

ADMINISTRATIVE PANEL DECISION

Morrison & Foerster LLP v. Morrison Foerster, MorrisonFoersterLTD,
Morrison Foerster
Case No. D2023-2915

1. The Parties

The Complainant is Morrison & Foerster LLP, United States of America (“United States”), represented by Morrison & Foerster, LLP, United States.

The Respondent is Morrison Foerster, MorrisonFoersterLTD, Morrison Foerster , United Kingdom.

2. The Domain Names and Registrars

The disputed domain name <morrison-foerster.info> is registered with NameSilo, LLC.

The disputed domain name <morrison-foerster.online> is registered with NameCheap, Inc.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 7, 2023. On July 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 7, 2023, the Registrars transmitted by email to the Center their verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (PrivacyGuardian.org llc and Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 25, 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 July 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 August 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 29, 2023.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on September 5, 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 an international law firm with offices in the United States, Asia and Europe. The Complainant provides its services under the trademark MORRISON & FOERSTER since 1975 and owns trademark registrations for MORRISON & FOERSTER such as:

- United States registration No. 1665352 registered on November 19, 1991
- United States registration No. 2916268 registered on January 4, 2005

The disputed domain name <morrison-foerster.info> was registered on June 26, 2023 and the disputed domain name <morrison-foerster.online> was registered on June 28, 2023. Both disputed domain names resolve to the same webpage displaying the Complainant's trademark and claiming to be a law firm.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are virtually identical and confusingly similar to a trademark in which the Complainant has rights. The disputed domain names incorporate the Complainant's trademark and simply replace the ampersand with a dash, which does not eliminate the likelihood of confusion.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names. The Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services. The Complainant did not authorize the Respondent to use its trademark in the disputed domain names and the Respondent is not a provider of the Complainant's services. The Respondent is attempting to present itself as a law firm. The Respondent is trying to misappropriate the goodwill connected with the Complainant's trademark and had constructive and actual knowledge of the Complainant's trademark. There is a risk that the website located at the disputed domain names be used for malicious purposes. The Respondent is not commonly known by the disputed domain names. There is no legitimate noncommercial or fair use. Instead, the Respondent may use the disputed domain names as part of a phishing scheme.

The Complainant contends that the disputed domain names are registered and are being used in bad faith.

The Respondent had actual knowledge of the Complainant's trademark. The Complainant did not authorize the Respondent to use its trademark in the disputed domain names and the website located at the disputed domain names may be used for malicious purposes. The use of the Complainant's logo is further evidence of bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant owns trademark registrations for MORRISON & FOERSTER. The Panel is satisfied that the Complainant has established its ownership of the trademark MORRISON & FOERSTER.

The disputed domain names incorporate the two words forming the Complainant's trademark "MORRISON" and "FOERSTER". The sign "&" is replaced with the sign "-", which does not prevent a finding of confusing similarity. The generic Top-Level Domains ".info" and ".online" can be ignored when assessing confusing similarity as these are a standard registration requirement.

Consequently, the Panel finds that the disputed domain names are identical or confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent. In the instant case, the Complainant asserts that the Respondent is not authorized by the Complainant to use its trademark nor is a provider of the Complainant's services. Therefore, the Complainant has established a *prima facie* case and the burden of production shifts to the Respondent to show that it has rights or legitimate interests.

The Panel also notes that the Respondent's name (as shown in the WhoIs for the disputed domain names) corresponds to the disputed domain name, being closely similar to the Complainant's corporate name. The Panel finds that the circumstances indicate this is likely to be a name provided by the Respondent specifically to take unfair advantage of the Complainant's rights.

The Respondent has not provided any evidence to show that it has any rights or legitimate interests in the disputed domain names. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

In the present case, the Respondent was aware of the Complainant's trademark and has changed only a sign in order to confuse Internet users and to benefit from the nature of the disputed domain names.

There is sufficient evidence to demonstrate that the Respondent is aware of the Complainant's trademark. The Complainant's trademark has been first registered in 1991 while the disputed domain names were registered in 2023, *i.e.* more than 30 years later. The particular combination of "Morrison" and "Foerster" for the disputed domain names seem to respond to a targeting of the Complainant's trademark (*Singh & Singh Law Firm LLP and MKS IP Assets Private Limited v. Muhammad Irfan*, WIPO Case No. [D2023-2495](#)). The disputed domain names resolve to a website attempting to impersonate the Complainant by pretending to be a law firm and by displaying the Complainant's name. The Respondent even provided the name "Morrison and Foerster" as the registrant of the disputed domain names in a likely attempt to furtherance its impersonation. This is clearly an attempt to impersonate the Complainant, which is evidence of bad faith.

The Respondent is attempting to impersonate the Complainant either for the purpose of attracting Internet users looking for the Complainant's website into the Respondent's website or in order to obtain information on clients of the Complainant, *i.e.* phishing.

Such conduct would fall squarely within the meaning of paragraph 4(b)(iv) of the Policy. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) 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 names, <morrison-foerster.info> and <morrison-foerster.online> be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: September 19, 2023