

ADMINISTRATIVE PANEL DECISION

Fieldfisher LLP v. Elio D
Case No. D2023-1262

1. The Parties

The Complainant is Fieldfisher LLP, United Kingdom, represented internally.

The Respondent is Elio D, Australia.

2. The Domain Name and Registrar

The disputed domain name <fieldfisherslawgroup.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 23, 2023. On March 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 23, 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 (Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 24, 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 29, 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 April 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 25, 2023.

The Center appointed Torsten Bettinger as the sole panelist in this matter on April 27, 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 European law firm headquartered in London, United Kingdom.

The Complainant was renamed to Fieldfisher in 2014, having had “Field Fisher” as part of the law firm’s name since 1969.

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

- European Union Trade Mark Registration No. 012575511 for FIELDFISHER registered in Classes 9, 16, 25, 35, 36, 38, 41, and 45, filed on February 7, 2014, and registered on June 30, 2014;
- United Kingdom Trade Mark Registration No. UK00912575511 for FIELDFISHER registered in Classes 9, 16, 25, 35, 36, 38, 41, and 45, filed on February 7, 2014, and registered on June 30, 2014;
- United States of America Trade Mark Registration No. IR1238145 for FIELDFISHER registered in Class 45, filed on August 4, 2014, and registered on January 26, 2016;
- International Trade Mark Registration No. 1238145 for FIELDFISHER registered in Class 45, filed on August 4, 2014, and registered on March 5, 2015.

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

The disputed domain name was registered on February 15, 2023.

The Complainant states, and provides documentation in support thereof, that the disputed domain name resolves to a website purporting to be part of the Complainant’s Fieldfisher legal services, evidenced by the inclusion of the Complainant’s address on the website.

5. Parties’ Contentions

A. Complainant

The Complainant states that it has acquired a strong reputation, becoming one of the United Kingdom’s top law firms by revenue and having a multinational presence with more than 1,700 employees and 26 offices in 11 countries,

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, arguing that

- the additional “s” at the end of “Fieldfisher” and the term “lawgroup” are, as such, insufficient to avoid confusing similarity, and will, on the contrary, merely suggest to Internet users that the disputed domain name is related to the Complainant’s group or law firm;
- the Top-Level-Domain (“TLD”) “.com” is a technical requirement of registration of a domain name and does not serve to distinguish the domain name from other domain names.

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 use of the disputed domain name for just over one month is insufficient to generate any goodwill or reputation in the disputed domain name with its customers;

- by using a proxy service the respondent is seeking to hide its activity from scrutiny in proceedings under the Policy.
- the Complainant has never licensed or otherwise authorized the Respondent or the Registrant to use its trademarks or to register any domain name including its FIELDFISHER trademarks.

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:

- the registration of the disputed domain name is primarily intended to disrupt the business of the Complainant, as the disputed domain name is highly similar to the FIELDFISHER trademarks and resolves to a website that purports to be part of the Complainant's Fieldfisher legal services, evidenced by the inclusion of the Complainant's address on the website;
- given the reputed and distinctive nature of Fieldfisher LLP and its FIELDFISHER mark, and the activities undertaken by the Respondent, it is highly likely that the Respondent had actual notice as to the Complainant's trademarks at the time it registered the disputed domain name;
- the Respondent acted with opportunistic bad faith in registering the name in order to make an illegitimate use of it;
- the Respondent has intentionally attempted to attract for commercial gain internet users to its website by using a domain name which is likely to cause confusion with the Complainant's websites;
- the Respondent has used its website to provide an apparent scam under the disputed domain name and in the circumstances, given the likelihood of confusion, there is a *prima facie* case that this could tarnish the Complainant's goodwill in its name and trademarks;
- under the circumstances the Respondent's use of a domain privacy and proxy service when perpetrating an evidently dishonest act is another factor that indicates bad faith.

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 FIELDFISHER.

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 adds the letter “s” to the Complainant’s trademark FIELDFISHER as well as the word “lawgroup”, a descriptive term for Complainant’s business of providing legal services.

The Panel finds that the addition of the letter “s” does not prevent the Complainant’s trademark from being recognizable within the disputed domain name. Furthermore, it has long been established under the UDRP case law that the addition of wording to a trademark in a domain name does not prevent a finding of confusing similarity under the first element of the UDRP (see section 1.8 of [WIPO Overview 3.0](#)). The Panel therefore agrees with the Complainant’s assertion that the addition of the term “lawgroup” does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark FIELDFISHER.

Finally, as to whether the disputed domain name is identical or confusingly similar to the FIELDFISHER Mark, the relevant comparison to be made is with the second- level portion of the domain name only as it is well-established that 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 FIELDFISHER 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 FIELDFISHER mark.

The Complainant provided evidence that the resolves to a website purporting to be part of the Complainant’s Fieldfisher legal services, evidenced by the inclusion of the Complainant’s address on the website. 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 3.0](#), 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 FIELDFISHER in various countries that predates the registration of the disputed domain name.

Given that the disputed domain name contains the Complainant's FIELDFISHER trademark in its entirety with the addition of the descriptive term "lawgroup" and that the disputed domain resolves to a website purporting to be part of the Complainant's Fieldfisher legal services, the Panel has no doubt that the Respondent registered the disputed domain name with actual knowledge of the Complainant's rights in the FIELDFISHER mark and therefore 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 resolve to a website purporting to be part of the Complainant's Fieldfisher legal services, evidenced by the inclusion of the Complainant's address on the website.

In the absence of a Response from the Respondent, the Panel therefore concludes that the disputed domain name is indisputably used to impersonate the Complainant and thus 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 an egregious case of bad faith pursuant to paragraph 4(a)(iii) of the Policy as it indicates that the Respondent intentionally registered and is using the disputed domain name in order to disrupt the Complainant's business, in accordance with paragraph 4(b)(iii) of the Policy, and to attract, for commercial gain, Internet users to its website in accordance with paragraph 4(b)(iv) of the Policy.

Finally, in the circumstances of the present case, the Respondent's use of a privacy service to hide its identity may be considered further evidence of the Respondent's bad faith; see [WIPO Overview 3.0, section 3.6](#)

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

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: May 11, 2023