

## **ADMINISTRATIVE PANEL DECISION**

Fieldfisher LLP v. Reg Boxes

Case No. D2023-0183

### **1. The Parties**

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

The Respondent is Reg Boxes, United States of America (“United States”).

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

The disputed domain name <fieldfisher.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 January 13, 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 13, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) 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 on January 18, 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 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 14, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on February 20, 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 and supported by offices in mainland Europe, the United States and China as well as international partner firms. With origins of the Complainant being traced back to 1835, it was renamed to Fieldfisher in 2014, having had "Field Fisher" as part of the Complainant's name since 1969. In addition to that, the Complainant operates its official website under the domain name <fieldfisher.com>, and is the owner of the following, amongst other, trademark registrations:

- European Union trademark registration No. 012575511 for FIELDFISHER, filed on February 7, 2014, and registered on June 30, 2014, in classes 9, 16, 25, 35, 36, 38, 41 and 45;
- United Kingdom trademark registration No. UK00912575511 for FIELDFISHER, filed on February 7, 2014, and registered on June 30, 2014; in classes 9, 16, 25, 35, 36, 38, 41 and 45;
- United States trademark registration No. 1238145 for FIELDFISHER, filed on August 4, 2014, and registered on January 26, 2016, in class 45; and
- International trademark registration No. 1238145 for FIELDFISHER, filed on August 4, 2014 and registered on March 5, 2015, in class 45.

The disputed domain name <fieldflsher.com> was registered on December 13, 2022. Presently, it resolves to a parked webpage displaying pay-per-click ("PPC") links.

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

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

The Complainant asserts to provide a wide range of legal services in various sectors, as well as several client solutions, such as alternative legal services and automation and efficiency products, having acquired a strong reputation and become one of the United Kingdom's top law firms by revenue, also counting with a multinational presence and more than 1,700 employees and 26 offices in 11 countries.

The Complainant further asserts to be a Times Top 20 Law Firm, a highly commended firm in the European Financial Times Innovative Lawyers rankings also having been repeatedly nominated for awards in areas including dispute resolution, M&A and intellectual property, being generally referred to around the world as "Fieldfisher".

Under the Complainant's view, the disputed domain name reproduces the distinctive element of the Complainant's trademark and is therefore highly similar thereto, given that it would be identical but for the "i" in "fisher" being replaced with an "l", being the lower case "l" very similar to a lower case "i", and almost identical to an upper case "I".

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name given that:

- (a) the Respondent's name suggests that the Respondent does not have any legitimate interest regarding the disputed domain name as its name does not bear any resemblance with the word "Fieldfisher", which has no meaning and is therefore highly distinctive and adopted by the Complainant so as to distinguish its business in the marketplace;

- (b) the Complainant has never licensed or otherwise authorized the Respondent to use its trademark or to register any domain name including the Complainant's trademark, thereby providing rights in respect of the disputed domain name; and
- (c) the Respondent cannot plausibly make a *bona fide* use of the disputed domain name given that apparently no active use of the disputed domain name has taken place.

As to the registration of the disputed domain name in bad faith, the Complainant asserts that the Respondent was evidently targeting the Complainant given that the disputed domain name is highly similar to the trademark owned by the Complainant, including the highly similar and dominant term "fieldfisher" and that it presents a website purporting to be part of the Complainant's Fieldfisher legal services. In addition to that, the Respondent's choice to retain a domain privacy and proxy service is a further indicative of the Respondent's bad faith. Lastly, the Complainant argues that there is implausibility of any good faith use to which the disputed domain name maybe put, having the Complainant in the past already been the victim of a similar case in which respondent provided an apparent scam under the domain name in dispute, what could tarnish the Complainant's goodwill in its name and trademark (see *Fieldfisher LLP v. Ruben M*, WIPO Case No. [D2022-4074](#)).

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

### **A. Identical or Confusingly Similar**

The Complainant has established rights in the FIELDFISHER trademark duly registered in several jurisdictions.

The Panel finds that the disputed domain name reproduces the dominant feature of the Complainant's mark, replacing the "i" in "fisher" for an "l". It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. The first element of the Policy has been established.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent's rights to or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) 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 trademark or service mark at issue.

The Respondent, in choosing not to respond, has failed to invoke any of the circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to and/or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden is still on the Complainant to first make a *prima facie* case against the Respondent (being the overall burden of proof always with the Complainant, but once the 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).

In that sense, the Complainant indeed states that it has never licensed or otherwise authorized the Respondent to use its trademark or to register any domain name including the Complainant's trademark, thereby providing rights in respect of the disputed domain name.

Also, the absence of any indication that the Respondent holds rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or the webpage available at the disputed domain name, corroborate with the Panel's finding of the absence of rights or legitimate interests.

Therefore, the Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name. The second element of the Policy has also been met.

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

This case presents the following circumstances which indicate under the balance of probabilities bad faith registration and use of the disputed domain name:

- a) the Complainant is a prestigious and long-established law firm with an international reach, being its name and registered trademark well known;
- b) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name;
- c) the present use of the disputed domain name in connection with a parked webpage displaying PPC links indicates the Respondent's bad faith; and
- d) the indication of what appears to be false contact details, not having the Center been able to fully deliver communications to the Respondent.

Further, previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

For the reasons above, the Respondent's conduct has to be considered, in this Panel's view, as bad faith registration and use of the disputed domain name.

## **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 <fieldfisher.com> be transferred to the Complainant.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: March 3, 2023