

ADMINISTRATIVE PANEL DECISION

Pinsent Masons LLP v. Crouze Paul

Case No. D2023-1392

1. The Parties

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

The Respondent is Crouze Paul, Israel.

2. The Domain Name and Registrar

The disputed domain name <pinsentmasonslaw.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 30, 2023. On March 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 31, 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 April 3, 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 April 4, 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 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 28, 2023. Due to an administrative issue at the time of notification of the Complaint, the Center granted the Respondent a 10-day period (through May 11, 2023) in which to indicate whether it wished to participate in the proceeding. The Respondent did not reply.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on May 26, 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 engaged in the provision of legal services across a broad spectrum of practice areas. The Complainant operates internationally with 26 offices across the UK, Europe, the Gulf, Asia Pacific and Africa. The Complainant ranks among the top 20 law firms in the UK and has over 400 partners, a total legal team of around 1,800 people, and more than 2,500 staff. The Complainant's creation dates back to several decades ago. The actual law firm is the result of several mergers with other law firms occurred since 1995, the latest of which dates back to 2012. During the years, the Complainant changed its name several times, until it commenced trading as "Pinsent Masons" in December 2004.

The Complainant is the registered proprietor of a variety of PINSENT MASONS registered trademarks in various countries worldwide, among which the following:

- European Union registration No. 006819197, filed on April 9, 2008 and registered on November 26, 2008, for goods and services in classes 9, 16, 35, 36, 41 and 45;
- International registration No. 977347, registered on April 30, 2008, designating several countries and covering goods and services in classes 9, 16, 35, 36, 41 and 45.

The Complainant is also the owner of the domain name <pinsentmasons.com>, registered on June 1, 2004, which is used in connection with its services.

The disputed domain name was registered on March 6, 2023 and is inactive.

5. Parties' Contentions

A. Complainant

The Complainant maintains that the disputed domain name is confusingly similar to its PINSENT MASONS trademark, as it incorporates it entirely, with the addition of the word "law". The addition of this term to the Complainant's trademark cannot prevent a finding of confusing similarity.

The Complainant further maintains that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent is not making a legitimate noncommercial fair use of the disputed domain name. Moreover, it is not possible for the Respondent to have acquired any legitimate right to use the disputed domain name.

Lastly, the Complainant argues that the disputed domain name was registered and is being used in bad faith. The disputed domain name incorporates the Complainant's trademark in full along with the term "law", which is directly related to the Complainant's activity. Given the widespread use and reputation of the Complainant, the Respondent must have been aware that in registering the disputed domain name it was misappropriating the Complainant's intellectual property rights. Moreover, any possible legitimate use of the disputed domain name by the Respondent would be implausible. Although the specific reason for the registration of the disputed domain name is unclear, the Complainant believes that in the absence of any legitimacy, the disputed domain name could have been registered for several reasons, including to generate revenues through pay-per-click links, or to redirect traffic to an alternative website, or even to facilitate the creation of email addresses that could be used for illegitimate or fraudulent purposes. In any event, none of

these uses would be in good faith. Moreover, the registration of the disputed domain name prevents the Complainant from registering a domain name, which corresponds to the Complainant's trademark. The disputed domain name is so obviously intended to imply a connection with the Complainant that its very use by the Respondent constitutes opportunistic bad faith, as the relevant public will always assume that there is an association between the Respondent and the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel is of the opinion that the disputed domain name is confusingly similar with the Complainant's mark as it fully incorporates it with the addition of the term "law". As explained in section 1.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), assessment of confusing similarity involves comparing the (alpha-numeric) domain name and the textual components of the relevant mark. Here, disregarding the Top-Level Domain ("TLD"), the disputed domain name is confusingly similar to the textual element of the Complainant's mark PINSENT MASONS. The additional word "law" is not sufficient to prevent a confusing similarity between the Complainant's trademark and the disputed domain name, as the PINSENT MASONS trademark remains clearly identifiable within the disputed domain name. Pursuant to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

Therefore, the Panel is satisfied that the first condition under the Policy is met.

B. Rights or Legitimate Interests

While the overall burden of proof rests with the complainant, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

In the instant case, the Panel notes that the Complainant has no relation with the Respondent and that the Complainant did not authorize the Respondent to incorporate its PINSENT MASONS trademark in the disputed domain name. Furthermore, there are no elements in the file showing that the Respondent has been commonly known by the disputed domain name. The disputed domain name is inactive; consequently, the Respondent has not used the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. The Respondent has not presented any argument or evidence showing that it has made demonstrable preparations to use the disputed domain name.

Other circumstances pointing towards the Respondent's lack of rights or legitimate interests in the disputed domain name reside in the nature of the disputed domain name, which incorporates the Complainant's trademark in full, coupled with a term making direct reference to the Complainant's activity. It is generally recognized that domain names consisting of a trademark plus a descriptive term carry a risk of implied affiliation: consumers looking for the Complainant would certainly believe that the disputed domain name belongs to the Complainant or to some affiliated entity (see section 2.5.1 of the [WIPO Overview 3.0](#)).

For all the reasons mentioned above, the Panel finds that, at least *prima facie*, the Respondent lacks rights or legitimate interests in the disputed domain name. Therefore, the burden of production shifts to the Respondent to provide convincing arguments and evidence supporting its rights or legitimate interests. However, the Respondent failed to meet this burden by choosing not to file its response.

In light of the foregoing, the Panel is satisfied that the second requirement under the Policy is met.

C. Registered and Used in Bad Faith

With respect to the bad faith requirement, the Complainant points out that its PINSENT MASONS trademark is well known and that the Respondent must have been aware of it at the time of the registration of the disputed domain name. Considering the significance of the Complainant, with many offices spread all over the world and the longstanding use of the Complainant's trademark, the Panel agrees that this trademark is likely to enjoy recognition, at least in the Complainant's field of activity. Moreover, the trademark at issue is certainly one exclusively associated with the Complainant, considering that it consists of the union of two surnames. Lastly, the addition of the term "law" to the disputed domain name, which clearly relates to the Complainant's field of activity, is clear evidence of the fact that the Respondent was well aware of the Complainant's mark at the time of the registration of the disputed domain name. The registration of a domain name confusingly similar to a third party's well-known trademark without rights or legitimate interests amounts to registration in bad faith.

As far as use is concerned, the disputed domain name does not resolve to an active website. However, the fact that the domain name is passively held cannot prevent a finding of use in bad faith under the so-called "passive holding doctrine". In particular, when a disputed domain name is inactive, the Panel must look at the totality of the circumstances of the case, including: (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 section 3.3 of the [WIPO Overview 3.0](#)). In the case at issue, the Panel notes that the Complainant's trademark is distinctive and exclusively associated with the Complainant. Moreover, the Complainant's trademark enjoys reputation in the legal field. The Respondent failed to submit a response and to provide evidence of actual or contemplated good-faith use of the disputed domain name. The Respondent registered the disputed domain name through a privacy service, as such, concealing its identity in order to render more difficult the Complainant's protection of its intellectual property rights. Finally, the Panel finds that in consideration of the reputation of the Complainant's trademark and the nature of the disputed domain name, which fully incorporates this mark with the addition of a term making direct and immediate reference to the Complainant's activity, there is no plausible use that the Respondent could make of the disputed domain name. For all the reasons mentioned above, the Panel concludes that the Respondent has registered and used the disputed domain name in bad faith.

Hence, the Panel is satisfied that also the third and last condition under the Policy is met.

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 <pinsentmasonsllaw.com> be transferred to the Complainant.

/Angelica Lodigiani/

Angelica Lodigiani

Sole Panelist

Date: June 9, 2023