged in over 100 practice areas (Annex 4 to the Complaint). The Complainant has been recognized in law firm rankings, including The American Lawyer’s ranking of the 100 top-grossing firms in the United States and The National Law Journal’s ranking of the 500 largest law firms in the United States (Annexes 5 and 6 to the Complaint).

The Respondent has not provided the Panel with information of any kind.

B. The Service Marks

The Complainant owns service marks in the USA for NELSON MULLINS RILEY & SCARBOROUGH and NELSON MULLINS (together, the “NELSON MULLINS marks”), names it has used in connection with its business since 1987 and 1999 respectively. A list of these registered marks follows (Annex 7 to the Complaint):

Trademark	USPTO Registration Number	Registration Date
NELSON MULLINS RILEY & SCARBOROUGH	3757228	March 9, 2010
NELSON MULLINS	3754391	March 2, 2010
NELSON MULLINS [stylized]	5361314	December 19, 2017

Additionally, the Complainant registered and has used the domain name <nelsonmullins.com> in connection with its business since at least April 1997 (Annex 8 to the Complaint).

C. The Domain Name

The Respondent registered the Domain Name on March 1, 2022 (Annex 1 to the Complaint). The Domain Name does not resolve to an active website, but email servers associated with it have been activated, which allows the Respondent to send emails from email accounts associated with the Domain Name (Annexes 9 and 10 to the Complaint). The Complaint contains evidence that the Respondent has attempted to engage in a business email compromise (“BEC”) attack using emails sent from the email servers associated with the Domain Name (Annex 11 to the Complaint).

5. Parties’ Contentions

A. Complainant

The Complainant first argues that the Domain Name is confusingly similar to its NELSON MULLINS marks. The Complainant states that it obtained common law rights in the marks as early as 1999 and obtained its service mark registration in 2010 — both dates that long precede the Respondent’s registration of the Domain Name in March 2022. According to the Complainant, the Domain Name wholly incorporates its marks with an obvious misspelling, being the omission of the letter “L” from the second word of the mark. The Complainant submits that domain names consisting of obvious or intentional misspellings of trademarks or service marks have consistently been found to be confusingly similar by WIPO panels.

The Complainant next argues that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Complainant represents that it has not authorized the Respondent to use the NELSON MULLINS marks, and that the Respondent has no affiliation with the Complainant. The Complainant further submits that the Respondent used the Domain Name to carry out a BEC attack, and that illicit activity of this kind cannot confer any rights or legitimate interests on the Respondent.

Finally, the Complainant argues that the Domain Name was registered and is being used in bad faith. The Complainant submits that a panel may make a finding of bad faith on the basis of circumstances other than those enumerated in paragraph 4(b) of the Policy. The Complainant says that in this case, on the very same day that it registered the confusingly similar Domain Name, the Respondent used it in furtherance of a BEC scheme. According to the Complainant, this circumstance in itself evidences bad faith registration and use, and further demonstrates that the Respondent knew of the Complainant's rights in the NELSON MULLINS marks when it registered the Domain Name.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy stipulates that the Complainant must prove the following three elements in order to be successful in its action:

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

Paragraph 4(c) of the Policy sets out illustrative circumstances that could demonstrate a respondent's rights or legitimate interests in a domain name for purposes of paragraph 4(a)(ii) above.

Paragraph 4(b) of the Policy sets out illustrative circumstances that may demonstrate registration and use of a domain name in bad faith for purposes of paragraph 4(a)(iii) above.

A. Identical or Confusingly Similar

The Domain Name entirely incorporates the Complainant's NELSON MULLINS service mark, with the only differences being the omission of one "L" from the word "MULLINS" and the addition of the ".com" generic-Top Level Domain ("gTLD"). It is well established that the addition of the ".com" gTLD does not prevent a finding of confusing similarity. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11. The Panel further finds that the obvious misspelling of the Complainant's mark constitutes typo squatting, which further supports a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.9.

Accordingly, the Panel easily finds that the Complaint succeeds as to the first element of the Policy.

B. Rights or Legitimate Interests

Many prior UDRP panels have found that a complainant only needs to establish a *prima facie* case in relation to the second element of the test under paragraph 4(a)(ii) of the Policy (see, e.g., *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. [D2004-0110](#); *MatchNet plc v. MAC Trading*, WIPO Case No. [D2000-0205](#)). Once a *prima facie* showing is made, the burden of production shifts to the

respondent to demonstrate that it possesses rights or legitimate interests in respect of the domain name in dispute.

The present Panel agrees that the Complainant need only make out a *prima facie* case and finds that it has met that standard here. In the absence of any contrary evidence, the Panel accepts the Complainant's representation that the Respondent has no connection to the Complainant and has not received permission to use the Complainant's NELSON MULLINS marks. The Panel also finds no indication that the Respondent is commonly known by a name corresponding to the Domain Name.

In these circumstances, the Complainant has made out a *prima facie* case that the Respondent lacks any rights or legitimate interests in the Domain Name. The Respondent has failed to provide any contrary evidence, despite having had the opportunity to do so. The Panel accordingly finds that the Complaint succeeds as to the second element of the test under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The third element of the test under paragraph 4(a) requires proof that the Domain Name has been registered and is being used in bad faith. The Panel finds that to be sufficiently established here.

Based on the documentary evidence that the Complainant has provided, in particular in Annex 11 to the Complaint, the Panel finds it more likely than not that the Respondent used the Domain Name in connection with an attempted BEC scam. The use of a domain name for *per se* illegitimate activities such as this constitutes manifest evidence of bad faith registration and use. See [WIPO Overview 3.0](#), section 3.1.4.

On this basis, the Panel finds that the Complaint likewise succeeds as to the third element of the paragraph 4(a) test.

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, <nelsonmulins.com>, be transferred to the Complainant.

/D. Brian King/

D. Brian King

Sole Panelist

Date: June 13, 2022