

## **ADMINISTRATIVE PANEL DECISION**

Pinsent Masons LLP v. Dengabo Oiboh

Case No. D2023-3024

### **1. The Parties**

The Complainant is Pinsent Masons LLP, United Kingdom (“UK”), internally represented.

The Respondent is Dengabo Oiboh, Nigeria.

### **2. The Domain Name and Registrar**

The disputed domain name <pinsentmasons-ae.com> (the “Disputed Domain Name”) is registered with Dynadot, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 14, 2023. On July 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 14, 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 (Super Privacy Service Ltd c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 18, 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 24, 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 July 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 24, 2023.

The Center appointed Nicholas Weston as the sole panelist in this matter on September 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 full-service international law firm with 26 offices across the UK, Europe, the Gulf, Asia Pacific, and Africa. The Complainant holds a number of registrations for the trademark PINSENT MASONS in various jurisdictions including, for example, International Trademark No. 2484418, registered on April 30, 2008, in International Classes 9, 16, 35, 36, 41, and 45.

The Complainant owns a number of domain names that contain the trademark PINSENT MASONS including <pinsentmasons.com> which resolves to its main website.

The Respondent registered the Disputed Domain Name <pinsentmasons-ae.com> on April 12, 2023. The Disputed Domain Name resolves to an inactive webpage.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant cites several trademarks registrations internationally for the mark PINSENT MASONS as *prima facie* evidence of ownership.

The Complainant submits that its rights in the mark PINSENT MASONS predate the Respondent's registration of the Disputed Domain Name. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the PINSENT MASONS trademark and that the confusing similarity is not removed by the addition of the hyphen or the letters "ae" or the generic Top-Level Domain ("gTLD") ".com". It submits that "[g]iven the international presence and associated reputation of the name Pinsent Masons, no trader would choose the [Disputed] Domain Name unless with the intention to create a false impression of association with the Complainant in order to attract business from the Complainant in order to attract business from the Complainant or misleadingly to divert the public from the Complainant to the Respondent."

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that "[it] considers that it is not possible for the respondent to have acquired any legitimate right to use the Domain Name since its registration."

Finally, the Complainant alleges that the Respondent registered and is using the Disputed Domain Name in bad faith and that "the term '-ae' ... could be taken to refer to the United Arab Emirates, a territory in which the Complainant operates." The Complainant further contends that "members of the public will always assume that there is an association between the respondent and the Complainant, and/or between the Respondent and the Pinsent Masons trade marks."

##### **B. Respondent**

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

## 6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

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

### A. Identical or Confusingly Similar

The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark PINSENT MASONS in numerous jurisdictions. The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the PINSENT MASONS trademark, the Panel observes that the Disputed Domain Name comprises: (a) the Complainant's trademark PINSENT MASONS; (b) followed by a hyphen; (c) followed by the letters "ae"; (d) followed by the gTLD ".com".

It is well established that the gTLD used as technical part of a domain name may be disregarded. The relevant comparison to be made is with the Second-Level portion of the Disputed Domain Name, specifically: "pinsentmasons-ae" (see section 1.11.1 of the [WIPO Overview 3.0](#)).

In this case, the Disputed Domain Name identically incorporates the entirety of the Complainant's trademark. It is also well-established that in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (see [WIPO Overview 3.0](#), section 1.7).

The Panel finds that the addition of the hyphen and the letters "ae" does not avoid a finding of confusing similarity between the Disputed Domain Name and the Complainant's trademark as the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see [WIPO Overview 3.0](#), section 1.8).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name. The Policy also places the burden on the Complainant to establish the absence of the Respondent's rights or legitimate interests in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Panel observes that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because (i) the Disputed Domain Name is inactive; (ii) the Respondent has not acquired or owned any trademark or service mark rights in the name PINSENT MASONS, and has not been commonly known by the name PINSENT MASONS; and (iii) the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain.

The Panel accepts the Complainant's uncontested submission that "the Respondent is not making a legitimate non-commercial fair use of the [Disputed] Domain Name".

The Panel finds that the composition of the Disputed Domain Name, largely comprised of the Complainant's trademark, indicates an awareness and targeting of the Complainant and its mark with the intention to take unfair advantage of it, which does not support a finding of any rights or legitimate interests. Numerous previous panels have recognized that a respondent's prior registration of a trademark which corresponds to a disputed domain name will ordinarily support a finding of rights or legitimate interests in that disputed domain name for purposes of the second element of the Policy (see [WIPO Overview 3.0](#), section 2.12).

The Panel finds for the Complainant on this element of the Policy.

### **C. Registered and Used in Bad Faith**

The third element of the Policy requires that the Complainant must also demonstrate that the Disputed Domain Name has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both of these conjunctive requirements.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, given the composition of the Disputed Domain Name, the Panel is satisfied that the Respondent targeted the Complainant's trademark PINSSENT MASONS when it registered the Disputed Domain Name. The Panel is prepared to infer that the Respondent knew, or should have known, that its registration would be identical or confusingly similar to the Complainant's trademark (see [WIPO Overview 3.0](#), section 3.2.2).

Further, a gap of several years between registration of a complainant's trademark and respondent's registration of a disputed domain name (containing the trademark) can indicate bad faith registration. In this case, the Disputed Domain Name was registered 15 years after the Complainant established registered trademark rights in the PINSSENT MASONS mark.

On the issue of use, the evidence is that the Disputed Domain Name is inactive and unconnected with any *bona fide* supply of goods or services by the Respondent. Previous UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. "While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the 'passive holding' doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put" (see [WIPO Overview 3.0](#), section 3.3). This Panel notes that the evidence is that all of these factors are present in this proceeding.

The Respondent's conduct calls for an explanation, which was not forthcoming. In the absence of any countervailing evidence, this Panel accepts the Complainant's evidence and finds that the Respondent has registered and used the Complainant's trademark PINSSENT MASONS in the Disputed Domain Name, without the Complainant's consent or authorization, for the likely purpose of capitalizing on the reputation of the trademark to infringe upon the Complainant's rights.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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 Name, <pinsentmasons-ae.com> be transferred to the Complainant.

*/Nicholas Weston/*

**Nicholas Weston**

Sole Panelist

Date: September 14, 2023