

ADMINISTRATIVE PANEL DECISION

Bryan Cave Leighton Paisner LLP v. asd asd, asd asd
Case No. D2023-0156

1. The Parties

The Complainant is Bryan Cave Leighton Paisner LLP, United States of America ("USA"), internally represented.

The Respondent is asd asd, asd asd, Japan.

2. The Domain Name and Registrar

The disputed domain name <bryancaveintl.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on January 12, 2023. On January 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 16, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on January 16, 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 in English on January 19, 2023.

On January 16, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On January 19, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Japanese of the Complaint, and the proceedings commenced on January 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 14, 2023.

The Center appointed Erica Aoki as the sole panelist in this matter on March 6, 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 more than 1,200 lawyers across 30 offices around the world, including in North America, Europe, the Middle East, and Asia.

The Complainant traces its roots to 1873 when its predecessor in interest was formed in St. Louis, Missouri, USA and grew exponentially from a single office to twenty-six offices in seven countries with hundreds of employees.

Prior to April 2018, the Complainant was named Bryan Cave LLP. On April 1, 2018, the highly publicized combination of law firms Bryan Cave LLP (a limited liability partnership registered in the USA) and Berwin Leighton Paisner LLP (a limited liability partnership registered in England and Wales) became effective, resulting in the name of the Complainant being changed to Bryan Cave Leighton Paisner LLP.

The Complainant holds registrations for the trademark BRYAN CAVE and variations thereof in numerous countries around the world, including the European Union Trade Mark No. 008806036 registered on June 2, 2010.

The disputed domain name was registered on November 12, 2022. The disputed domain name resolves to an inactive website.

5. Parties' Contentions

A. Complainant

The Complainant is one of the world's largest international law firms with more than 1,200 lawyers across 30 offices around the world and has a long and successful history since 1873 when its predecessor in interest was formed in St. Louis, Missouri, USA.

Beginning in approximately 1917, when its predecessor adopted the name Bryan, Williams, and Cave – eventually shortened to simply Bryan Cave – and for the subsequent century of operation, Bryan Cave grew exponentially from a single office to twenty-six offices in seven countries with hundreds of employees.

Prior to April 2018, the Complainant was named Bryan Cave LLP. On April 1, 2018, the highly publicized combination of law firms Bryan Cave LLP (a limited liability partnership registered in the USA) and Berwin Leighton Paisner LLP (a limited liability partnership registered in England and Wales) became effective, resulting in the name of the Complainant being changed to Bryan Cave Leighton Paisner LLP.

Prior to the combination, the Complainant's legacy firm, Bryan Cave LLP, used the mark BRYAN CAVE in connection with its offerings of legal and related services around the world. Since the combination, the Complainant continues to be known and referred to as "Bryan Cave."

Further, since the combination, the Complainant has continuously used the BRYAN CAVE, BRYAN CAVE LEIGHTON PAISNER, and BRYAN CAVE LEIGHTON PASINER BCLP trademarks in connection with its offerings of legal and related services.

The Complainant holds registrations for the trademark BRYAN CAVE and variations thereof in numerous countries around the world.

The Complainant and/or its predecessor firms also own numerous other relevant trademark registrations throughout the world. The Complainant has maintained and continues to maintain an active presence on the Internet, including through its legacy webpage (which now redirects to the Complainant's website as well as through various other domain names incorporating the BRYAN CAVE Marks).

As an international law firm, the Complainant's business relies on its Internet presence to promote its services, notify clients and potential clients of legal matters and for correspondence through email communications.

The Complainant has expended, and continues to expend, a substantial number of resources, money, time and effort promoting, marketing, advertising, and building consumer recognition and goodwill in its services under and in connection with its highly recognized and distinctive BRYAN CAVE Marks.

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademark, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

The Complainant is required to establish the requirements specified under paragraph 4(a) of the Policy:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in respect of 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. Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Japanese. Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding". The Panel may also order that any documents submitted in a language other than that of the proceeding be translated.

However, as noted by previous UDRP panels, paragraph 11 of the Rules must be applied in accordance with the overriding requirements of paragraphs 10(b) and 10(c) of the Rules that the parties are treated equally, that each party is given a fair opportunity to present its case and that the proceeding takes place with due expedition (see, e.g., *General Electric Company v. Edison Electric Corp. General Energy a/k/a Edison GE GEEEEGE.COM a/k/a Edison-GE and Edison Electric Corp.*, WIPO Case No. [D2006-0334](#)).

In deciding whether to allow the proceeding to be conducted in a language other than the language of the Registration Agreement, and to require the Complainant in an appropriate case to translate the Complaint into the language of that Agreement, the Panel must have regard to all “the relevant circumstances” of the case. The factors that the Panel should take into consideration include *inter alia* whether the Respondent is able to understand and effectively communicate in the language in which the Complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation and the delay in the proceedings can be avoided without causing injustice to the Parties.

According to section 4.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), prior UDRP panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios include: (i) evidence showing that the respondent can understand the language of the complaint, (ii) the language/script of the domain name particularly where the same as that of the complainant’s mark, (iii) any content on the webpage under the disputed domain name, (iv) prior cases involving the respondent in a particular language, (v) prior correspondence between the parties, (vi) potential unfairness or unwarranted delay in ordering the complainant to translate the complaint, (vii) evidence of other respondent-controlled domain names registered, used, or corresponding to a particular language, (viii) in cases involving multiple domain names, the use of a particular language agreement for some (but not all) of the disputed domain names, (ix) currencies accepted on the webpage under the disputed domain name, or (x) other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement.

The Complainant has submitted a request that the language of the proceeding be English.

The Panel notes that the Center notified the Respondent in Japanese and English regarding the language of the proceeding and the Respondent was invited to present his objection to the proceeding being held in English and if the Center did not hear from the Respondent by the specified due date, the Center would proceed on the basis that the Respondent had no objection to the Complainant’s request that English be the language of the proceeding. The Respondent had the opportunity to raise objections or make known his preference but did not do so. The Panel further notes that the Center notified the Respondent in Japanese and English of the Complaint, and the Respondent was informed that it could file a response either in Japanese or English, but the Respondent did not file any response.

Taking all these circumstances into account, the Panel finds that it is appropriate to exercise its discretion and allow the proceeding to be conducted in English.

B. Identical or Confusingly Similar

Based on the facts presented by the Complainant, this Panel finds that the Complainant has established its rights in BRYAN CAVE through registration and use. The Panel finds that the disputed domain name is confusingly similar to the Complainant’s registered trademark, as the disputed domain name includes the Complainant’s mark in full, with only the addition of the term “intl,” a widely recognized abbreviation of the term “international,” to the Complainant’s trademark, which does not prevent a finding of confusing similarity (see section 1.8 of the [WIPO Overview 3.0](#)).

C. Rights or Legitimate Interests

The Panel finds the following on record in this proceeding under the Policy:

The Respondent is in default and thus has made no affirmative attempt to show any rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy indicates that a registrant may have a right or legitimate interest in a domain name if it uses the domain name in connection with a *bona fide* offering of goods or services prior to notice of the dispute. In this regard, the Respondent is in no way connected with the Complainant and has no authorization to use any of the Complainant’s trademarks. The disputed domain name is set up MX-records

for the domain name allowing the Respondent to send and receive emails and potentially use for fraudulent email communications.

There is no evidence on record that the Respondent is or was commonly known by the disputed domain name as an individual, business, or other organization.

There is no evidence on record that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Thus, the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Panel therefore finds that the Complainant has established an un rebutted *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, under the Policy, paragraph 4(a)(ii).

D. Registered and Used in Bad Faith

The Respondent has registered the disputed domain name to lure consumers to an imposter's site for commercial gain.

The Complainant's trademark was registered before the registration of the disputed domain name, and it is evident from the Respondent's use of the disputed domain name that the Respondent knew of the Complainant's BRYAN CAVE trademark when registering the disputed domain name.

Furthermore, the Complainant's BRYAN CAVE trademark is distinctive and unique to the Complainant. It is therefore beyond the realm of coincidence that the Respondent chose the disputed domain name without the intention of invoking a misleading association with the Complainant.

The Panel finds that it is most likely that the Respondent was aware of the Complainant's rights in the BRYAN CAVE trademark at the time the disputed domain name was registered, indicating that such registration was made in bad faith.

Accordingly, and as also supported by the Panel's findings above under the second element of the Policy, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith under the Policy, paragraph 4(a)(iii).

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 <bryancaveintl.com> be transferred to the Complainant.

/Erica Aoki/

Erica Aoki

Sole Panelist

Date: March 20, 2023