

## ADMINISTRATIVE PANEL DECISION

Ropes & Gray LLP v. Atrur Mhitryn

Case No. D2024-3294

### 1. The Parties

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

The Respondent is Atrur Mhitryn, Belgium.

### 2. The Domain Name and Registrar

The disputed domain name <ropesgray.international> (the “Disputed Domain Name”) is registered with Hostinger Operations, UAB (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 12, 2024. On August 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 14, 2024, 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 (Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 14, 2024, 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 August 15, 2024.

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 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 12, 2024.

On September 12, 2024, the Respondent sent an email communication to the Center saying: "Hello Thank you for informing us. This is the domain of one of our clients. We blocked the services that were provided to him as services. We have nothing against transferring the domain to the owner of intellectual property."

The Center invited the Complainant to request the suspension of the proceeding to pursue settlement negotiations between the Parties, but the Complainant did not make such request.

The Center appointed Nicholas Weston as the sole panelist in this matter on September 27, 2024. 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 operates a multinational legal services business that employs more than 1,500 lawyers. The Complainant holds United States registration No. 2,902,936, for the trademark ROPES & GRAY registered on November 16, 2004.

The Complainant owns the domain name <ropesgray.com>, which was registered on October 12, 1995. which resolves to its main website.

The Respondent registered the Disputed Domain Name on May 15, 2024. It resolves to an inactive webpage. The evidence submitted in the Complaint illustrates that the Disputed Domain Name has been used for emails impersonating the Complainant.

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

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

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Notably, the Complainant cites its trademark registration in the United States for the mark ROPES & GRAY, as *prima facie* evidence of ownership.

The Complainant submits that its rights in that the mark ROPES & GRAY predate the Respondent's registration of the Disputed Domain Name by more than 150 years at common law and nearly 20 years based on the trademark registration cited. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name is comprised of the ROPES & GRAY trademark and that the addition of the generic Top-Level Domain ("gTLD") ".international" is not sufficient to avoid the confusing similarity to its trademark.

The Complainant contends that "[t]here is no relationship or affiliation between the Complainant and the Respondent giving rise to any license, permission, or other right by which the Respondent could own or use any domain name incorporating the Complainant's registered ROPES & GRAY mark". It also submits, in summary, that none of the circumstances set out in paragraph 4(c) of the Policy appear to apply that might give the Respondent any rights or legitimate interests in respect of the Disputed Domain Name.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and the Rules having regard to the long prior use of the Complainant's trademark. The Complainant submits that the passive holding of the Disputed Domain Name would not prevent a finding of bad faith.

## **B. Respondent**

The Respondent did not formally reply to the Complainant's contentions beyond the email mentioned above under Section 3.

## **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**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the Disputed Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. The requirements of the first element for purposes of the Policy may be satisfied by a trademark registered in any country. [WIPO Overview 3.0](#), section 1.2.1. The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark ROPES & GRAY in numerous countries.

Turning to whether the Disputed Domain Name is identical or confusingly similar to the ROPES & GRAY trademark, the Panel observes that the Disputed Domain Name is comprised of: (a) an exact reproduction of the Complainant's trademark ROPES & GRAY, absent the ampersand; (b) followed by the gTLD ".international".

It is well established that the gTLD used as part of a domain name is generally disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11. The relevant comparison to be made is with the second-level portion of the Disputed Domain Name, specifically: "ropesgray".

The Panel finds the entirety of the mark ROPES & GRAY is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control 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 on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such

relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name such as those enumerated in the Policy or otherwise.

The Panel notes the evidence reflecting that the Disputed Domain Name has been used for purposes of a fraudulent email scheme impersonating the Complainant. Such use can never confer rights or legitimate interests upon a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, 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, taking into account the composition of the Disputed Domain Name and the distinctive nature of the Complainant's trademark, the Panel is satisfied that the Respondent knew of and targeted the Complainant's trademark ROPES & GRAY when it registered the Disputed Domain Name (see *Ropes & Gray LLP v. David Turcotte*, WIPO Case No. [D2017-2474](#) ("[the] Complainant's well-known mark"); *Ropes & Gray LLP v. Onso Onso*, WIPO Case No. [D2019-0823](#) ("the [Complainant's] trademark is well known"); *Ropes & Gray LLP v. Contact Privacy Inc. Customer 0158624574/ Admin NA, Ropes Gray*, WIPO Case No. [D2020-2376](#) ("the Complainant's ROPES & GRAY mark is distinctive and well-known")).

This Panel finds that there is no reason for the Respondent to have registered the Disputed Domain Name other than to target the reputation and goodwill of the Complainant's well-known trademark. [WIPO Overview 3.0](#), section 3.1.4. Such targeting is clearly the intention of the Respondent given the fraudulent email scheme to which the Disputed Domain Name has been put, which is *prima facie* evidence of bad faith use.

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 Respondent registered the Disputed Domain Name nearly 20 years after the Complainant established registered trademark rights in the ROPES & GRAY mark.

On the issue of use, the Complainant's evidence shows that the website to which the Disputed Domain Names resolves is inactive despite having been used for a fraudulent email scheme.

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. Having reviewed the available record, the Panel finds the non-use of the Disputed Domain Name does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the Complainant's well-known ROPES & GRAY trademark, and the composition of the Disputed Domain Name, and finds that in the circumstances of this case the passive holding of the Disputed Domain Name does not prevent a finding of bad faith under the Policy.

Panels may take into account particular circumstances in assessing whether the respondent's registration of a domain name is in bad faith include: (i) the nature of the Disputed Domain Name such as here where a widely-known mark is used, (ii) the chosen Top-Level Domain; (iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the Disputed Domain Name, or (viii) other indicia generally suggesting that the respondent had somehow targeted the complainant. [WIPO Overview 3.0](#), section 3.2.1. In the circumstances, particularly given the absence of a formal reply, and the Respondent's tentative acknowledgment that a transfer of the Disputed Domain Name to the Complainant is appropriate, the Panel finds the Respondent's registration and use of, the Disputed Domain Name constitutes bad faith under the Policy.

While the Respondent apparently claims that the registration of the Disputed Domain Name was for one of its "clients", the Panel notes that section 4.4.6 of the [WIPO Overview 3.0](#) holds that a Whols-listed registrant accepts liability for any use of the relevant domain name unless it timely discloses the contact information of any underlying beneficial registrant. Given that no disclosure was made here and the Registrar disclosed the Respondent as the registrant of the Disputed Domain Name, the Panel will maintain the Party named as the Respondent for purposes of this proceeding.

The Panel finds that the Complainant has established the third element 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 <ropesgray.international> be transferred to the Complainant.

*/Nicholas Weston/*  
**Nicholas Weston**  
Sole Panelist  
Date: September 30, 2024