

ADMINISTRATIVE PANEL DECISION

Ice Miller LLP v. Simon Henderson

Case No. D2023-0233

1. The Parties

The Complainant is Ice Miller LLP, United States of America (“United States”), represented internally.

The Respondent is Simon Henderson, Australia.

2. The Domain Name and Registrar

The disputed domain name <icermiller.com> 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 January 18, 2023. On January 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 20, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 23, 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 January 30, 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 January 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 23, 2023.

The Center appointed Torsten Bettinger as the sole panelist in this matter on March 1, 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 is a law firm based in Indianapolis, Indiana, which was founded in 1910 and adopted the name Ice Miller Donadio and Ryan in 1963.

The Complainant states, and provides documentation in support thereof, that it is the owner of the following trademark registrations:

- United States Reg. No. 2623467 for ICE MILLER (registered on September 24, 2002, for use in connection with, *inter alia*, “business consultations for private and public companies”;
- United States Reg. No. 4573643 (for ICEMILLER LEGAL COUNSEL (stylized characters) (registered on July 22, 2014) for use in connection with, *inter alia*, “Legal services for private and public companies”.

The Complainant uses the domain name <icemiller.com> as its primary domain name.

The disputed domain name was registered December 12, 2022.

The Complainant states, and provides documentation in support thereof, that the Respondent used the disputed domain name to impersonate an attorney that works for the Complainant by creating false email addresses and initiating communications with various individuals.

5. Parties' Contentions

A. Complainant

The Complainant states that it is one of the largest law firms in Indianapolis and one of the 200 largest firms in the United States employing more than 300 lawyers and 40 paraprofessionals.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant asserts the disputed domain name is visually similar to the Complainant's trademark and primary domain name, given the fact that disputed domain name simply replaces the uppercase “I” of the trademark by a lowercase “l” and adds the letter “r” in the middle of the Complainant's domain name as a lowercase “l” can be mistaken as an uppercase “I” and the letter “r” can be mistaken as an additional arch to the letter “m”.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy, the Complainant submitted that:

- the Respondent is not sponsored by or affiliated with the Complainant in any way;
- there is no evidence that the Respondent is making any legitimate noncommercial or fair use of the domain name without intent for commercial gain as there is no legitimate connection between the Respondent's use of the disputed domain name and the Complainant and their trademarks;
- the Complainant has not given the Respondent permission to use the Complainant's trademarks or business information in any manner, including domain names;
- the Complainant has never licensed or authorized the Respondent to use the Complainant's marks or name, or to register any domain name incorporating the Complainant's mark or name;
- the Respondent is not commonly known by the disputed domain name;

- the Respondent's use of the privacy protection service to conceal its true identity, in and of itself, constitutes evidence of bad faith under paragraph 4(a)(ii) of the Policy;
- the Respondent was aware of the Complainant's rights in registering the domain name the only logical conclusion is that the Respondent registered the domain name in bad faith with intent to capitalize on the Complainant's fame and reputation to initiate a fraudulent scheme by exploiting confusion created by the disputed domain name.

Finally, with regard to the disputed domain name having been registered and being used in bad faith pursuant to paragraph 4(a)(iii) of the Policy, the Complainant argues that:

- as the disputed domain name only slightly modifies the Complainant's ICE MILLER and ICE MILLER LEGAL COUNSEL trademarks, it is not possible to conceive a plausible situation in which the Respondent would have been unaware of the Complainant's brands at the time the disputed domain name was registered;
- the Respondent has used the disputed domain name to impersonate an attorney that works for the Complainant;
- the Respondent created false email addresses, impersonated an attorney, and initiated communications with various individuals;
- the Respondent took steps to ensure that their email would look legitimate by using email signature and design styles commonly employed by the Complainant's attorneys;
- the Respondent has employed a privacy service to hide its identity.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

- (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

The Complainant has demonstrated that it owns and has rights to the trademark registration for the mark ICE MILLER.

It is well-established that the test of identity or confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases (see sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

In this case, the disputed domain name contains the Complainant's trademark in its entirety and simply replaces the first letter of the Complainant's trademark "I" by a lowercase "i" and adds the letter "r" in the middle of the Complainant's trademark. This is obviously an intentional misspelling of the Complainant's trademark which does not prevent the Complainant's trademark from being recognizable within the disputed domain name, as a lowercase "i" can be mistaken as an uppercase "I" and the letter "r" can be mistaken as an additional arch to the letter "m".

Furthermore, the specific generic Top-Level Domain ("gTLD") designation such as ".com", ".net", ".org" is not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable top-level suffix may itself form part of the relevant trademark (see [WIPO Overview 3.0](#), section 1.11).

For the foregoing reasons the Panel concludes that the disputed domain name is confusingly similar to the Complainant's ICE MILLER trademark, and that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy a respondent may establish its rights or legitimate interests in the domain name, among other circumstances, by showing any of the following elements;

"(i) before any notice to you [the Respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you [the Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you [the Respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The Complainant stated that the Respondent is neither affiliated with, nor authorized by the Complainant to register and use ICE MILLER mark, and is not commonly known by the disputed domain name.

The Complainant provided evidence that the Respondent has used the disputed domain name to impersonate an attorney that works for the Complainant by creating false email addresses and initiating communications with various individuals. These submissions are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

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 disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent chose not to contest the Complainant's allegations and has failed to come forward with any evidence to refute the Complainant's *prima facie* showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts the Complainant's submissions as undisputed facts and concludes that the Respondent has used the disputed domain name for illegal purposes, which prior panels have found, can never confer rights or legitimate interests upon a respondent. See [WIPO Overview](#), section 2.13. Accordingly, the Panels finds that the Respondent lacks rights or legitimate interests in the disputed domain name and that the Complainant has also satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, 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 the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- ii. the Respondent has registered the disputed 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 the Respondent has engaged in a pattern of such conduct; or
- iii. the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

Bad Faith Registration

The Complainant holds a trademark registration for the ICE MILLER in the United States of America that predates the registration of the disputed domain name.

Given that the Complainant's ICE MILLER trademark predates the disputed domain name, is widely known, and that the disputed domain name consists of an intentional misspelling of the ICE MILLER trademark, it is difficult to conceive that the Respondent coincidentally registered the disputed domain name without knowledge of the Complainant's rights in the ICE MILLER mark, particularly given the use of the disputed domain name described above and below. As the Respondent has not submitted a response, or offered any other explanation as to why the disputed domain name was registered, the Panel is satisfied that the Respondent registered the disputed domain name in bad faith.

Bad faith Use

To prove bad faith use of the disputed domain name, the Complainant provided evidence that the Respondent has used the disputed domain name to engage in a business email compromise to impersonate one of the Complainant's attorneys.

In the absence of a Response from the Respondent, the Panel therefore concludes that the disputed domain name is indisputably used to capitalize on the Complainant's reputation to launch a fraudulent scheme by taking advantage of the confusion created by the disputed domain name. Such use constitutes bad faith pursuant to paragraph 4(b)(iv) of the Policy, because the Respondent uses the disputed domain name to attract Internet traffic to its site for commercial gain by creating a likelihood of confusion. (See [WIPO Overview 3.0](#), section 3.1.4, "the use of a domain name for per se illegitimate activity such as [...] phishing [...] is manifestly considered evidence of bad faith" and as set forth in [WIPO Overview 3.0](#), section 3.4, using a disputed domain name for "phishing", especially where "the respondent's use of the domain name [is] to send deceptive emails" for purposes such as "to solicit payment of fraudulent invoices by the complainant's actual or prospective customers" constitutes bad faith, see also, e.g., *BTWN Exhibits, LLC v. Registration Private, Domains By Proxy, LLC / Ahmed Fawzy, ASM Marketing*, WIPO Case No. [D2020-0036](#) (finding bad faith where "Respondent used the Domain Name to create an email address [and] send fraudulent emails to Complainant's customers"); and *LinkedIn Corporation v. Michael Moore*, WIPO Case

No. [D2022-3287](#) (finding bad faith where “Respondent used the disputed domain name as the sender domain in an email adopting the identity of an employee of Complainant, with other details intended to appear as originating with Complainant, including an invoice designed to appear as originating with Complainant (but with different payment details)”); see also *Arista Networks Inc. v. Sam Morgan*, WIPO Case No. [D2022-4352](#) (in an almost identical case scenario: “Respondent has used the Disputed Domain Name to engage in a business email compromise or phishing scam to impersonate Complainant, which resulted in one of Complainant’s customers sending USD 100,000 to what Complainant has called ‘an unaffiliated bank account.’ This obviously shows that the Disputed Domain Name has been used in bad faith by creating a likelihood of confusion under paragraph 4(b)(iv) of the Policy”).

The Panel is therefore satisfied that the Complainant has shown that the disputed domain name has been registered and is being used in bad faith satisfying the third limb 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, <lcermiller.com>, be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: March 15, 2023