ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION
Pinsent Masons LLP v. Emmanuel Davis
Case No. D2024-3424

1. The Parties

The Complainant is Pinsent Masons LLP, United Kingdom, self-represented.

The Respondent is Emmanuel Davis, United States of America.

2. The Domain Name and Registrar

The disputed domain name <pinsentmasonslawfirms.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 August 21, 2024. On August 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 21, 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 Service provided by Withheld for privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 22, 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 27, 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 28, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 17, 2024. The Respondent did not submit any response. Accordingly, the Center commenced the panel appointment process on September 18, 2024.

The Center appointed Johan Sjöbeck as the sole panelist in this matter on September 23, 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 has submitted evidence that it is the owner of a number of a large number of registered trademarks, including the European Union trademark registration PINSENT MASONS (word) with registration number 006819197 and registration date November 26, 2008. The trademark is registered for goods and services in class 9, 16, 35, 36, 41 and 45.

The disputed domain name <pinsentmasonslawfirms.com> was registered on January 29, 2024. The website, to which the disputed domain name resolves, displays sponsored commercial pay-per-click links.

5. Parties' Contentions

A. Complainant

The Complainant is Pinsent Masons LLP. The Complainant is a full-service international law firm engaged in the provision of legal services across a broad spectrum of practice areas including construction, dispute resolution, outsourcing and technology, corporate finance and intellectual property. The Complainant operates internationally with 26 offices across the United Kingdom, Europe, the Gulf, Asia Pacific and Africa.

The Complainant ranks amongst the top 20 law firms in the United Kingdom and has over 400 partners, a total legal team of around 1,800 and more than 2,500 staff. The Complainant is a result of a number of mergers. In 1995 Pinsent & Co, a Birmingham based law firm merged with Simpson Curtis, a Leeds based law firm, and commenced trading as "Pinsent Curtis". In 2001, Pinsent Curtis merged with Biddle & Co, to form "Pinsent Curtis Biddle". In 2002, the Birmingham office of Garrets was incorporated into the firm. Pinsent Biddle Curtis was subsequently renamed "Pinsents" in 2003. In December 2004, Pinsents merged with law firm Masons and commenced trading as "Pinsent Masons" and on May 1, 2012, Pinsent Masons merged with the law firm McGrigors LLP.

The Complainant offers its services primarily under the name Pinsent Masons LLP at the website "www.pinsentmasons.com". The Complainant is the registered proprietor of a variety of United Kingdom registered and European Union registered trademarks in the name Pinsent Masons in a range of classes including in relation to legal services. The Complainant has used the trademarks continuously since they were registered. The trademarks have been used extensively across a range of services. In addition, the Complainant has advertised services bearing the marks both online through its websites and offline in a variety of publications. As a result of the Complainant's activities, it has built up substantial goodwill and gained a valuable reputation in the trademarks in relation to the services to which it registered with which the Complainant and no other is associated. The goodwill associated with the name Pinsent Masons is the property of the Complainant and cannot pass to any third party without a formal assignation. No such assignation in favor of the Respondent has taken place.

The Complainant is the registrant of a portfolio of domain names including <pinsentmasons.com> which was registered on June 1, 2004. The Complainant uses these domain names to promote and offer its legal related goods and services.

The disputed domain name <pinsentmasonslawfirms.com>, which was registered on January 29, 2024, incorporates the entirety of the Complainant's trademark PINSENT MASONS. The disputed domain name is identical to the Complainant's rights save for the addition of the term 'lawfirms'. This is a classic case of domain name squatting and as a consequence the disputed domain name is confusingly similar to the

Complainant's trademark. The Respondent has added the word 'lawfirms' to the trademark PINSENT MASONS in the disputed domain name presumably in an attempt to either distinguish the disputed domain name from the Complainant or appear as an extension of the Complainant's services. This change makes no difference to the overall impression of the dominant words PINSENT MASONS in the disputed domain name and is a prime example of classic domain name squatting. The addition of the word 'lawfirms' to the Complainant's trademark ties the disputed domain name more closely to the legal services provided by the Complainant. UDRP panels have consistently held that "a mere addition or a minor misspelling of Complainant's trademark does not create a new or different mark in which Respondent has legitimate rights." (*Hobson, Inc. v. Peter Carrington a/k/a Party Night Inc*, WIPO Case No. D2003-0317 and see further the case of *BHP Billiton Innovation Pty Ltd v. Oloyi*, WIPO Case No. D2017-0284).

The fact that the Respondent registered the disputed domain name using the generic level suffix ".com" causes further confusion given that the Complainant's core market is offering legal related services to a wide range of users located in various countries throughout the world.

Given the international presence and associated reputation of the trademarked 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 or misleadingly divert the public from the Complainant to the Respondent.

The Respondent registered the disputed domain name on January 29, 2024, and the registration was updated on the same date. An attempt was made to review the disputed domain name on August 21, 2024. When accessing the page, there are visible legal related sponsored links such as 'Contract Lawyer.' Given the disputed domain name, the Complainant considers it is reasonable to conclude that the Respondent registered the disputed domain name knowing that it is likely to attract interest from Internet users who are searching for the Complainant.

It is clear that the Respondent is not making a legitimate noncommercial fair use of the disputed domain name. The Complainant also considers that it is not possible for the respondent to have acquired any legitimate right to use the disputed domain name since its registration.

The disputed domain name not only incorporates the Complainant's name but also adds the term 'lawfirms', which is directly related to the Complainant's area of commercial activity. Given the widespread use and reputation of Pinsent Masons, particularly in relation to legal services, the Respondent must have been aware that in registering the disputed domain name it was misappropriating the valuable intellectual property of the Complainant.

The Respondent has not made any demonstrable preparations to make any use of the disputed domain name. The Respondent has opted to conceal its identity through a Privacy Protection Service. Given the disputed domain name in question, it is implausible to suggest that the Respondent could ever have a legitimate basis to hold or use the disputed domain name. The Complainant considers that the Respondent's motives for registration of the disputed domain name are illegitimate. The Complainant is concerned that the disputed domain name could have been registered in bad faith for further illegitimate purposes such as to sell the disputed domain name; to use the disputed domain name for the purpose of generating click through revenue; to use the disputed domain name in order to redirect Internet traffic to an alternative website for illegitimate or fraudulent purposes. None of these uses would constitute fair use and as such the Respondent has not generated any legitimate interest in the disputed domain name.

The Respondent's registration of the disputed domain name has also prevented the Complainant from registering a domain name which corresponds to the Complainant's trademarks. 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.

The Respondent will never be capable of using the disputed domain name for a legitimate purpose as the notoriety of Pinsent Masons is such 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 trademarks.

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove each of the following:

(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 the disputed domain name; and
(iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The 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.

From the submitted evidence it is clear that the Complainant is the owner of the registered trademark PINSENT MASONS and the Panel concludes that the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy.

The disputed domain name <pinsentmasonslawfirms.com> incorporates the Complainant's trademark in its entirety with the addition of the descriptive term "lawfirms". The Panel finds that the trademark is recognizable within the disputed domain name. Hence, the addition of the above-mentioned term to the trademark in the disputed domain name does not prevent a finding of confusing similarity. WIPO Overview 3.0, section 1.8.

Having the above in mind, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark and that the Complainant has proven the first requirement of the Policy under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests with respect to the disputed domain name. The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

(i) the Respondent uses or has made 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 prior to the dispute; or

(ii) the Respondent is commonly known by the disputed domain name, even if the Respondent has not acquired any trademark 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.

The Complainant's trademark registration for PINSENT MASONS predates the registration of the disputed domain name. The Complainant has not licensed, approved, or in any way consented to the Respondent's registration and use of the trademark in the disputed domain name. There is no evidence in the case file indicating that the Respondent has used or made any preparations to use the disputed domain name in connection with a bona fide offering of goods or services prior to the dispute. On the contrary, the Complainant has submitted evidence that the Respondent is using the disputed domain name, which is confusingly similar to the Complainant's trademark, to display sponsored commercial pay-per-click links competing with or capitalizing on the Complainant's PINSENT MASONS trademark.

Although given the opportunity, the Respondent has not rebutted the Complainant's prima facie case. The Respondent has not submitted any evidence indicating that it is the owner of any trademark or that it is commonly known by the disputed domain name. Furthermore, there is no evidence indicating that the Respondent intends to make 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. The Panel also finds that the composition of the disputed domain name carries a risk of implied affiliation. WIPO Overview 3.0, section 2.5.1.

The Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy or otherwise, any rights or legitimate interests in respect of the disputed domain name. In light of the above, there is no evidence in the case that refutes the Complainant's submissions, and the Panel concludes that the Complainant has also proven the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use include without limitation:

(i) circumstances indicating the disputed domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name; or

(ii) circumstances indicating that the disputed domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding disputed domain name, provided there is a pattern of such conduct; or

(iii) circumstances indicating that the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the disputed domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on that website or location.

The Complainant's trademark registration for PINSENT MASONS predates the registration of the disputed domain name <pinsentmasonslawfirms.com>. The nature of the disputed domain name that comprises the Complainant's trademark in its entirety with the addition of the term "lawfirms'" makes it inconceivable that that the Respondent coincidentally selected the disputed domain name without any knowledge of the Complainant, the Complainant's trademark or the Complainant's business. Moreover, combining the trademark with the term "lawfirms" could potentially mislead Internet users and consumers into mistakenly believing that the disputed domain name is owned by, affiliated with, endorsed by, or provided by the Complainant.

The Complainant has provided evidence that the disputed domain name resolves to a website with sponsored commercial pay-per-click links competing with or capitalizing on the Complainant's trademark.

Thus, the evidence and the circumstances in the case indicate that the disputed domain name has been registered and used in an attempt to attract, for commercial gain, Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website.

Based on the facts alleged in the Complaint and the evidence provided by the Complainant, which the Respondent has made no effort to rebut, the Panel is persuaded on the balance of probabilities that the Respondent registered and used the disputed domain name with the Complainant's trademark and business in mind. There is no evidence in the case file that refutes the Complainant's submissions and the Panel concludes that the Complainant has proved that the disputed domain name <pinsentmasonslawfirms.com> has been registered and used in bad faith.

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 <pinsentmasonslawfirms.com> shall be transferred to the Complainant.

/Johan Sjöbeck/
Johan Sjöbeck
Sole Panelist
Date: October 7, 2024